

**IN THE MATTER OF A TRADE MARK APPLICATION T98/12444A
BY REEMTSMA CIGARETTENFABRIKEN GMBH**

AND

**OPPOSITION THERETO BY
HUGO BOSS AG**

*Before Principal Assistant Registrar Ms Lee Li Choon
3, 4 August 2009*

Trade Marks – Opposition to registration – likelihood of confusion – bad faith – whether opponents’ expunged marks block registration of Application Mark – whether opponents’ expunged marks are considered earlier marks under section 23 of the old Trade Marks Act 1991 - whether the Application Mark should be refused registration under Section 23, 15 and 12 of the Trade Marks Act (Cap. 332) 1991 Rev. Ed.

Trade Marks – Opposition to registration – whether opponents’ expunged marks block registration of Application Mark – whether opponents’ expunged marks are considered earlier marks under section 23 of the Trade Marks Act (Cap. 332) 1991 Rev. Ed.

Trade Marks – Opposition to registration – whether use/proposed use of the Application Mark in respect of the proposed specification is likely to deceive or lead to the belief that there is some connection and/or association between the Applicants’ goods and the Opponents’ goods when, in fact no such connection and/or association exists – whether registration of the Application Mark would be contrary to section 15 of the Trade Marks Act (Cap. 332) 1991 Rev. Ed.

Trade Marks – Opposition to registration – whether the Applicants can claim to be bona fide proprietors of the Application Mark- whether registration of the Application Mark would be contrary to Section 12(1) of the Trade Marks Act (Cap. 332) 1991 Rev. Ed.

This is an opposition against the trade mark application T98/12444A by Reemtsma Cigarettenfabriken Gmbh for the word mark, “BOSS” in class 34 for use on “tobacco, tobacco products, particularly cigarettes and cigarillos, smoker’s articles, matches; all included in Class 34” (hereinafter referred to as “the Application Mark”). The date of application was 14 December 1998.

The Applicants have a long history of dealing in cigarettes and cigars that dated as far back as 1910. To date, the Applicants are trading in more than 100 countries. Currently, there are numerous applications/registrations by the Applicants for the mark “BOSS” in many countries throughout the world. The Applicants have been selling cigarettes and tobacco products under the name “BOSS” outside of Singapore since early 1987. This business was first started in Slovenia and now, cigarettes, tobacco related products and accessories bearing the trade mark “BOSS” have been sold and marketed in many other countries throughout the world including Albania, Bosnia-Herzegovina, Croatia, Czech Republic, Hungary, Kosovo, Kyrgyzstan, Macedonia, Malaysia, Slovakia, Taiwan, Ukraine, Vietnam and various African countries.

The Opponents, Hugo Boss AG, originated as a family firm in Germany some 70 years ago. The main business of the Opponents started out as the design, manufacture and sale of traditional high fashion menswear under, inter alia, the trade marks, “BOSS”, “HUGO BOSS” and “BOSS/HUGO BOSS”. From 1983 onwards, the Opponents have continually expanded and been diversifying from its traditional high fashion menswear into other areas and product lines, including the following goods – scarves, perfumes, spectacles, small leather items, umbrellas, watches, jewellery and cuff-links, bed linen, plaid/tartan blankets, bicycles, lighters, leather cigar holders and cigars, luggage, travel bags, suitcase, briefcases. The Opponents first started trading in Singapore in August 87. Over the years, more BOSS outlets were opened in Singapore. There were 8 outlets opened before 1998, all of which are BOSS outlets except for one Hugo outlet. The range of goods offered by the BOSS stores include suits, jackets, coats, blousons, shirts, pants, ties, polos, tshirts, bodywear, sweatshirts, knits, belts, shoes, bags, watches, eyewear, fragrances and lifestyle accessories such as cashmere throw, vase. The Opponents own numerous applications and registrations in various classes worldwide. In Singapore, the Opponents have about 59 registrations or applications for the various combinations of “BOSS”, “HUGO BOSS”, “BOSS/HUGO BOSS”, “HUGO” from as early as 1974 including two registrations T74/59825G and T87/05010G in Class 34 for tobacco products which have since, 5 February 2002, been revoked on the basis of non-use. The registrations and applications in Singapore cover a wide range of goods including Class 9 (spectacles), Class 14 (jewellery, clocks,

watches), 16 (paper products), 18 (leather belts, bags, trunks, suitcases), 24 (textiles, fabrics), 25 (clothing), 26 (haberdashery), 28 (sports articles, toys), 35 (retail services), 38 (telecommunications services), 42 (professional consultancy services relating to shop front layout).

Held, disallowing registration:

1. The point in time to consider whether there are “marks already on the register” for the purposes of section 23 is when the Registrar decides whether a mark can be registered. Thus, if at that point, the Opponents’ earlier registrations T74/59825G and T87/05010G are no longer subsisting and valid, they do not stand against the registration of the Application Mark as earlier “marks already on the register” for the purpose of section 23. In this case, as the Opponents’ earlier registrations T74/59825G and T87/05010G ceased to have effect as from 5 February 2002, they no longer stand as “marks already on the register” to block the registration of the Application Mark under section 23 of the Trade Marks Act, Cap 332, 1991 Rev Ed. at this point in time.
2. By virtue of the Opponents’ international reputation and reputation in Singapore for the mark, “BOSS” for a wide variety of goods, and in the absence of any trade by the Applicants for cigarettes carrying the name “BOSS” in Singapore as at the date of application of the Application Mark, as at the date of application of the Application Mark, the Applicants’ use of the mark “BOSS” on cigarettes would cause a number of reasonable members of the Singapore public to wonder whether it might not be the case that the two products come from the same source, i.e., the Opponents and thus result in a tangible likelihood of confusion or deception. The likelihood of confusion is accentuated in light of the fact that whilst the Opponents have started trading in a wide range of goods through “BOSS” outlets in Singapore since 1987, the Applicants have not started trading in Singapore using the “BOSS” mark for cigarettes as at the date of application of the Application Mark. It is to be noted that Section 15 is not meant to protect traders as such but the public from confusion and deception. It is also to be noted there are a number of well-known brands such as Cartier and YSL in relation to men’s goods that have branched out into the tobacco trade. Registration of the Application Mark therefore contravenes section 15 of the Trade Marks Act, Cap 332, 1991 Rev Ed. The Application Mark shall therefore not be registered.
3. There is no evidence of dealings or conduct on the part of the Applicants which falls short of the standards of acceptable commercial behaviour observed by reasonable and experienced men. There is also no evidence of misappropriation by the Applicants as required for a finding of bad faith under section 12. Bad faith is a serious allegation and the Opponents must prove such is the case specifically and distinctly. There is therefore no reason to disallow the registration of the Application Mark under section 12 of the Trade Marks Act, Cap 332, 1991 Rev Ed.

Provisions of legislation discussed:

- Trade Marks Act (Cap. 332) 1991 Rev. Ed., sections 23, 15 and 12

Cases referred to:

- Reemtsma Cigarettenfabriken GmbH v Hugo Boss AG [2003] 4 SLR 155
- Kambly SA Specialities de Biscuits Suisses v Intersnack Knabber-Geback GMBH & Co KG [2004] EWHC 943 (CH), [2004] All ER (D) 331
- Keraion Trade Mark [1977] RPC 588
- Polymat Trademark [1968] RPC 124 s Co’s Application [1915] 32 RPC 442
- Transpay Trade Mark (2001) RPC 10
- Reveria Trade Mark [2003] RPC 50
- Ideal Home Limited v IPC Media Limited (Case O-050-06, 14 February 2006)
- Omega Engineering Inc [2003] FSR 49
- Kellogg Co v Pacific Food Products Sdn Bhd [1999] 2 SLR 651; [1998] SGCA 72
- Bali Trade Mark [1969] RPC 472
- Playboy Pte Ltd v Playboy Enterprises Inc [1999] SGIPOS 2
- Harrods Limited v Harrodian School Limited [1996] RPC 697
- British Sugar Plc v James Robertson & Sons Ltd [1996] RPC 281.
- Pianotist Co.’s Application [1906] 23 RPC 774
- The Polo / Lauren Co, LP v Shop-In Department Store Pte Ltd [2006] 2 SLR 290
- Florence Line SRL v Advance Magazine Publishers Inc [1995] AIPR 642
- Smile Inc Asia Pte Ltd v Britesmile International Ltd [2004] SGIPOS 1
- McDonald’s Corp v. Future Enterprises Pte Ltd [2005] 1 SLR 177
- Tiffany & Company v. Fabriques de Tabac Reunies S.A. [1999] 3 SLR 147

- Superbowl Golf School & Country Club Pte Ltd v National Football League Properties Inc. [2007] SGIPOS 14
- Smith, Hayden & Co Ltd's Application (1946) 63 RPC 97
- Alfred Dunhill Limited v. Sunoptic S.A. [1979] F.S.R. 337
- Sabel BV v Puma AG [1998] RPC 199
- Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B V [2000] FSR 77
- Rothmans of Pall Mall Limited v Maycolson International Ltd [2006] 2 SLR 551
- Samsonite Corp v Montres Rolex SA [1995] AIPR 244
- Hyundai Mobis v Mobil Petroleum Company, Inc [2008] SGHC 104
- Application by Brown Shoes Company Inc. for Rectification of the Register in respect of Trade Mark No.B.720,262 [1959] RPC 29
- "Royal Enfield" Trade Marks [2002] RPC 24

Representation:

- Mr Loh Chai Chong and Ms Catherine Lee from M/s Rodyk & Davidson for the Applicants
- Mr Paul Teo and Ms Eileen Chong from M/s Drew & Napier for the Opponents