

O/0490/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003732485

BY LIMBOSS PTE. LTD.

TO REGISTER:

L I M B O S S

AS A TRADE MARK IN CLASSES 3 & 35

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 432437 BY

HUGO BOSS TRADE MARK MANAGEMENT GMBH & CO. KG.

BACKGROUND AND PLEADINGS

1. On 14 December 2021, LIMBOSS PTE. LTD. (“the applicant”) applied to register the trade mark shown on the cover of this decision (“the applicant’s mark”) in the UK for the following goods and services:

Class 3: Beauty care cosmetics; Beauty care preparations; Beauty creams for body care; Beauty serums with anti-ageing properties; Beauty masks; Colognes; Cosmetics; Eye cosmetics; Eyebrow cosmetics; Face blusher; Cosmetic pencils; Cosmetic nail preparations; Eyeliners; Eyeliner pencils; Eau-de-toilette; Eau de parfum; Make-up; Make-up foundations; Make-up pencils; Liquid foundation (mizu-oshiroi); Make-up removers; Mascaras; Lip balm; Lip gloss; Lipstick; Skincare cosmetics; Skincare preparations; Sun bronzers; Sunscreen preparations; Sunscreens [for cosmetic use]; Toiletries; Perfumes; Perfumery products.

Class 35: Online retail store services relating to cosmetic and beauty products; Retail services in relation to toiletries; Retail services in relation to beauty implements for humans; Providing consumer product information relating to cosmetics; Providing consumer product advice relating to cosmetics; Commercial information and advice services for consumers in the field of beauty products.

2. The applicant’s mark was published for opposition purposes on 7 January 2022 and, on 7 April 2022, it was opposed by HUGO BOSS Trade Mark Management GmbH & Co. KG. (“the opponent”). The opposition is based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”).

3. In respect of the 5(2)(b) ground, the opponent relies on the following marks:

BOSS

UK registration no: 900049221¹

Filing date 1 April 1996; registration date 29 January 2009

Relying on some goods only, namely:

Class 3: Fragrant sprays; perfumery; deodorising preparations for personal use; soaps.

("the opponent's first mark");

HUGO BOSS

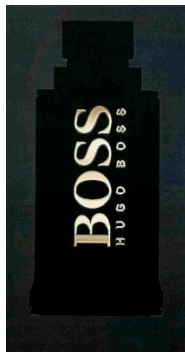
UK registration no: 918047550

Filing date 3 April 2019; registration date 17 July 2019

Relying on all goods, namely:

Class 3: Soaps; essential oils; cosmetics; perfumery; fragrances.

("the opponent's second mark");



UK registration no: 801289378

Filing date 27 October 2015; registration date 28 December 2016

Priority date 20 June 2015

Relying on all goods, namely:

¹ Save for the opponent's fifth mark, all trade marks relied upon by the opponent are either comparable trade marks based on pre-existing EUTMs or pre-existing International Registrations designating the EU. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs.

Class 3: Soaps; perfumeries; essential oils; cosmetics; hair lotions; dentifrices.

("the opponent's third mark");

BOSS THE SCENT

UK registration no: 801373865

Filing date 13 September 2017; registration date 11 April 2018

Priority date 17 March 2017

Relying on all goods, namely:

Class 3: Soaps; perfumeries; essential oils; preparations for body and beauty care; hair lotions; dentifrices.

("the opponent's fourth mark"); and

BOSS
HUGO BOSS

International Registration designating the UK: 754225

International registration date 8 February 2001; date protection granted in the UK 10 April 2002

Relying on some goods only, namely:

Class 3: Perfumery, deodorants for personal use; soaps.

("the opponent's fifth mark").

4. Under the 5(2)(b) ground, the opponent pleads that in view of the high level of similarity between the parties' marks and the identical or similarity of the goods and services at issue, there exists a likelihood of confusion on the part of the public, which includes a likelihood of association with the earlier marks. In addition, the opponent relies on a family of marks argument and argues that the presence of 'BOSS' in the applicant's mark creates a likelihood of confusion with the opponent's family of 'BOSS' marks. The opponent argues that, in encountering the marks, the

average consumer is likely to believe that it is an extension of the opponent's family of 'BOSS' marks.

5. Under its 5(3) ground, the opponent relies on its first, second, third and fifth marks only. These are reproduced above. As for the goods that the opponent claims to enjoy a reputation, these are underlined in the above reproductions. Under this ground, the opponent argues that the marks are similar and as a result of the very strong reputation accrued by the opponent for those marks relied upon, use of the applicant's mark will call the opponent's marks to mind. The opponent argues that, as a result of the marks being linked in the minds of average consumers, use of the applicant's mark will take unfair advantage of the opponent's marks, dilute their distinctive character and be detrimental to the opponent's repute.
6. The applicant filed a counterstatement denying the claims made. The applicant elected to put the opponent to proof of use, however, it did not specify for which marks proof of use was sought. I will discuss this point further below.
7. Only the opponent filed evidence in chief. A hearing took place before me on 7 March 2023, by video conference. The opponent was represented by Mr Tony Pluckrose and Mr Anthony Yeramisu of Boulton Wade Tennant LLP, who have represented the opponent throughout these proceedings. Neither the applicant nor its representative elected to attend the hearing and neither did it file any written submissions in lieu of its attendance. Since 20 December 2022, the applicant has been represented in these proceedings by Withers & Rogers LLP.
8. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

9. The opponent's evidence in chief came in the form of the witness statement of Ms Alice Busachi dated 13 September 2022. Ms Busachi is the Assistant General Counsel of Coty, Inc ("Coty") and has held this position since March 2021, previously holding the role of Senior Legal Counsel. Ms Busachi confirms that Coty is the licensee of the trade marks of the opponent for goods in class 3, including those goods relied upon in these proceedings. Ms Busachi's statement is accompanied by five exhibits, being Exhibits AB01 to AB05.

10. I will refer to points from the evidence where necessary.

PRELIMINARY ISSUE

11. Prior to the hearing, the opponent's representative made a request to file additional evidence that included decisions from the EUIPO and the Turkish Patent and Trademark Office regarding identical (or, if not, analogous) matters in those jurisdictions. The request was refused via a preliminary view dated 23 February 2023. The reason for the refusal was that the decisions were not binding on the Tribunal and, therefore, had no material impact on the decision that the Hearing Officer would ultimately make. The evidence, therefore, did not satisfy the requirements of *Property Renaissance Ltd v Stanley Dock Hotel & Ors* [2016] EWHC 3103 (CH). In communicating the refusal, the Tribunal set out that there was no reason why the opponent could not include these decisions in any authorities bundle that the opponent wished to file with its skeleton arguments. No challenge to the preliminary view was forthcoming and the decisions were filed prior to the hearing as part of the opponent's authorities bundle.

12. While I have considered these decisions, I wish to confirm that, for the avoidance of doubt, they are not binding upon me and are not relevant to the decision I must now make. Instead, my decision will be based on the global assessment of the issues before me and not on the decisions of the EUIPO or the Turkish Patent and

Trademark Office. At the hearing, the opponent made submissions surrounding the findings in these decisions and I will address those points where necessary.

DECISION

Proof of use

13. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

14. The relevant statutory provisions are as follows:

“Section 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 relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(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 relevant period 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 (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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 Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(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.”

15. When comparable marks are put to proof of use, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

16. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

17. Given their filing dates, the opponent’s marks qualify as earlier trade marks under the above provisions. While the opponent’s first and fifth marks completed their registration processes over five years prior to the filing date of the applicant’s mark, the opponent’s second, third and fourth marks did not. As set out above, the applicant made a blanket request that the opponent provide proof of use. Given that the proof of use provisions only apply to the opponent’s first and fifth marks, it is only those marks that are subject to the proof of use assessment in respect of the goods relied upon. As for the opponent’s second, third and fourth marks, they are not subject to the proof of use provisions and the opponent may, therefore, rely on all of the goods for which those marks are registered.

18. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-

9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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 Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* 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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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].”

19. Pursuant to Section 6A of the Act, the relevant period for assessing whether there has been genuine use of the opponent’s first and fifth marks is the 5-year period ending with the filing date of the applicant’s mark, being 14 December 2021. Therefore, the relevant period for this assessment is 15 December 2016 to 14 December 2021.

20. The opponent’s first mark is a comparable mark based upon an earlier EUTM, which means that use of the mark in the EU prior to IP Completion Day (being 31 December 2020) is relevant to the present assessment.² Between 15 December 2016 and 31 December 2020, the EU is therefore the relevant territory for proof of use. However, from 1 January to 14 December 2021, the relevant territory is the UK only. On this point, I refer to the case of *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, wherein the Court of Justice of the European Union (“CJEU”) noted that:

“It should, however, be observed that ... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single

² See paragraph 4 of Tribunal Practice Notice 2/2020

Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

21. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”³ because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

Sufficient Use

22. I note that the opponent’s evidence of use sets out that use of the marks for the class 3 goods relied upon was made by Coty. As discussed above, the narrative evidence of Ms Busachi confirms that Coty is licenced to use the opponent’s marks in respect of class 3 goods. While no documentary evidence has been provided confirming this relationship, I do not consider it necessary to have the express agreement before me in these proceedings. This is on the basis that the narrative evidence has not been challenged and, on the basis that it was accompanied by a signed statement of truth, I have no reason to disbelieve the comments of Ms Busachi. As a result, I accept that any use made by Coty was with the consent of the opponent and it is, therefore, relevant to these proceedings.⁴ Going forward, I will, for ease of reference, refer to the use by Coty as being by the opponent.

23. The opponent’s evidence in respect of the use made of its marks is extensive. I do not intend to summarise it in full as I believe I can deal with it relatively swiftly. The opponent sells a range of fragrances, deodorants and soaps and screenshots taken from the opponent’s website confirming this is shown in evidence by way of print-outs dated 27 July 2017, 19 May 2019 and 25 May 2020 taken from the

³ *Jumpman* BL O/222/16

⁴ See Section 6A(3)(a) of the Act

internet archive facility, The Wayback Machine.⁵ The print-outs are dominated by a range of perfumes but also include shower gels and deodorant sticks that, for the most part, bear the opponent's fifth mark. For the avoidance of doubt, I consider that use of the opponent's fifth mark only is satisfactory use of its first mark as registered. This is on the basis that the opponent's first mark is the word 'BOSS' only and this mark can be said to sit within the fifth mark as part of a composite mark and, given the size of 'BOSS' in that mark, it will be still seen as indicative of the origin of the goods. As per the case of *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, this is in line with use of a mark as registered and is, therefore, acceptable.

24. Total revenue figures for sales in the UK of fragrances, deodorants and soaps under the opponent's marks for the years 2017 to 2021 are provided and are broken down as follows:

Total revenue in United Kingdom (GBP)				
2017	2018	2019	2020	2021
57.5 million	72.7 million	84 million	66.4 million	73.5 million

25. In addition, EU figures are provided for the same time period and they are broken down as follows:

Total revenue in the European Union (EUR)				
2017	2018	2019	2020	2021
464,213,818	457,884,877	493,285,666	402,855,939	436,746,710

26. There is no further breakdown between the three categories covered by the above UK and EU figures. Regardless, I consider it reasonable to infer that these figures are clearly representative of a significant turnover for each category.

⁵ Exhibit AB01

27. In respect of market share, the opponent confirms that between 2018 and 2021, its market share in the fragrance sector ranged from 4.9% and 6.1%.⁶

28. Across the UK, the opponent confirms that, during the relevant period, it sold its fragrances via a range of retailers such as Boots, John Lewis, The Perfume Shop, House of Fraser and Superdrug, amongst others.

29. There is a wide range of evidence regarding advertising and marketing undertaken by the opponent during the relevant period. I do not intend to go over this in detail but note that it shows significant advertising campaigns across different mediums such as in cinemas and on television⁷ as well as outdoor campaigns in locations such as ‘Westfield Shepherds Bush’, ‘The Arndale Centre’ in Manchester and Piccadilly Circus.⁸ The advertising shown appears to focus on perfumery goods. In respect of advertising spend, a breakdown of the opponent expenditure in the UK has been provided for 2017 to 2021. This is as follows:

Advertising spend in the United Kingdom (GBP)				
2017	2018	2019	2020	2021
12,623,355	8,586,010	11,469,786	8,442,537	10,152,231

30. Press coverage is also discussed that shows the opponent being featured in magazines such as Marie Claire, GQ, Men’s Health and Elle Magazine, amongst others. Examples of such coverage is provided in evidence.⁹

31. Taking all of the evidence into account, it is clear that it demonstrates that the opponent operates an exceptionally large business. Given the nature of the evidence and for reasons that will become apparent below, I will assess the use of the opponent’s perfumery goods first and then move to consider the remaining goods, being “deodorising preparations for personal use” (in the first mark), “deodorants for personal use” (in the fifth mark) and “soaps” (in both marks).

⁶ Page 101 of Exhibit AB03

⁷ Pages 116 and 117 of Exhibit AB03

⁸ Pages 118 to 121 to Exhibit AB03

⁹ Exhibit AB05

32. While a 4.9% to 6.1% market share for fragrances may appear relatively low, I do not consider this to be the case. Given the size of the turnover provided (even taking into account the fact that it also covers deodorant and soaps), it is clear that the fragrance market is an enormous one and I do not consider it a point of serious dispute to suggest that it is also a very competitive one that is populated by a large number of businesses. Therefore, I conclude that the market share provided is significant. Further, the turnover figures for the UK alone, not to mention the EU at large, are very significant, so too is the advertising expenditure (again, I acknowledge the inclusion of deodorant and soaps in these figures). The latter point is further supported by the evidence demonstrating the opponent's presence in advertising its perfumery goods across different mediums and the press coverage it has attracted during the relevant period. I also note that the opponent has confirmed that, across the UK, it has sold its fragrances in large nationwide retailers such as Boots and John Lewis. Based on the evidence filed, I have no hesitation in finding that there is clearly genuine use of both the opponent's first and fifth marks during the relevant period in relation to "fragrant sprays" (in the first mark only) and "perfumery".

33. I turn now to consider the evidence in relation to the remaining goods relied upon, being "deodorising preparations for personal use" (in the first mark), "deodorants for personal use" (in the fifth mark) and "soaps" (in both marks). I remind myself that the website evidence supports the opponent's position that it also sold goods including shower gels and deodorants during the relevant period. I have set out above that the turnover figures provided are very significant, however, the figures relate to three categories of goods and have not been broken down further. Given the focus on fragrances in the evidence, I do not consider it controversial to suggest that the majority of the turnover is likely to have stemmed from the sale of those goods rather than deodorants or shower gels. Having said that, given the size of the turnover provided, I consider it reasonable to infer that there is still a respectable level of sales that is attributable to deodorants and shower gels. Even if these sales are significantly less than those for its fragrances, I remind myself that use of the mark need not always be quantitatively significant for it to be

deemed genuine. On balance of the evidence as a whole, I am satisfied that the opponent has demonstrated use for these goods also. While I accept that the use covers “deodorants for personal use” and “deodorising preparations for personal use”, I am not satisfied that the opponent should be granted use of the term “soaps” at large. While shower gels are a type of soap used to clean the body, I consider them to be a subcategory of soaps and I am of the view that the average consumer would fairly describe the use shown as “shower gels” rather than the broader term “soaps”.¹⁰ Therefore, in considering a fair specification of these goods, I limit the term “soaps” to “shower gels”.

Section 5(2)(b): my approach

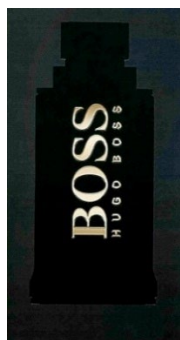
34. At the hearing, the opponent’s representative, Mr Pluckrose, submitted that, in respect of the section 5(2)(b) ground, it would be focusing on the opponent’s first, third and fifth marks. That being said, Mr Pluckrose confirmed that as the opponent is running a family of marks argument, the remaining two marks are still relied upon. I would not ordinarily address a family of marks argument at this point in a decision but I consider doing so is necessary as it will inform the approach I take in respect of the section 5(2)(b) ground.

35. The basis for the family of marks argument is that the opponent’s marks all utilise the element “BOSS” and that, upon being confronted with the applicant’s mark, the average consumer would clearly identify the word ‘BOSS’ and, therefore, perceive it as an extension of the opponent’s family of ‘BOSS’ marks. While this argument is noted, I do not consider that it holds any weight. This is on the basis that the opponent’s marks do not demonstrate an obvious pattern that would lead the consumer to consider that the applicant’s mark is consistent with the opponent’s family of marks. For example, the marks relied upon are ‘BOSS’, ‘BOSS THE SCENT’ and ‘HUGO BOSS’. Even though they all share the word ‘BOSS’, this is either solus, followed by a descriptive element (‘THE SCENT’) or preceded by a commonly known first name (‘HUGO’). I do not consider these marks demonstrate

¹⁰ *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

a consistent pattern that would indicate a family of marks and, notably, none of them include the element 'BOSS' conjoined with an unknown prefix, which is the case in the applicant's mark. I see no reason why, even with the knowledge of the opponent's use of 'BOSS', the average consumer would view 'LIMBOSS' as being consistent with the opponent's family of marks. Lastly, I note that the opponent sought to rely on marks such as 'BOSS ORANGE', 'BOSS FEMME' and 'BOSS MA VIE' in support of this argument. These marks are not relied upon in these proceedings and are, therefore, of no assistance. Even so, these marks are the word 'BOSS' followed by a suffix and this is a pattern not shared in the applicant's mark so would be of no assistance to the opponent in any event.

36. In light of the above and given the comments of Mr Pluckrose at the hearing (that the second and fourth marks support the family of marks argument), I do not consider it necessary to consider those marks in my section 5(2)(b) assessment. As for the reliance upon the opponent's third mark, I am not convinced that it adds anything beyond the reliance upon the fifth mark. This is on the basis that the third and fifth marks are as follows:



("the opponent's third mark")



("the opponent's fifth mark")

37. I appreciate that the third mark differs somewhat in its presentation, however, the word elements, save for their alignment, are identical. The colour difference is noted but, as it is registered in black and white, the opponent's fifth mark may also be presented in the same colour as the third mark. As a result, it is my intention to proceed on the basis of the opponent's first and fifth marks only. That being said, the opponent has not withdrawn its reliance on the remaining marks so I will return to consider them if I consider it necessary to do so.

Legislation and case law

38. Section 5(2)(b) of the Act reads as follows:

“(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 or association with the earlier trade mark.”

39. Section 5A of the Act states as follows:

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

40. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization 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-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

41. The competing goods and services are as follows:

The opponent's goods	The applicant's goods and services
<p><i>The opponent's first mark</i></p> <p><u>Class 3</u> Fragrant sprays; perfumery; deodorising preparations for personal use; shower gels.</p> <p><i>The opponent's fifth mark</i></p> <p><u>Class 3</u> Perfumery, deodorants for personal use; shower gels.</p>	<p><u>Class 3</u> Beauty care cosmetics; Beauty care preparations; Beauty creams for body care; Beauty serums with anti-ageing properties; Beauty masks; Colognes; Cosmetics; Eye cosmetics; Eyebrow cosmetics; Face blusher; Cosmetic pencils; Cosmetic nail preparations; Eyeliners; Eyeliner pencils; Eau-de-toilette; Eau de parfum; Make-up; Make-up foundations; Make-up pencils; Liquid foundation (mizu-oshiroi); Make-up removers; Mascaras; Lip balm; Lip gloss; Lipstick; Skincare cosmetics; Skincare preparations; Sun bronzers; Sunscreen preparations; Sunscreens</p>

	<p>[for cosmetic use]; Toiletries; Perfumes; Perfumery products.</p> <p><u>Class 35</u> Online retail store services relating to cosmetic and beauty products; Retail services in relation to toiletries; Retail services in relation to beauty implements for humans; Providing consumer product information relating to cosmetics; Providing consumer product advice relating to cosmetics; Commercial information and advice services for consumers in the field of beauty products.</p>
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42. When making the comparison assessing the similarity of the goods or services, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“[...] 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”.

43. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

44. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods (though it equally applies to services) are not worded identically, they can still be considered identical if the goods specified in the contested trade mark application are included in a more general category covered by a term under the earlier mark (or vice versa).

45. I have detailed submissions from the opponent in respect of the goods and services comparison. I do not intend to reproduce them here but confirm that I have taken them into account in making the below comparison. While the applicant did file a counterstatement wherein it denied the similarity of the marks and the existence of confusion, it made no comment on the similarity of the goods and services at issue. As such, I will treat the applicant’s silence as an acceptance that there is some level of similarity between the goods and services at issue. That being said, the applicant’s silence on the matter means that there is nothing to suggest the level of similarity accepted. Therefore, I am still required to proceed to consider a full comparison of the goods and services.

Class 3

46. Regardless of their slight differences in wording, I find that “perfumes” and “perfumery products” in the applicant’s specification are self-evidently identical to “perfumery” in the opponent’s specifications.

47. “Colognes”, “eau-de-toilette” and “eau de parfum” in the applicant’s specification are types of perfumery goods and are, therefore, encompassed by the opponent’s “perfumery” goods in both of its specifications. These goods are, therefore, identical under the principle outlined in *Meric*.

48. “Toiletries” in the applicant’s specification is a broad term that covers goods that relate to personal hygiene such as shampoo or soaps. The opponent’s specifications include “shower gels” which is a type of soap and, therefore, can be said to fall within the applicant’s broader category of goods. These goods are, therefore, identical under the principle outlined in *Meric*.

49. “Skincare preparations” in the applicant’s specification is another broad term that can cover a range of goods such as skin creams, soaps and moisturisers, amongst others. Following the same logic in the preceding paragraph, I find that as “shower gels” in the opponent’s specifications is a type of soap, it can be said to be a preparation for skincare. As a result, I find that these goods are identical under the principle outlined in *Meric*.

50. The applicant’s specification covers a wide range of cosmetic related goods, these are as follows:

“Beauty care cosmetics; Beauty care preparations; Beauty creams for body care; Beauty serums with anti-ageing properties; Beauty masks; Cosmetics; Eye cosmetics; Eyebrow cosmetics; Face blusher; Cosmetic nail preparations; Make-up; Make-up foundations; Liquid foundation (mizu-oshiroi); Make-up removers; Mascaras; Lip balm; Lip gloss; Lipstick; Skincare cosmetics; Sun bronzers.”

While the opponent's specifications does not include cosmetic goods, I consider that all of the above goods have some level of similarity with the opponent's "perfumery" and "deodorising preparations for personal use" goods. The nature and purpose of all of these goods is different in that one parties' goods are cosmetics used for beautifying the user's skin whereas the other's is to enhance the user's scent. It can be argued that there is some overlap in method of use in that both parties' goods are applied to the skin, however, I consider that this is a superficial overlap. In respect of user, there is clearly some overlap in that both parties' goods will be sought by members of the general public at large. The goods are neither competitive nor complementary to each other. Lastly, in so far as trade channels are concerned, I consider it common in the trade that producers of cosmetics also produce perfume and deodorising goods. Further, the goods are likely all sold at the same retailers and, in larger retailers, the goods will be found in the same sections, albeit not on the same or adjacent shelves/aisles. Taking all of this into account, I am of the view that these goods are similar to between a low and medium degree.

51. In respect of the remaining cosmetic goods in the applicant's specification, being "cosmetic pencils", "eyeliner pencils", "eyeliners" and "make-up pencils", I consider that they share a level of similarity that is one step removed from the opponent's "perfumery" and "deodorising preparations for personal use" goods than those discussed in the preceding paragraph. While I accept that the overlap in trade channels and user remains, the overlap in method of use (albeit superficial above) does not. This is on the basis that these goods of the applicant are goods that cannot be said to be applied to the skin in the same way i.e. they will be 'drawn' onto the user's skin rather than sprayed or rubbed (as is the case with the applicant's goods discussed above and the opponent's goods). Overall, I consider that these goods are similar to a low degree.

52. "Sunscreen preparations" and "sunscreens [for cosmetic use]" in the applicant's specification are all types of skincare preparations used for the purpose of protecting the skin from sunburn. While not identical to "shower gels" in the opponent's specifications, I consider that there is some degree of similarity

between them. While the purposes of the goods differ, I consider that there is some overlap in nature and method of use in that both goods can include gels that are applied to the skin. However, that being said, any overlap in these factors is superficial given the distance in purpose between them. I consider that these goods also overlap in user but are not competitive or complementary to each other. In respect of trade channels, I do not consider that it is common in trade for a producer of sunscreen to also produce a shower gel, however, I consider that these goods will be sold by the same retailers and, where they are sold in larger retailers, they are likely to be found in the same sections. So while I consider there to be some overlap in trade channels, it is somewhat limited. Taking all of the above into account, I find that the overlap in user, the limited overlap and trade channels and superficial overlaps in nature and method of use are only sufficient to warrant a finding that these goods are similar to a low degree.

Class 35

53. In respect of retail services, when compared with the goods that they cover, I remind myself of the case of *Oakley, Inc v OHIM*, Case T-116/06, wherein the GC, at paragraphs 46 to 57, held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

54. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services versus goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services

for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are 'similar' to goods are not clear cut."

55. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*,¹¹ and *Assembled Investments (Proprietary) Ltd v. OHIM*¹², upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*¹³, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to

¹¹ Case C-411/13P

¹² Case T-105/05, at paragraphs [30] to [35] of the judgment

¹³ Case C-398/07P

exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

56. I appreciate that, for there to be similarity between the opponent's goods and the applicant's services, the goods being retailed by the applicant do not need to be exactly the same as the opponent's goods. Therefore, I am able to find similarity in respect of the goods and services at issue even if the opponent's goods are not the same as those retailed by the applicant.

57. As set out in the GC cases referred to above, although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore, similar to a degree. In my view, it is common for producers of the goods covered by the opponent's specifications, being "perfumery", "deodorising preparations for personal use" and "shower gels" to also retail in those goods. Additionally, I consider that those same producers will also retail in similar goods, such as those covered by the applicant's services (being a broader range of cosmetics, beauty products, toiletries and beauty implements). The applicant's services cover such a broad range of health and beauty goods and I consider that it is common in the trade for consumers to perceive that retailers of these goods to also retail in the goods covered by the opponent's specification, even if it can be said that they are not the same as those covered by the applicant's retail services. For example, a producer of these goods may operate its own retail stores that exclusively sell that producer's goods which will cover a wide range of goods in the health and beauty, cosmetic and perfumery sector (being those covered by both parties' specifications). Further, I also consider it common for large retailers to also produce and sell their own range of branded goods (again, this is likely to include those goods covered by both parties' specifications). In my view, the average consumer will be aware of the complementary relationship between the producer of goods such as "perfumery", "deodorising preparations for personal use" and "shower gels" and the retailing of the same and other types of health and beauty goods, cosmetics and toiletries. It follows that a medium degree of similarity exists between the applicant's services and the opponent's goods.

58. Lastly, I turn to the remaining class 35 services of the applicant, namely “providing consumer product information relating to cosmetics”, “providing consumer product advice relating to cosmetics” and “commercial information and advice services for consumers in the field of beauty products”. I have no evidence in relation to how these services are provided but, as far as I understand them, they are commonly provided to consumers in stores or other retail environments where sales assistants will provide advice and information in relation to make up and other beauty products. For example, such advice will relate to the suitability of the make up for the consumer’s skin complexion. While the goods offered by the opponent are different to the goods at issue under these services, I consider that there is a degree of similarity between them. This is on the basis that there is an overlap in user in that consumers who buy “perfumery”, for example, are also likely to be consumers for make-up or other cosmetics and may, therefore, seek advice or information in relation to the same. As for trade channels, I consider that they also overlap in that a retailer of cosmetic goods and, therefore, those retailers that provide consumers with the advice/information covered by these services, will also sell perfumery products. While the remaining factors all differ, I consider that the overlap in user and trade channels is sufficient to give rise to a low degree of similarity.

The average consumer and the nature of the purchasing act

59. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well

informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

60. In my view, the average consumer for the goods and services at issue will be members of the general public at large. The goods at issue will be available via retailers or their online equivalents, be that specialist or general, where they will be displayed on shelves and self-selected by the consumer. For online retailers, the goods will be displayed on webpages and will be selected by the consumer after having viewed an image of the products. In my view, the visual aspect will dominate the selection process, however, I do not discount the aural component playing a role by way of word of mouth recommendations or after discussions with sales persons or beauticians. Even where this occurs, the consumer will still review the products visually.

61. As for the services at issue, these are most likely to be selected having considered, for example, promotional material (in hard copy or online) and signage appearing on the high street. While visual considerations will be an important part of the selection process, the services are also likely to be the subject of word-of-mouth recommendations meaning that aural considerations will not be an insignificant feature of the selection process.

62. It is my understanding that the goods at issue are, for the most part, relatively low cost goods that are purchased relatively frequently. Turning to the level of attention, while some goods may be of low cost, they are all goods that are applied to the human body and, therefore, I am of the view that the goods will attract a medium degree of attention. I consider that the average consumer will consider several factors such as the ingredients of the goods, scents used (for perfumed goods), the compatibility with the user’s skin, the cosmetic and/or skin care benefits (for cosmetic goods) and whether they were tested on animals. As for the services at issue, these will also be selected relatively frequently as they will be sought when

the user is looking to buy goods such as those at issue. The services will be selected after considering factors such as stock, price of goods offered in comparison to other retailers and expertise/knowledge of staff. It is my view that the services will also attract a medium degree of attention during the selection process.

Comparison of the marks

63. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

64. 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.”

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

66. The respective trade marks are shown below:

The opponent's marks	The applicant's mark
<p data-bbox="347 253 746 342">BOSS ("the opponent's first mark")</p> <p data-bbox="379 412 715 595">BOSS HUGO BOSS ("the opponent's fifth mark")</p>	<p data-bbox="874 389 1369 448">L I M B O S S</p>

67. I have detailed submissions from the opponent in respect of the comparison of the marks at issue. I also note that the applicant made comments in its counterstatement in respect of the comparison of the marks. I do not intend to reproduce these here but confirm that I have taken them into account in making the following assessment.

Overall Impression

The applicant's mark

68. The applicant's mark is a figurative word mark that consists of the word 'LIMBOSS' in a standard black typeface. There are no other elements that contribute to the overall impression of the mark.

The opponent's marks

69. The opponent's first mark is a word only mark, made up solely of the word 'BOSS'. There are no other elements that contribute to the overall impression of the mark. As for the opponent's fifth mark, this is a figurative mark made up of two separate word elements. The first is the word 'BOSS', presented in a standard black typeface. This sits above the second word element, being the words 'HUGO BOSS' presented in the same (but considerably smaller) typeface. Given the size and placement of the word 'BOSS', it plays the greatest role in the overall impression of the mark, with 'HUGO BOSS' playing a lesser role.

Visual Comparison

70. Dealing first with the opponent's first mark, it shares the letters 'B-O-S-S' with the applicant's mark. These shared letters make up the entirety of the opponent's first mark. As a word only mark, the opponent's first mark can be used in any standard typeface and this extends to the typeface used by the applicant. The marks differ in the presence of the letters 'L-I-M' that sit at the start of the applicant's mark. I bear in mind that the average consumer tends to focus on the beginnings of marks¹⁴ and, as a result, the letters 'L-I-M' will have a significant impact on the visual comparison. Having said that, I find that the common element of 'BOSS', regardless of its position at the end of the applicant's mark, will still result in a finding that these marks are visually similar to between a medium and high degree.

71. Turning to the opponent's fifth mark, this also shares the letters 'B-O-S-S' with the applicant's mark. The typefaces used in these marks are, if not identical, highly similar. In this comparison, the shared letters do not make up the entirety of the opponent's fifth mark but do dominate its overall impression. The marks differ with the presence of the letters 'L-I-M' at the beginning of the applicant's mark and the presence of the words 'HUGO BOSS' at the bottom of the opponent's fifth mark. While these words play a lesser role in the opponent's fifth mark, they will still impact upon the visual comparison. That being said, the 'BOSS' element still dominates and will, in my view, result in these marks being visually similar to a medium degree.

Aural Comparison

72. The applicant's mark is made up of two syllables that will be pronounced 'LIM-BOSS'. The opponent's first mark is made up of just one syllable that will be pronounced 'BOSS'. Clearly there is some degree of similarity between the marks on the basis that the entire aural element of the opponent's first mark is identical to the applicant's second syllable. Following similar reasons to those discussed

¹⁴ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

when considering the visual comparison of these marks, I conclude that these marks are aurally similar to between a medium and high degree.

73. As for the opponent's fifth mark, I am of the view that the average consumer is unlikely to seek to pronounce the words 'HUGO BOSS'. I make this finding whilst bearing in mind the case of *Purity Hemp Company Improving Life as Nature Intended*¹⁵ wherein Mr Phillip Harris, sitting as the Appointed Person, stated that descriptiveness does not of itself render an element negligible or aurally invisible. I do not consider the same applies here because, while 'HUGO BOSS' is not descriptive, it is a partially repetitive verbal element that I do not consider that the average consumer will look to articulate having already pronounced the dominant word 'BOSS'. It does not seem logical to me that the average consumer will pronounce the mark 'BOSS HUGO BOSS'. As a result, I consider that the comparison in the preceding paragraph also applies to these marks in that they are aurally similar to between a medium and high degree. In the event I am wrong to conclude that 'HUGO BOSS' would not be pronounced then I consider these marks to be aurally similar to a low degree. This is because the aural elements of the opponent's fifth mark are twice as long as the applicant's and, while the common element is articulated twice in the opponent's fifth mark, this is still a point of difference. Further, the different elements (being 'LIM' at the beginning of the applicant's mark and 'HUGO' in the middle of the opponents' fifth mark) will also contribute as points of difference.

Conceptual Comparison

74. In its counterstatement, the applicant sets out that its brand was created by Ms Limor Segal who is known by her nickname 'Limbo' and that the marketing team of the applicant combined this with her family name, being Segal, to come up with the name 'LIMBOSS'. While that may be the case, the assessment I must make is based on the perception of the mark by the average consumer, not the intention behind the mark. Further, there is nothing before me in evidence pointing to any

¹⁵ Case BL O/115/22

widespread knowledge of this individual and her nickname 'Limbo' to the point that its use in the applicant's mark may be understood as having this intended meaning. This argument is, therefore, dismissed. I note that, at the hearing, the opponent sought to rely on the EUIPO decision (that I have discussed above) wherein the EUIPO acknowledged that some consumers would recognised the 'LIM' prefix as meaning 'Limited'. While I note the decision of the EUIPO, I am not bound by it and, in the present case, I see no reason why some consumers in the UK would view 'LIM' as being short for 'Limited. As far as I am aware, and I have no evidence to suggest otherwise, 'LIM' is not a commonly used abbreviation for 'Limited'. On the contrary, it is my understanding (and I appreciate that this may not be widespread but I have nothing to guide me otherwise and neither do I consider this a point of serious dispute)¹⁶ that it is often the case that 'Limited' is shortened to 'LTD', not 'LIM'. As a result, this argument is also dismissed.

75. An additional point raised by the opponent was a reference to the case of *Skype v OHIM*¹⁷ wherein the GC held that, when viewing the word 'Skype', the average consumer would identify the word 'Sky' within it, even if the remaining element of 'pe' had no meaning. This is in support of an argument that 'BOSS' (meaning either a person who is in charge of an organisation or a family name) will be understood even if 'LIM' is perceived as having no meaning. I do not agree that the majority of average consumers would view the word 'BOSS' within the mark because, even taking into account the *Skype* case, this would require an artificial dissection of the mark. For this majority, I find that the applicant's mark will be seen as a made up word with no obvious meaning. All that being said, I do consider it possible that a smaller, but still significant, proportion of average consumers would recognise the word 'BOSS' within 'LIMBOSS'. For those consumers, I find that there will be some conceptual connection to the meaning of that word, however, the applicant's mark will still have no obvious meaning as a whole. In terms of the meaning of 'BOSS', I accept the first meaning proposed by the opponent, being *a person in charge of an organisation*, will be widely understood but I am not convinced as to its meaning

¹⁶ *Chorkee Ltd v Cherokee Inc.*, Case BL O/048/08

¹⁷ T-184/13

as a family name. As far as I am aware, it is not a particularly common surname in the UK and I have nothing before me by way of evidence to suggest otherwise.

76. In comparing the applicant's mark with the opponent's first mark (the meaning of which will solely be understood as a person in charge of an organisation), my finding will differ depending on the understanding of 'LIMBOSS'. If it is understood as a made-up word, then these marks are conceptually dissimilar. However, for those consumers who identify the word 'BOSS' within the applicant's mark, then there will be some degree of similarity. While that may be the case, the mark as a whole still conveys no immediately graspable meaning, the connection to the word 'BOSS', while noted, will not be as dominant as it will be lessened by the conceptual ambiguity of 'LIM'. Overall, I consider that, in this scenario, these marks are conceptually similar to a medium degree.

77. Turning to the opponent's fifth mark, I note that I have found that 'BOSS' (solus) will not be understood as a family name. However, for this mark, I consider that it will be. This is on the basis that 'BOSS' is displayed in large typeface above the words 'HUGO BOSS', being words that will clearly be understood as an individual's name. The words 'HUGO BOSS' will, therefore, qualify the meaning of 'BOSS' that sits above it. Despite the shared use of 'BOSS', I find that even if it is identified in 'LIMBOSS', I do not consider that it will be understood as a reference to a name. Therefore, I consider that these marks are conceptually dissimilar.

Distinctive character of the opponent's marks

78. 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).”

79. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The opponent has claimed that its marks have acquired a high degree of distinctiveness character due to the use made of them. Before considering the position in respect of this claim, it is necessary to consider the inherent position.

80. The opponent argues that the inherent position in respect of its marks is that they are distinctive to a high degree. This is on the basis that the marks are neither allusive nor suggestive of a characteristic of the goods. While that may be the case, the marks will either be perceived as a well-known dictionary word (the opponent’s first mark) or a reference to an individual named ‘HUGO BOSS’ (the opponent’s fifth mark). The use of a well-known dictionary word or a name as the basis for a trade mark is not particularly remarkable so I see no reason why the inherent position should be high. Instead, I consider the inherent position in respect of both marks is that they are distinctive to a medium degree.

81. Turning to the argument of an enhanced degree of distinctiveness, this is something I can deal with briefly. In considering proof of use for these two marks, I provided a summary of the evidence at paragraphs 22 to 30 above. I do not intend to repeat the points here but, relying on that same summary, it is clear that the opponent operates an exceptionally large business with a UK turnover for 2017 to 2021 of £354.1 million and an advertising spend over that same time of £51,273,919. Further, its share in the fragrance market during this period ranged from 4.9% to 6.1%. Following on from my discussion on this point at paragraph 32 above, I find that this represents a significant market share. I have only been provided with five years of use, however, the turnover and advertising for 2017 was £57 million and £12 million, respectively. Such figures do not appear overnight and, while I cannot speak to the size of the use before this date, it is clear that, as at the start of 2017, the opponent was already operating a large business and it is reasonable to conclude that it had been using its marks for a number of years prior. Taking all of the evidence into account, I am satisfied that the evidence is sufficient to demonstrate that the opponent has acquired an enhanced degree of distinctiveness in both of its marks. I consider that the distinctiveness of both marks has been enhanced to a high degree but, due to the issues discussed at paragraph 33 above regarding the deodorant and shower gel goods of the opponent, this finding only relates to “perfumery” (in both marks) and “fragrant sprays” (in the first mark).

Likelihood of confusion

82. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective

goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

83. I have found the parties' goods and services range from being identical to similar to a low degree. I have found the average consumer for the goods to be members of the general public who will select the goods and services at issue via primarily visual means, although I do not discount an aural component playing a part. On this point, I refer to the case of *New Look*¹⁸ (which has also been cited by the applicant in its submissions) wherein the GC set out that where goods are selected by primarily visual means, the average consumer tends to attribute more importance to the visual similarity between marks. I have concluded that the average consumer will pay a medium degree of attention when selecting the goods and services at issue. I have found that the opponent's marks are inherently distinctive to a medium degree but that this has been enhanced to a high degree for "perfumery" and "fragrant sprays" as a result of the use made of the marks relied upon. While this is a factor that weighs in the opponent's favour, it does not automatically give rise to a finding of confusion. In respect of the similarity of the marks at issue, I have found that the applicant's mark is:

- a. visually and aurally similar to between a medium and high degree and either conceptually dissimilar or to a medium degree (if the consumer identifies 'BOSS' within the applicant's mark) with the opponent's first mark; and
- b. visually similar to a medium degree, aurally similar to between a medium and high degree (or low, depending on the pronunciation of the 'HUGO BOSS' element) and conceptually dissimilar (regardless of the identification of 'BOSS' in the applicant's mark).

¹⁸ *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03

84. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I am not convinced that the marks would be mistakenly recalled or misremembered for one another. While I appreciate that the applicant's mark consists of the letters 'B-O-S-S' that form the entirety of the opponent's first mark and the dominant element of its fifth, even to the point that it is presented in an identical (or at least highly similar) typeface as the fifth mark (and in a typeface that the first mark, being a word only mark, can be displayed in), I am of the view that 'LIM' at the beginning of the applicant's mark will allow the average consumer to correctly recall and remember the marks, particularly given the conceptual ambiguity it creates (even if 'BOSS' is identified). While it may be the case that the opponent's marks are highly distinctive as a result of their use, the clear difference presented by the beginnings of the marks element will still be noticed, regardless of how well-known the opponent's marks are. Consequently, I do not consider there to be any likelihood of direct confusion.

85. Turning now to consider a likelihood of indirect confusion, I am reminded of the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

86. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

87. In support of its claim to the existence of a likelihood of indirect confusion, the opponent submits that the applicant's mark may be seen as a 'limited edition' product line of the opponent. I have discussed above that I do not consider that the average consumer in the UK would see the letters 'LIM' as being short for 'Limited'. As a result, I see no basis for this argument. I fail to see why the average consumer

would believe that a company with highly distinctive marks that are dominated by the word 'BOSS' would extend its brand or create a sub-brand in such a way that it alters that highly distinctive element, i.e. by adding an element of unknown meaning (the letters 'LIM') to the beginnings of its marks so as to create a new, seemingly made-up word (albeit the word 'BOSS' may still be noticed). I do not consider that such an alteration would be considered consistent or logical. It seems to me that the opponent's best case for the existence of a likelihood of confusion is that discussed in category (a) of *L.A. Sugar* (reproduced above). On this point, I appreciate that the distinctiveness of 'BOSS' has been enhanced to a high degree (in relation to perfumery goods only), however it is still, at its core, an ordinary dictionary word with a well-known meaning. Therefore, I do not consider that its use is so strikingly distinctive that the average consumer would think no one else would use it. Lastly, even if the average consumer, upon being confronted by the applicant's mark on goods that are identical, was to call to mind the opponent's marks, this is mere association not indirect confusion.¹⁹ Consequently, I do not consider that there is any likelihood of indirect confusion between any of the marks at issue.

Final remarks on 5(2)(b)

88. In discussing my approach at paragraph 37 above, I stated that I would return to consider the position in respect of the opponent's remaining marks, if necessary. It is my view that the opponents' first and fifth marks represented its best case under the 5(2)(b) ground on the basis that they shared the greater degree of similarity with the applicant's mark (the additional elements of 'HUGO' in the second mark, additional figurative elements in the third mark and the words 'THE SCENT' in the fourth marks all serve as further points of difference). I see no reason why a consideration of the remaining marks would, all things being equal, result in a favourable finding for the opponent. Therefore, I do not consider it necessary to consider the remaining marks any further.

¹⁹ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

89. As a result of my findings above, the opposition under section 5(2)(b) fails in its entirety. I will now proceed to consider the remaining grounds of the opposition.

Section 5(3)

90. Section 5(3) of the Act states:

“5(3) A trade mark which –

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 repute of the earlier trade mark.”

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

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *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/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

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

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

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

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder 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*).

92. The conditions of section 5(3) are cumulative. There must be similarity between the marks, the opponent must also show that its marks have achieved a level of knowledge, or reputation, amongst a significant part of the public. The opponent must also establish that the public will make a link between the marks, in the sense of the earlier mark being brought to mind by the later mark. Assuming that these conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the opponent 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.

93. The relevant date for the assessment under section 5(3) is the date of the application at issue, being 14 December 2021.

Reputation

94. 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."

95. Under its 5(3) ground, the opponent relies on its first, second, third and fifth marks only. Under the 5(2)(b) ground, the opponent relied on a wider range of goods for each of its marks than it does here. I note that the only goods for which the opponent claims to enjoy a reputation in are "perfumery", "fragrances" and "perfumeries".

96. At the hearing, the opponent's representative set out that, when considering the 5(3) ground, it would focus on just three marks, being the first, third and fifth marks. Following the same reasoning discussed at paragraphs 36 and 37 above, I will proceed with considering the first and fifth marks only and will only return to consider the third mark if I consider it necessary to do so.

97. Before proceeding, it is necessary to point out that as the opponent's first mark is a comparable mark based on a pre-existing EUTM, use of the same in the EU prior to IP Completion Day (being 31 December 2020) is relevant to the assessment of the existence of a reputation. That being said, I do not consider this to be of any real relevance here. This is because, as per the case of *Pago International GmbH*

v Tirolmilch registrierte GmbH, Case C-301/07, an EU trade mark may be considered to have a reputation if it is known by a substantial part of the territory of the European Community and that the territory of a single Member State alone may be considered as satisfying that requirement. Further, I note the case of *Whirlpool Corporations and others v Kenwood Limited* [2009] ETMR 5 (HC), wherein Geoffrey Hobbs Q.C. confirmed that when assessing reputation in the EU, the UK is a substantial part of the same. While these cases were determined prior to the UK's departure from the EU, they remain relevant insofar as use in the EU is a relevant factor.

98. I have produced a summary of the opponent's evidence at paragraphs 22 to 30 above. While this was for the purpose of assessing whether there was genuine use of the opponent's first and fifth marks, the same evidence is relevant to this assessment. I do not intend to reproduce it here save to remind myself that between 2017 and 2021, the opponent's UK turnover was £354.1 million in respect of fragrances, deodorants and soaps. While deodorants and soaps are not relied upon under this ground, I consider it reasonable to infer that a proportion of the turnover for fragrances alone is still very significant. In support of this inference, I note that (1) the majority of the goods shown bearing the opponent's marks in its evidence are perfumery goods and (2) the evidence of market share (being between 4.9% and 6.1%) for these years is in relation to the fragrance sector, of which perfume is clearly a substantial part. For this same period, I also remind myself that the opponent incurred an advertising spend of £51,273,919. Again, I am satisfied that a very significant proportion of this figure relates to perfumery goods. These figures are clearly indicative of an exceptionally large business operation and while not particularly long standing (five years), I refer to my comments regarding the longevity of use at paragraph 81 above. I also bear in mind the significant press coverage and prominent advertising campaigns in the evidence. Taking all of the evidence into account, I am satisfied that the opponent enjoys a very strong reputation in the UK in its first and fifth marks in respect of the goods relied upon

Link

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

The degree of similarity between the conflicting marks.

100. As the marks at issue here are the same as those assessed under the 5(2)(b) ground above, I rely on the same findings here in that the applicant's mark is visually and aurally similar to between a medium and high degree and either conceptually dissimilar or to a medium degree (if the consumer identifies 'BOSS' within the applicant's mark) with the opponent's first mark and visually similar to a medium degree, aurally similar to between a medium and high degree (or low, depending on the pronunciation of the 'HUGO BOSS' element) and conceptually dissimilar (regardless of the identification of 'BOSS' in the applicant's mark).

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public.

101. My assessment under 5(2)(b) above was made in respect of a broader set of goods than those for which the opponent relies on under the present ground. Where I found identity or similarity between the applicant's goods and services and the opponent's "perfumery" goods, the same will apply here. As for those goods that I did not compare to "perfumery", these were "toiletries", "skincare preparations", "sunscreen preparations" and "sunscreens [for cosmetic purposes]". I consider that there is a low degree of similarity between these goods on the basis that there is an overlap in user and trade channels between them. Even if I am wrong on this point, I remind myself that for 5(3) oppositions to succeed, it is not necessary for the goods or services to be similar. On this point, I am of the view that the goods at issue all operate in broadly the same sector meaning that,

regardless of any degree of similarity between them, they share a degree of closeness.

The strength of the earlier mark's reputation

102. The opponent enjoys a very strong reputation in its marks.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

103. The opponent's marks enjoy a medium degree of inherent distinctive character. As a result of the use made of the marks, I have found that both marks are distinctive to a high degree to perfumery and fragrant sprays, being the goods at issue here.

Whether there is a likelihood of confusion

104. I have found above that there is no likelihood of either direct or indirect confusion.

Conclusion on link

105. While I have found no likelihood of confusion, this is not fatal to the existence of a link between the parties' marks. In the present case, I consider that this issue is overcome by the very strong reputation and high degree of distinctive character of the opponent's marks. Further, there is a degree of similarity between the marks in that, despite the presence of the letters 'LIM' at the beginning of the applicant's mark, they all share an identical element, being 'BOSS'. I remind myself that this is the sole element of the opponent's first mark and the dominant element of its fifth. While I appreciate that the typefaces used in both the applicant's mark and the opponent's fifth mark are standard, they are identical (or if not, highly similar). Further, as a word only mark, the opponent's first mark is capable of being presented in an identical typeface to the applicant's mark. On this point, I note that

the opponent's position is that the evidence shows extensive use of the same typeface. Taking all of this into account, together with the fact that the marks at issue will be viewed on identical or similar goods and services, I am of the view that a significant proportion of the relevant public concerned with the goods and services at issue will consider there to be a link between the marks. Alternatively, even if I am wrong to conclude that all goods and services at issue are similar, I consider that there will still be a link between the marks at issue. This is on the basis that (1) the goods and services still share a degree of closeness in that they operate in, broadly, the same sector and (2) the level of reputation and distinctiveness of the opponent's marks are significant enough to overcome any differences between the goods and services.

Damage

106. The opponent has pleaded that use of the applicant's mark would, without due cause, take unfair advantage of the reputation of the opponent's marks and/or be detrimental to the distinctive character or reputation of the opponent's marks. I will deal with each head of damage in turn below.

Unfair Advantage

107. While I note that I have found there to be no confusion in the present case, I am reminded of the case of *Lonsdale Sports Limited v Erol*, [2013] EWHC 2956 (Ch) wherein Norris J. rejected a claim that there was a likelihood of confusion between the appellant's mark and the respondent's mark. However, he found that:

"34. As I have said above, at a first glance the block of text in the Respondent's Mark looks like something that Lonsdale might be connected with (a first impression soon dispelled in the case of the average consumer). But that first glance is important. Those who look at the wearer of a product bearing the Respondent's Mark might not get more than a glance and might think the wearer was clad in a Lonsdale product. The creation of that illusion might be quite enough for the purchaser of a "look-alike" product: indeed who but such

a person would knowingly buy a "pretend" product? Further, it undoubtedly dilutes the true "Lonsdale" brand by putting into circulation products which do not proclaim distinctiveness but rather affinity with a reputable brand.

35. In my judgment the case under s.5(3) was made out on the evidence as found by the Hearing Officer."

108. I am of the view that a similar outcome will apply in the present circumstances. By applying to register a similar mark that uses the same highly distinctive and very strongly reputed element of the opponent in the same typeface that the opponent also uses, I consider that the applicant is going to benefit from a transfer of image from the opponent's marks onto its own. I accept that, on further inspection, it may be the case that the average consumer confronted by the applicant's mark would dispel any connection between the parties upon the recognition of the seemingly unknown element 'LIM', however, as per the case law set out above, the first glance is important. I find that a consumer may, upon seeing the applicant's mark on products or services that are identical or similar to the opponent's reputed goods, remind them of the opponent's marks. I find that this also applies to those goods that may be dissimilar on the basis that, as I have set out above, the opponent enjoys a very strong reputation and the parties operate in, broadly the same sector. So while there may be no likelihood of confusion between the marks, the creation of the illusion that the applicant's mark is connected with the opponent's mark is such that it would achieve instant familiarity in the eyes of a significant proportion of the relevant public, thereby securing a commercial advantage and benefitting from the opponent's reputation without paying financial compensation. Such commercial advantage would not exist were it not for the very strong reputation of the opponent's marks. Therefore, I find it likely that the applicant's mark, when used on all of the goods and services applied for, takes unfair advantage of the opponent's marks.

Detriment to distinctive character

109. As damage is made out on the basis of unfair advantage, I do not consider it necessary to go on to consider the opponent's other heads of damage. However, for the sake of completeness, I will briefly consider detriment to distinctive character on the basis that, as per the reasoning set out in the passage of *Lonsdale* reproduced above, the presence of the applicant's mark undoubtedly dilutes the true 'BOSS' brand by putting into circulation products which do not proclaim distinctiveness but rather affinity with a reputable brand by sharing the same 'BOSS' element in the same (albeit standard) typeface that is associated with the opponent's reputed marks. In these circumstances, I consider that there is a serious risk that detriment to distinctive character would occur.

Final remarks on 5(3)

110. As the opposition based upon section 5(3) succeeds in its entirety, I see no reason to return to consider the opponent's remaining marks on the basis that it will not further the opponent's position.

CONCLUSION

111. While the opposition has failed in respect of the 5(2)(b) ground, it has succeeded in full in respect of the 5(3) ground and, therefore, the application is refused in its entirety.

COSTS

112. As the opponent has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. Despite the fact that the opponent has only succeeded in respect of one of its grounds, I consider that a full costs award is appropriate. In the circumstances, I award the opponent the sum of **£1,700** as a contribution towards its costs. The sum is calculated as follows:

Preparing a notice of opposition:	£200
Preparing evidence:	£500
Preparation for and attendance at a hearing:	£800
Official fees:	£200
Total:	£1,700

113. I hereby order LIMBOSS PTE. LTD. to pay HUGO BOSS Trade Mark Management GmbH & Co. KG. the sum of £1,700. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 30th day of May 2023

A COOPER
For the Registrar