

**O-498-18**

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No. 3237730  
BY SHENZHEN YONGFULONG TECHNOLOGY CO. LIMITED  
TO REGISTER THE TRADE MARK**

**UFBOS**

**IN CLASS 9**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER No. 409996 BY  
HUGO BOSS TRADE MARK MANAGEMENT GMBH & CO. KG**

## BACKGROUND

1) On 28 April 2017, Sherzhen Yongfulong Technology Co. Limited (hereinafter “the applicant”) applied to register the trade mark shown on the front page of this decision in respect of the following goods:

- In Class 9: Battery chargers; Computers; Sound cards; Electrical adapters; Network cards; Computer network hubs; eyeglasses; Smartwatches; Power strips with movable sockets; Cabinets for loudspeakers; Earphones; Routers; computer peripheral devices; Printers; Unfilled ink cartridges for computer printers; Cases for smartphones; Sleeves for laptops; Cables and wires; mouse [computer peripheral]; keyboards.

2) The application was examined and accepted, and subsequently published for opposition purposes on 12 May 2017 in Trade Marks Journal No.2017/019.

3) On 14 August 2017 Hugo Boss Trade Mark Management GmbH & Co. KG (hereinafter “the opponent”) filed a notice of opposition, subsequently amended and also amended by the witness statement which reduced the number of mark relied upon. The opponent is the proprietor of the following trade marks:

Mark	Number	Dates of filing & registration	Class	Specification relied upon under section 5(2)(b)
<b>BOSS</b>	EU 49221	01.04.96 29.01.09	9	Spectacles and parts therefor.
			14	Clocks and watches.
			18	Leather and imitations of leather, and goods made of these materials (included in class 18), in particular small leather goods.
			25	Clothing for men and women
<b>HUGO BOSS</b>	EU 49254	01.04.96 26.03.08	9	Spectacles and parts therefor.
			14	Clocks and watches.
			18	Leather and imitations of leather, and goods made of these materials (included in class 18), in particular small leather goods.
			25	Clothing for men and women

4) The grounds of opposition are, in summary:

- a) The opposition is partial and against only the following goods of the application: “smartwatches; eyeglasses; cases for smartphones; sleeves for laptops”. The opponent relies upon its goods listed above in classes 9, 14 and 18 for which the its marks are registered. The opponent contends that the mark in suit is similar to the opponent’s marks and sought to be registered for identical and/or similar goods. The mark in suit therefore offends against section 5(2)(b) of the Act.
- b) The opponent has considerable reputation in the UK in respect of clothing; spectacles, watches and leather goods under the marks above. Use of the mark in suit would form a link between the applicant’s goods and those of the opponent such that it would take unfair advantage of the repute of the opponent’s marks. Such a link would damage or tarnish the reputation of the opponent’s marks and diminish their distinctiveness. The application therefore offends against section 5(3) of the Act.
- c) The opponent has goodwill and reputation in the signs BOSS and HUGO BOSS in respect of clothing; spectacles, watches and leather goods and as such use of the mark in suit would create misrepresentation, leading to damage to the opponent. As such the application offends against Section 5(4)(a) of the Act.

5) On 22 September 2017 the applicant filed a counterstatement, subsequently amended, basically denying all the grounds. It contends that the “UF” part of its mark “stands for the applicant’s name “YOUNGFULONG” in short pronunciation and the word “BOSS” is a very commonly used word that means a person who is in charge of a worker or organisation”. It points out that its goods are electronic products and are different in nature, use, selling channels and end users and that the applicant has no connection to the clothing industry. It puts the opponent to proof of use of both its marks.

6) Only the opponent filed evidence. Both parties seek an award of costs in their favour. Neither party wished to be heard. Only the opponent provided written submissions which I shall refer to as and when necessary in my decision.

7) The opponent filed a witness statement, dated 11 December 2017, by Paul Anthony Daly the Finance Director of Hugo Boss (Schweiz) AG a company which is part of the Hugo Boss group. He is authorised to make the statement and has access to the relevant records. He states that his evidence is focussed upon the use of BOSS and HUGO BOSS in the EU and in the UK, in particular, as the UK is a significant member of the EU and providing evidence of use in every EU country would, he contends, be disproportionate. He provides annual sales figures for the group of companies globally which covers clothing, footwear, headgear, accessories and fragrances, eyewear, watches, home textiles and writing instruments. He states that these sales figures cover various trade marks, including BOSS, BOSS ORANGE, BOSS GREEN and HUGO. He states that “Net sales in the UK alone in 2016 were in the region of €300 million” but does not give details of the trade marks used or the goods which were sold. He also states that the group has over 70 stores in the UK and goods can also be purchased at other retail outlets throughout the UK. The company sponsors sporting and cultural events worldwide and alongside traditional advertising also it uses social media. The group sponsors a number of UK sports people under the HUGO BOSS mark. He states that eyewear under the marks HUGO BOSS and BOSS has been sold in the UK since 1989 and in 2016 sales under the marks amounted to over €2 million in the UK alone. Watches have been sold in the UK since 1996 under both HUGO BOSS and BOSS and sales in 2016 in the UK amounted to over €19 million. He states that leather goods such as purses, wallets, belts and bags including smartphones cases have been sold under the marks HUGO BOSS and BOSS in the UK during the relevant period. He also confirms that clothing under the marks HUGO BOSS and BOSS has been sold in the UK in the relevant period. He provides a large number of exhibits many of which are undated or dated after the relevant date. No evidence of actual sales in the UK or EU were provided, nor were turnover figures for clothing in these areas provided. The evidence provided is not sufficient to show that the opponent enjoys a reputation or goodwill in its marks in the UK or EU. I list below the exhibits which I find relevant to my decision:

- Pages 65-73: Glasses offered for sale on the opponent’s UK website under the mark BOSS and HUGO BOSS dated 22 June 2012-24 February 2016.

- Pages 124 – 129 which show watches with both the marks BOSS and HUGO BOSS (one underneath the other) upon them offered for sale by the opponent's UK website between June 2012 and 14 Oct 2016.
- Pages 181- 186 show handbags and leather wallets offered for sale on the opponent's UK website between 17 February 2013 and 16 October 2016 under the marks BOSS and HUGO BOSS (one underneath the other).

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

## **DECISION**

9) I shall first consider the ground of opposition under section 5(2)(b) which reads:

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

(a) .....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

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

“6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

11) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier filed trade marks. Given the interplay between the date that the opponent's marks were registered (EU 49221: 29 January 2009 and EU 49254 26 March 2008) and the date that the applicant's mark was published (12 May 2017), the proof of use requirements bite upon both the opponent's marks. Section 6 states:

"6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

12) In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. *The law with respect to genuine use* . In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237 ). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaft” (German),

“efectivo” (Spanish), “sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria” (Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être*



of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

13) The opponent needs to show use of its marks in the five years prior to the publication date of the mark in suit, which means that the period in question is 13 May 2012 - 12 May 2017. The opponent is relying upon the following identical specification for both its marks BOSS and HUGO BOSS.

9	Spectacles and parts therefor.
14	Clocks and watches.
18	Leather and imitations of leather, and goods made of these materials (included in class 18), in particular small leather goods.

14) In his statement Mr Daly states that his company sold €2 million worth of spectacles under the two marks in 2016 in the UK which is corroborated by pages 65-73 in the exhibits which show spectacles under both marks offered for sale on a UK website during the relevant period. Similarly, he states that in 2016 his company sold €19 million worth of watches under the two marks in the UK corroborated by pages 124 -129 which show watches for sale on a UK website during the relevant period. There is no use shown on clocks in the evidence. Lastly, Mr Daly states that his company sells leather goods in the UK but does not provide any sales figures, instead the only evidence of use is provided at pages 181 – 186 dated 17 March 2013 – 16 October 2016 which show handbags and leather wallets offered for sale on a UK website. I am willing to accept this is enough to pass the proof of use test but only for the items shown not the full specification relied upon.

15) Having determined that the marks have been used I have to consider the specification which the opponent should be able to rely upon in the ensuing comparison test. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

16) Whilst in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation (which is equally applicable to an assessment of proof of use) as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

17) The marks are registered for the specifications set out in paragraph 13 above. These items were specifically chosen by the opponent and I can see no reason why the items such as "spectacles" and "watches" would not be regarded as subcategories of the class and have markets all of their own. The same is not quite so obvious with regard to the class 18 goods. However, the specification as registered is quite wide covering all leather and imitation leather goods. I note that the specification has the words "in particular small leather goods" but do not believe that this accurately reflects the use shown and so I will adhere to the actual use shown which is on handbags and leather wallets. As such the **opponent can, in respect of marks 49221 and 49254, only rely upon "spectacles" in class 9; "watches" in class 14 and "handbags and leather wallets" in class 18 in the comparison tests.**

18) When considering the issue under section 5(2)(b) I take into account the following principles which 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **The average consumer and the nature of the purchasing process**

19) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade.

20) All of the goods of the two parties are standard consumer products which would be purchased by the public at large. Such goods will typically be offered for sale in retail outlets, in brochures and catalogues as well as on the internet. The initial selection is therefore primarily visual. I accept that more expensive items such as watches may, for example, be researched or discussed with a member of staff or be made to order. The latter, along with personal recommendations, bring aural considerations into play.

21) Clearly, the average consumer's level of attention will vary considerably depending on the nature of the item at issue. However, to my mind even when selecting routine inexpensive items such as off the shelf reading glasses or a wallet the average consumer will pay attention to considerations such as size, colour, fabric, cost and whether its meets technical requirements such as strength of lens.

**Overall the average consumer for these types of goods is likely to pay an average degree of attention to the selection of such items.**

## Comparison of goods and services

22) When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, the CJEU stated at paragraph 23 of its judgement:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

23) Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

24) In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”.

25) In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) OHIM* case T-133/05, the General Court (“GC”) stated:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T110/01 *Vedial V OHIM France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

26) The specifications to be compared are as follows:

Opponent’s goods	Applicant’s goods
Class 9: Spectacles Class 14: Watches Class 18: Handbags and leather wallets	Class 9: smartwatches; eyeglasses; cases for smartphones; sleeves for laptops

27) Clearly, “spectacles” and “eyeglasses” both in class 9 are identical. The applicant’s “smartwatches” maybe in class 9 and have and do more than simply tell the time, but they are also watches which are worn on the wrist and at first glance appear to be a wristwatch. These must be

regarded as highly similar. Lastly, I consider “cases for smartphones and sleeves for laptops” to “handbags and leather wallets”. I accept that these are in different classes, but I am also aware that phone cases can also have compartments for the storage of cash and credit cards just like a wallet and so these are highly similar. “Sleeves for laptops” frequently offer additional storage space and hold more than the laptop but also offer the ability to store a phone, wallet etc just like a handbag as one would not want to carry two bags, one strictly for a laptop and the other for everything else. I accept that their main purpose is different, and they are not in strict competition. They do share a similar nature and as both are leather goods maybe found in the same retail outlets and so have an overlap in trade channels. I find these goods to be similar to a medium degree.

### Comparison of trade marks

28) 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 them, 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.”

29) The marks of the two parties are as follows:

Applicant's Mark	Opponent's marks	
UFBOSS	49221	BOSS
	49254	HUGO BOSS

30) Clearly, both the applicant's mark and the opponent's marks contain the word BOSS. In the mark in suit it is preceded by the letters UF, whereas 49221 has no other matter and 49254 has the name



HUGO as its initial element. The applicant claims that the letters UF stands for part of its name being the short pronunciation of the word “YOUNGFULONG”. There is no evidence to support this, but I have no reason to doubt this claim. However, the average UK consumer will not, I believe, recognise the letters UF as having such a meaning. The letters do not appear to have any meaning in respect of the goods and the opponent's contention that the average consumer would view the letters as standing for a line or range of product seems highly fanciful. In my opinion, I think it more likely that the average consumer will view the letters UF as standing for the forenames of Mr Boss in much the same way as WH Smith, FW Woolworth and JC Penney. Just as the name HUGO identifies the opponent's founder from other people with the surname Boss. Clearly, there is considerable visual, aural and conceptual similarity between the mark in suit and mark 49221. Whilst mark 49254 has a degree of visual and aural similarity but differs considerably conceptually as they will be seen by the average consumer to identify two different people. **I therefore find that the opponent's mark 49221 is highly similar to the mark in suit whilst the opponent's mark 49254 is only similar to the mark in suit to a low degree.**

#### **Distinctive character of the earlier trade mark**

31) 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 *Windsurfing Chiemsee 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).”

32) The word/s “BOSS” “HUGO BOSS” have no meaning for the class 9 goods in this case. The opponent has filed evidence of use, but has failed to put the sales figures into any perspective in respect of market share, nor has it filed any independent evidence of reputation (within the relevant period). **I find that both the opponent’s marks have an average degree of distinctiveness but cannot benefit from enhanced distinctiveness through use.**

### **Likelihood of confusion**

33) In determining whether there is a likelihood of confusion, 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 trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer is a member of the general public who will select the goods by predominantly visual means, although not discounting aural considerations and that they will pay at least an average degree of attention to the selection of such goods.
- the opponent’s marks have an average degree of inherent distinctiveness, but cannot benefit from an enhanced distinctiveness through use.
- the opponent’s mark 49221 is highly similar to the mark in suit whilst the opponent’s mark 49254 is only similar to the mark in suit to a low degree.
- When comparing the goods of the two parties I made the following findings:

Applicant's goods	Opponent's goods	Finding
Eyeglasses	Spectacles	Identical
Smart watches	Watches	Highly similar
cases for smartphones	leather wallets	Similar to a medium degree
sleeves for laptops	handbags	Similar to a medium degree

34) In view of the above, in respect of the opponent's mark 49221 there is a likelihood of consumers being confused into believing that any of the specified class 9 goods applied for under the mark in suit and provided by the applicant are those of the opponent or provided by some undertaking linked to it.

**The opposition under Section 5(2) (b) in respect of the following goods succeeds: In class 9 "Eyeglasses; smart watches; cases for smartphones; sleeves for laptops".** However, in respect of the opponent's mark 49254 there is no likelihood of consumers being confused into believing that any of the specified class 9 goods applied for under the mark in suit and provided by the applicant are those of the opponent or provided by some undertaking linked to it. **The opposition under Section 5(2) (b) in respect of the opponent's mark 49254 fails.**

35) I next turn to the ground of opposition under section 5(3) which reads:

"5. (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 (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) 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."

36) When considering the above ground I take into account the relevant case law that can be found in the following judgments of the Court of Justice of the European Union (CJEU): Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The principles are 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 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*.

(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*).

37) I must first consider the issue of reputation. 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."

38) Obviously, the reputation must exist in the goods covered by the trade mark (see General Court ruling in *Tulliallan Burlington Ltd v EUIPO*, Case T-123/16). In the instant case the opponent has filed turnover figures for one year in respect of spectacles and watches in respect of the marks BOSS and HUGO BOSS. There is no split between the marks, possibly because the goods all appear to be branded "BOSS" with the words "HUGO BOSS" after or just underneath. The opponent's evidence only illustrates the mark BOSS being qualified by the name HUGO BOSS identifying the man who founded and initially owned the company. There is no use shown of the mark BOSS alone. The opponent has also failed to identify the size of the market or their market share. There is no evidence from independent sources as to reputation. Nor did the opponent provide any sales information, market share, advertising, etc. regarding clothing for which it also claims to have a reputation. It did file a report from some years prior to the relevant period regarding mark recognition but in the absence of recent sales figures it is difficult to give this any attribution. The only possible reputation the opponent could contend to have from the evidence provided is under the mark HUGO BOSS for watches and spectacles.

39) Having scrapped over the first hurdle I next must consider the issue of whether the public would make a link between the marks of the two parties. In Case C-408/01, *Addidas-Salomon*, the CJEU held that:

"28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23)."

40) The level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion. In *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, the CJEU stated (at paragraph 72 of its judgment) that:

“The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

41) I take into account the comments of Mr Geoffrey Hobbs Q.C. (sitting as a Deputy Judge) in *Electrocoin Automatics Limited and Coinworld Limited and Others* [2005] FSR 7:

“102. I think it is clear that in order to be productive of advantage or detriment of the kind prescribed, ‘the link’ established in the minds of people in the market place needs to have an effect on their economic behaviour. The presence in the market place of marks and signs which call each other to mind is not, of itself, sufficient for that purpose.”

42) I also look to the case of *Intel Corporation Inc v CPM United Kingdom Ltd* [2006] EWCH 1878 where Patten J said at para 28:

“But the first step to the exploitation of the distinctive character of the earlier mark is necessarily the making of the association or link between the two marks and all that Neuberger J is, I think, saying in this passage [Premier Brands at p. 789] is that the existence of a later mark which calls to mind the earlier established mark is not sufficient to ground an objection under s.5(3) or

s.10(3) unless it has one or other of the consequences specified by those provisions. It must be right that the making of the association is not necessarily to be treated as a detriment or the taking of an unfair advantage in itself and in cases of unfair advantage it is likely to be necessary to show that the making of the link between the marks had economic consequences beneficial to the user of the later mark. But in relation to detriment the position is more complicated. The association between two marks and therefore potentially between the products or services to which they relate may be detrimental to the strength and reputation of the earlier mark if it tarnishes it by association or makes it less distinctive. This is likely to take place as a consequence of the same mental process which links the two marks in the minds of consumers and is essentially a negative reaction and effect.”

43) Earlier in this decision I found that the mark in suit is similar to only a low degree to the mark HUGO BOSS. Following my finding in respect of section 5(2)(b) the remaining goods in class 9 applied for are: “Battery chargers; Computers; Sound cards; Electrical adapters; Network cards; Computer network hubs; Power strips with movable sockets; Cabinets for loudspeakers; Earphones; Routers; computer peripheral devices; Printers; Unfilled ink cartridges for computer printers; Cables and wires; mouse [computer peripheral]; keyboards”. Whilst I accept that the goods of the two parties do not need to be similar for a successful finding under section 5(3) similarity is one of the aspects which I must consider. To my mind, these goods are so far removed from the goods in which the opponent has managed to show reputation that there is no prospect of any consumer forming a link between the marks of the two parties. **In the absence of a link the ground of opposition under section 5(3) must fail.**

44) Lastly, I turn to the ground of opposition under section 5(4)(a) which reads:

5. (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, or

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.”



45) Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

46) Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances."

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

47) First, I must determine the date at which the opponent's claim is to be assessed; this is known as the material date. As set out in *Advanced Perimeter Systems Limited v Multisys Computers Limited*,

BL O-410-11 paragraphs 39-43, by Mr Daniel Alexander QC acting as the Appointed Person the relevant date for the purposes of s.5(4)(a) of the Act is the date that the mark in suit was applied for, in the instant case this was 28 April 2017 which is, therefore, the material date. The applicant has shown no use of its mark and so cannot claim to be the senior user as per the comments in *Croom's Trade Mark Application [2005] RPC 2* and *Daimlerchrysler AG v Javid Alavi (T/A Merc) [2001] RPC 42*.

## Goodwill

48) I now turn to consider the evidence filed by the opponent to determine when it began use of its marks and upon which goods. In determining this I take into account of the guidance in the case of *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership) [2002] RPC 19 (HC)*, Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97* as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

49) However, in *Minimax GmbH & Co KG v Chubb Fire Limited [2008] EWHC 1960 (Pat)* Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

50) From the evidence filed by the opponent it is clear that they have had goodwill in watches and glasses since 2016 the only year for which sales figures for the UK or EU have been provided. The opponent provided a global turnover figure for vast range of goods, but this is of no use in the instant case. As set out in paragraphs 7 & 38 the opponent has not shown goodwill in respect of clothing. **I conclude that the opponent has shown it has goodwill in the combined mark “BOSS; HUGO BOSS” only, and then only in respect of spectacles and watches amongst a substantial proportion of the population of the UK, even though the sales figures provided were not put into context in terms of market share.**

## **MISREPRESENTATION**

51) In *Neutrogena Corporation and Another v Golden Limited and Another*, 1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect*

*Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

“The role of the court, including this court, was emphasised by *Lord Diplock in GE Trade Mark* [1973] R.P.C. 297 at page 321 where he said:

‘where the goods are sold to the general public for consumption or domestic use, the question whether such buyers would be likely to be deceived or confused by the use of the trade mark is a “jury question”. By that I mean: that if the issue had now, as formerly, to be tried by a jury, who as members of the general public would themselves be potential buyers of the goods, they would be required not only to consider any evidence of other members of the public which had been adduced but also to use their own common sense and to consider whether they would themselves be likely to be deceived or confused.

The question does not cease to be a “jury question” when the issue is tried by a judge alone or on appeal by a plurality of judges. The judge's approach to the question should be the same as that of a jury. He, too, would be a potential buyer of the goods. He should, of course, be alert to the danger of allowing his own idiosyncratic knowledge or temperament to influence his decision, but the whole of his training in the practice of the law should have accustomed him to this, and this should provide the safety which in the case of a jury is provided by their number. That in issues of this kind judges are entitled to give effect to their own opinions as to the likelihood of deception or confusion and, in doing so, are not confined to the evidence of witnesses called at the trial is well established by decisions of this House itself.”

52) Earlier in this decision I found that the mark in suit and the opponent's mark HUGO BOSS had a low degree of similarity. The goods opposed in this ground are as set out in paragraph 43 above and these are significantly different from the goods in which the opponent has goodwill. To my mind, the necessary misrepresentation required by the tort of passing off will not occur and the opposition action based upon section 5(4)(a) must fail.

## **CONCLUSION**

53) The opposition in relation to section 5(2)(b) has been successful. The result is that the application will be refused in relation to the following goods: Eyeglasses; Smart watches; cases for smartphones; sleeves for laptops.

54) The opposition in respect of section 5(3) and 5(4)(a) both failed and so the registration can be concluded in respect of the following goods in class 9:

“Battery chargers; Computers; Sound cards; Electrical adapters; Network cards; Computer network hubs; Power strips with movable sockets; Cabinets for loudspeakers; Earphones; Routers; computer peripheral devices; Printers; Unfilled ink cartridges for computer printers; Cables and wires; mouse [computer peripheral]; keyboards”.

## **COSTS**

55) The opponents have been wholly successful in respect of 5(2)(b) but have failed completely in respect of 5(3) and 5(4)(a). As both sides have achieved a measure of success I do not propose to favour either side with an award of costs.

**Dated this 14th day of August 2018**



**George W Salthouse**  
**For the Registrar,**  
**the Comptroller-General**

