

This article was published in the *World Trademark Review* on November, 4 2013.

Hugo Boss defeated in BabyBoss case

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On September 12, 2013 the Intellectual Property Court rendered a decision in favor of BabyBoss City Limited (BabyBoss) in a trademark dispute case involving "BabyBoss" and "HUGO BOSS".



BabyBoss registered the trademark "  " for confectionery products in Class 30. HUGO BOSS Trade Mark Management GmbH & Co. KG (Hugo Boss) filed an action with the Intellectual Property Office (IPO) to invalidate the registration. The invalidation action was based on the fame of their BOSS related trademarks, including BOSS, HUGO BOSS, covering a variety of goods and services. To support the action, Hugo Boss submitted voluminous materials attesting to worldwide trademark registrations, sales and promotion of trademarked products, versatile business operation.

BabyBoss defended the action based on the grounds that 1) both parties' trademarks are not similar in their entirety; 2) confectionery products are not related to HUGO BOSS famous products, such as clothing, watches, brief cases, etc.; and 3) BOSS is a commonly seen word, thus less distinctive in the judgment of the conflict between trademarks.

The IPO concluded that there is likelihood of confusion among general consumers in the use of BabyBoss and BOSS or HUGO BOSS in the marketplace, thus ruled to invalidate the registration of the subject trademark. The appellant authority upheld the decision.

Dissatisfied with the decisions, BabyBoss filed a suit with the Intellectual Property Court, which then revoked the decisions and ruled in favor of BabyBoss. While recognizing the fame of Hugo Boss trademarks, the Court was not convinced that there would be likelihood of confusion among consumers regarding the source of trademarked products because the similarity of the trademarks concerned in their entirety was minor, the products of both parties were not related whatsoever and there is no evidence of actual confusion.

The Court's judgment is significant because it explicitly contradicts a judgment rendered by a different tribunal of the same Court three months earlier, 120-ShienSanSu-22, June 20, 2013. The June decision was rendered on an opposition action between identical parties but against the word mark "BabyBoss" for confectionery products in Class 30. In the word mark case, the Court dismissed the suit filed by BabyBoss City Limited and upheld the IPO's decision in cancelling the word mark registration on the grounds of likelihood of confusion. The tribunal, which rendered the September decision, specifically elaborated the reason why it held differently from the June decision is due to different specimens of trademark at issue. While both marks at issue contain the identical word "BabyBoss", the device mark of the September decision contains in large part three cartoon characters, which greatly distinguishes purely word mark of June decision case.

It is envisaged that Hugo Boss will appeal against the September decision to seek clarification. It would be interesting to follow up the case.

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