

O-123-06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2272753B
BY ALOHA SURFBOARDS PTY LIMITED
TO REGISTER THE TRADE MARK:**



IN CLASSES 3 AND 16

AND

**THE OPPOSITION THERETO
UNDER NO 90944
BY MAJOR LEAGUE BASEBALL PROPERTIES, INC**

Trade Marks Act 1994

**In the matter of application no 2272753B
by Aloha Surfboards Pty Limited
to register the trade mark:**



**in classes 3 and 16
and the opposition thereto
under no 90944
by Major League Baseball Properties, Inc**

BACKGROUND

1) On 16 June 2001 Aloha Surfboards Pty Limited, which I will refer to as Aloha, applied to register the trade mark:



(the trade mark). On 25 March 2002 Aloha applied to have the specification of the application divided into two parts; subsequently, application no 2272753B was published for opposition purposes in the "Trade Marks Journal" on 15 May 2002 with the following specification:

shower gels, body sprays, shampoo, soaps, hair lotions and gels, essential oils and perfumery;

book binders, pencil/stationery cases, stationery, artists' materials.

The above goods are in classes 3 and 16 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 14 August 2002 Major League Baseball Properties Inc, which I will refer to as Major, filed a notice of opposition. Major is the owner of United Kingdom registration no 2248246 of the trade mark:



It is registered for the following goods and services:

athletic bags, overnight bags, backpacks, duffel bags, tote bags, knapsacks, attache cases, briefcases, purses, handbags, wallets, billfolds, fanny packs, waist packs, cosmetic cases sold empty, toiletry cases sold empty, key cases, luggage, suitcases, garment bags for travel, trunks for travelling, umbrellas, canes, card cases, dog collars and dog leashes;

clothing; caps, hats, visors, knitted headwear, headbands, bandannas, shirts, t-shirts, tank tops, sweaters, turtlenecks, pullovers, vests, shorts, pants, dresses, skirts, overalls, bodysuits, baseball uniforms, jerseys, warm-up suits, sweatshirts, sweatpants, underwear, boxer shorts, robes, sleepwear, swimwear, clothing wraps, coats, jackets, ponchos, raincoats, cloth bibs, infant wear, infant diaper covers, cloth diaper sets with undershirt and diaper cover, jumpers, rompers, onesies, coveralls, creepers, baby booties, ties, suspenders, belts, money belts, mittens, gloves, wristbands, earmuffs, scarves, footwear, socks, hosiery, slippers, aprons, sliding girdles and costumes;

toys and sporting goods; stuffed toys, plush toys, bean bag toys, bean bags, puppets, balloons, marbles, checker sets, chess sets, board games, dart boards and dart board accessories, toy cars and trucks, toy mobiles, puzzles, spools incorporating coiled string which rewind and return to the hand when thrown, toy banks, toy figures, dolls and doll accessories, inflatable baseball bats, decorative wind socks, toy tattoos, flying discs, mini bats, neck and wrist lanyards for mini bats, mini baseballs, toy figures and sports whistles, video game cartridges, hand held video and electronic games, coin-operated pinball machines, baseballs and holders for baseballs, autographed baseballs, basketballs, footballs, playground balls, rubber action balls, golf balls, golf club covers, golf club bags, golf putters, bowling balls, bowling bags, baseball bases, pitcher's plates, baseball bats, catcher's masks, grip tape for baseball bats, baseball batting tees, pine tar bags for baseball, rosin bags for baseball, batting gloves, baseball gloves, mitts, umpire's protective equipment, chest protectors for sports, athletic supporters, baseball pitching machines, fishing tackle, swim floats for recreational use, party favors in the nature of noise makers, and Christmas tree ornaments;

entertainment, education and information services; baseball games, competitions and exhibitions rendered live, through broadcast media including television and radio and via a global computer network or a commercial on-line service; providing information in the field of sports, entertainment and related topics, providing multi-

user interactive computer games, and providing for interactive exchange of messages and information, all via a global computer network or a commercial on-line service.

The above goods and services are in classes 18, 25, 28 and 41 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

3) Major states that it has made substantial use of its trade mark in the United Kingdom through the sale of baseball caps and other official merchandise bearing the trade mark since 1991. Major claims that the trade mark has been used in the United Kingdom in advertising and by way of media coverage in the United Kingdom since 1997 of the Atlanta Braves team. It claims that as a result of such use it has built up a substantial reputation in the trade mark both in relation to the merchandise on which it has been used and more generally.

4) Major states that the overall impression of the respective trade marks is substantially the same. It claims that the goods of the application are similar to the goods and services encompassed by its registration.

5) Major claims that owing to the similarity of the respective trade marks, the similarity of the respective goods and services, and the established and substantial reputation in its trade mark that there is a likelihood of confusion and registration of the trade mark would be contrary to section 5(2)(b) of the Trade Marks Act 1994.

6) Major states that to the extent that it is found that any of the goods specified in the application are dissimilar to the goods and services of its registration, that use of the trade mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of its trade mark. Consequently, registration of the trade mark would be contrary to section 5(3) of the Act.

7) Major states that owing to its established goodwill and reputation in its trade mark, the strong similarity between the respective trade marks, and the fact that the goods such as those applied for by the applicant are typically the subject of merchandising activities, it is submitted that use by the applicant of the trade mark would be likely to cause confusion amongst the relevant members of the public as to the origin of the goods being sold, amounting to a misrepresentation that the goods being sold by Aloha are in some way related to Major. This misrepresentation would in turn result in direct damage to Major in terms of loss of sales and/or damage to its goodwill in its trade mark by way of dilution or tarnishment. Major submits that use of the trade mark by Aloha is liable to be prevented by virtue of the law of passing-off and that registration of the application would be contrary to section 5(4)(a) of the Act.

8) Major seeks the refusal of the application and an award of costs.

9) Aloha filed a counterstatement. It denies the claims made by Major and in particular gives a detailed analysis as to the reasons why the respective goods and services are not similar. It requests the registration of the application and an award of costs.

10) Both sides filed evidence.

11) A hearing was originally appointed for 26 October 2005. Subsequently the sides requested a postponement of the hearing as settlement negotiations were taking place. The hearing was rescheduled for 30 November 2005. The two sides again requested a postponement and the hearing was rescheduled for 25 January 2006. The two sides again requested a postponement. The hearing was reappointed for 15 March 2006. In the notification the sides were reminded of the comments of Jacob LJ in *Bongrain SA's Trade Mark Application* [2005] RPC 14 and Pumfrey J in *Eleven Inc v Helshaw Food Products Ltd* [2002] WL 819953 about delays in applications before the registrar. They were advised that no further postponements of the hearing would be countenanced. On 2 March 2006 a further request for a postponement was received. The request was refused. The sides then requested that a decision from the papers be given.

EVIDENCE

Evidence of Major

12) This consists of an affidavit made by Ethan G Orlinsky. Mr Orlinsky is the corporate secretary of Major. Parts of Mr Orlinsky's affidavit represent submission and assertion rather than evidence of fact. I will generally confine my summary of his evidence to what can be considered to fall within the parameters of evidence of fact.

13) Mr Orlinsky states that the opposition is based upon the worldwide fame and fame in the United Kingdom of the Atlanta Braves Major League baseball club (the Atlanta Braves) and the MLBP Atlanta Braves A stylised trade mark. Exhibited at B is a copy of the Major trade marks. This exhibit shows the trade mark which is relied upon in the grounds of opposition; it also shows another trade mark.; this consists of the same basic letter A, however, it is fatter and is white with a black outline.

14) Mr Orlinsky states that Aloha's trade mark is a deliberate copy of Major's trade mark. (This is matter of assertion, no evidence has been submitted to show that Aloha copied Major's trade mark.)

15) Mr Orlinsky states that like many companies Major's merchandising programme includes hundred of licensees worldwide who have been granted the right to manufacture and sell a wide range of products bearing the trade marks of Major League baseball clubs, including goods in classes 3, 16, 18, 20, 21, 25, 28, 29, 30 and 31. Mr Orlinsky states that well known examples of this diversified merchandising practice are Hermès, Ralph Lauren and the World Wrestling Federation, whom, he states, distribute goods in classes 3, 16, 18 and 25.

16) Mr Orlinsky states that a review of the official website for Major and the Atlanta Braves club show that notebooks, portfolios, calendars, memo books, assignment planners, pens and pencils designated by Major's trade mark are offered for sale. Exhibited at D are pages downloaded from the MLB.com website on 11 April 2004. All the prices that are shown are in dollars. Most of the exhibits show use of signs other than that of Major's trade mark eg Braves. Where the letter A does appear in the basic format of the trade mark it is not in black. It appears in red on the cover of a "non-dated combo pack", in white or in outline on calendars, in red on an assignment

planner, in red on notebooks, portfolios and memo books, in white on a cap. As far as can be seen from the printouts, which are not always very clear, the letter A would always appear to be used in conjunction with other signs.

17) Mr Orlinsky states that many companies who distribute class 16 goods, such as Filofax, Dunhill, Montblanc and Cross, are equally well known for their class 18 goods. Exhibited at E are pages downloaded from the Internet on 22 November 2004. A page from the Filofax website shows refills for personal organisers, personal organisers, bags, briefcases etc.. Pages from the Dunhill website show a case and a pen. Pages from the Montblanc website show pens and bags and indicate that belts, diaries, pouches and cases are available. Pages from the Cross website show pens and a bag and indicate that pencils, watches, key rings, luggage tags are available. Prices are given on the pages, they are in dollars. A page from the Harrods website refers to pens, stationery and leather goods.

18) Mr Orlinsky states that Major produces several types of class 16 goods which bear the trade marks of baseball clubs, including the trade mark upon which it relies in this case. He states that such goods include programmes, books and magazines which are intended to capture “famous Class 41 baseball game services in print medium”. He states that information contained in Major’s game programmes, books and magazines may be the same information or content that is found on Major’s website.

19) Mr Orlinsky exhibits at F pictures of the packaging of a toothbrush. The rear of the packaging shows the letter A in red and the word Braves, the front of the packaging appears to simply show the word Braves. Mr Orlinsky states that the close relation between class 3 goods and class 18 goods can be seen in the common merchandising practice of world renowned retailers (sic) such as Ralph Lauren, Lancôme, Clinique, Sephora and Estée Lauder who, he states, sell toiletry cases and aftershaves or colognes under the same trade mark. Exhibited at G are pages downloaded from the Internet in 2004; where there are prices, they are in dollars. The printouts show Ralph Lauren eau de toilette, after shave, antiperspirant and travel kit; various Clinique personal care products, a gift collection of shaving products includes a grooming bag; Sunset & Doheny palette and brush set; a set of Dior cosmetics that come with a boudoir bag; PCH & Malibu lip gloss set. Also included in exhibit G are copies of advertisements from unidentified sources. They relate to Lancôme and Estée Lauder personal care sets that come with bags and cases. All of the advertisements relate to shops in the United States of America. At H pages downloaded from the Internet in November 2004 are exhibited. These relate to Michael Jordan goods, one printout shows a toiletry travelling case in which there are articles for grooming. Another page shows a set that comprises an EDT spray, soap and a tote bag. The goods are all priced in dollars. Exhibited at I are pages downloaded from the Internet in November 2004. One page shows Harrods cosmetic purses and bags and another Harrods toiletries. A page downloaded from the FCUK website shows a men’s weekend kit which comprises deodorising body spray, antiperspirant, shave gel and body wash. There is no written reference to a bag but one can be seen with the products. Pages from the Debenhams website show a manicure bag that includes nail fortifier, nail varnish, nail file and manicure tools and a wash bag and purse which contain various toiletries. Finally there are pages from the M&S website. These show several bags and a box, all of which are sold

containing toiletry articles. The material exhibited at I emanates from the United Kingdom.

20) Mr Orlinsky states that it is common merchandising practice for companies to expand the use of their trade marks from class 3 goods to class 25 goods and vice versa. Mr Orlinsky states that Major used its trade mark in the United Kingdom and around the world on the broad range of goods covered by its class 25 specification. In support of this claim he exhibits at J pages downloaded from Major's website on 22 November 2004. All of the goods are priced in dollars. The goods shown are a headband wrist set, a tee shirt, baseball caps, a chemise and shorts (underpants in British English); Major's trade mark, in various colours, is displayed prominently on the products. Mr Orlinsky states that there are many famous clothing designers who sell perfumes and/or cosmetic goods under their well-known trade marks, such as Chanel, Escada, Calvin Klein, Dolce & Gabbana and Donna Karan. Exhibited at K are various pages downloaded from the Internet in November 2004, where prices of goods are shown, they are in dollars. The printouts show various personal care products such as eau de toilette sold under the trade marks referred to in the previous but one sentence. The pages from the Chanel website show shoes, bags, purses and key holders.

21) Mr Orlinsky states that the Atlanta Braves club was founded in 1876 and played first in Boston and then Milwaukee, moving to Atlanta in 1966. He states that since 1966 the club has been publicly referred to as the Atlanta Braves. Exhibited at L is a variety of documentation relating to the history of the club. Pages downloaded from the Internet mainly refer to the Braves, on certain pages Major's trade mark in white on a blue background appears. Exhibited at M are pages from a publication showing baseball uniforms, these show the various kits worn by the club. The front of the shirts either show Braves or Atlanta, since 1987 there is a tomahawk beneath the wording. Major's trade mark in white appears on certain of the caps since 1969. It appears from the reproduction that it was not until 1987 that the trade mark, in white, appeared on both home and away baseball caps.

22) Mr Orlinsky states that since 1992 retail sales throughout the world of merchandise bearing various of Major's trade marks have exceeded US \$1,455,000,000; these sales include trade marks associated with or promoting the Atlanta Braves club.

23) Mr Orlinsky states that at N are exhibited print advertisements for goods bearing Major's trade mark which have appeared in foreign (ie non United States) publications. He states that some of these are published in the United Kingdom. The publications are as follows:

- "High 5", which describes itself as "the US pro sports monthly", of January 1995. It has a price in sterling. Pictured on the cover and in an article is a Greg Maddux. He is shown in both photographs wearing a baseball cap with Major's trade mark in white. An advertisement by Stateside American Sportswear, based in Derby, includes various of Major's baseball caps including one bearing its trade mark in white. The rubric to the advertisement refers to Braves.

- “GQ Active” for Autumn 2000. I cannot see any link to Major in this part of the exhibit.
- “The Face” from an unknown date, although there is a reference to 2001 on the cover. Two advertisements for products of Major are exhibited. They both include a man wearing a baseball jacket with Braves and a tomahawk across the front of it.
- A page with no provenance showing various baseball caps for sale, including that of the Atlanta Braves with the trade mark in white upon it.
- An advertisement from a Mexican publication in Castellano. This shows a baseball cap of the Atlanta Braves with the trade mark in white upon it.
- Photographs showing various Major merchandise in a Decathlon (sic) shop in France.
- A publication in German.
- An advertisement for “USA Today”, which promotes getting the latest baseball news from the USA via the publication. The mail address is in London. There are various pictures of baseball players, one of whom is sporting a cap of the Atlanta Braves with the trade mark in white upon it.
- A publication called “Double Play”, which is for those in the United Kingdom with an interest in baseball and softball. The publication would appear to emanate from 2000. There is an advertisement for Hallmark Cards which shows a paper bag with a number of Major’s logos upon it, including the trade mark in white.
- A publication in French.
- “Double Play for Summer 2001. In this publication is an advertisement for various baseball caps, including one of the Atlanta Braves with the trade mark in white upon it.

24) Mr Orlinsky exhibits at O Internet advertisements. Mr Orlinsky states that one on-line retailer is TA Sports, a company developed and promoted by BaseballSoftball UK to sell Major’s equipment and merchandise. All of the material exhibited, with the exception of two pages downloaded on 24 March 2003, was downloaded in the latter half of 2004. Certain of the pages exhibited can be identified as relating to the United Kingdom through such things as United Kingdom Internet addresses, prices in sterling or United Kingdom addresses. The goods displayed on such pages bearing Major’s trade mark in white upon them are: baseball caps and a casual jacket.

25) Mr Orlinsky states that Major’s licensed merchandise, including products bearing its A trade mark, have been sold directly in the United Kingdom through such shops as Allsports, Intersport GB Ltd, JD Sports, Lillywhites, Champion Sport, JJB Sports, Sports Connection, Gilesports Plc, Tripleplay UK, Hargreaves and Sports Pages. Exhibited at P are yearly reports detailing sales of goods bearing trade marks designating the Atlanta Braves club. From my calculations the sales of goods for the period from January 1998 to June 2002 was as follows:

headwear, caps and hats: 2462;
 pro-style (it is not known what this refers to): 68;
 jerseys: 86;
 t-shirts: 17;
 athletic apparel: 31;

banners: 3;
pennants: 156;
bumper strips 416.

There is no indication as to which trade mark(s) the goods bear.

26) Mr Orlinsky states that the official Major League Baseball website promotes Major League Baseball professional baseball and the individual Major League Baseball clubs, including the Atlanta Braves. The website provides information about Major League Baseball games, events and players. He states that there are written, audio, televised and Internet new stories on a variety of baseball related topics, some of these feature Atlanta Braves players wearing caps bearing Major's trade mark. Mr Orlinsky states that the website features live video and audio coverage of Atlanta Braves' games. Mr Orlinsky exhibits at Q further printouts from Major's website, downloaded in 2004. A number of the pages show various goods, all of which are priced in dollars.

27) Mr Orlinsky states that the official Atlanta Braves website prominently features Major's trade mark. He states that this website offers an abundance of news, information, audio/visual materials, products, on-line message boards, screen savers, e-mail, ticket sales, interactive games and interactive fantasy baseball leagues, all relating to the Atlanta Braves club. Exhibited at R are various pages downloaded from the website in late 2004. Many of the pages feature Major's trade mark in red or white, either on the page or on goods that are being sold: baseball hats, bib, notebooks, portfolios, memo books, planners and photographs.

28) Mr Orlinsky states that Major's Internet sites are accessible in the United Kingdom. He goes on to state how they could be accessed and exhibits at S a list of Internet cafés in the United Kingdom.

29) Mr Orlinsky states that Major's trade mark has been prominently displayed during Major League Baseball game broadcasts featuring the club. He states that Major League Baseball games, including games featuring the Atlanta Braves, have been broadcast worldwide, including to the United Kingdom, by network, local over-air cable or pay TV telecasts. Material relating to this is exhibited at T. This indicates that in 2001 two regular season Major League games were broadcast live on Wednesday and Sunday in the United Kingdom by Channel 5. As of January 2004 American Forces Radio & Television Service was broadcasting in the United Kingdom. In 2000 Channel 5 was also the broadcaster for Major League Baseball games. Mr Orlinsky states that the annual All-Star Game exhibition, which features players from each Major League Baseball club, and the annual World Series inter-league championship, which has featured the Atlanta Braves, have been licensed for television broadcast, in whole or in part in more than 205 countries and territories, including the United Kingdom. Mr Orlinsky states that during these broadcasts Major's trade mark appears on the Atlanta Braves' players' caps and batting helmets, on caps worn by the club's coaches, on signage in the stadium, on items used by vendors during the games, and on a variety of licensed goods and merchandise used or worn by fans, such as clothing, baseball caps and pennants. Mr Orlinsky states that television viewers are also exposed to Major's trade mark during news and sports

broadcasts in the United Kingdom when Major's trade mark is used on screen graphics to identify the club.

30) Mr Orlinsky states that Major League Baseball games featuring the Atlanta Braves have been televised in the United Kingdom via Five TV. He states that since 1996 Five TV has broadcast weekly live Major League Baseball games in the United Kingdom, including the All Star Game exhibition and the World Series championships. He states that during the eight month Major League Baseball season North American Sports Network (NASN), the only United Kingdom television channel dedicated to North American sports, broadcasts 6-10 live and tape delayed Major League Baseball games per week. Mr Orlinsky states that up to 250 Major League Baseball games have been broadcast each season in the United Kingdom by NASN. He states that the 2004 Division Series games featuring the Atlanta Braves were televised in the United Kingdom by NASN. Various material is exhibited at U. There are pages downloaded on 7 September 2004 relating to broadcasts made by Channel 5. An article from "Double Play" for Summer 2001 states that Channel 5 has begun to screen two live games a week. The article states that Channel 5 has regularly begun to secure earlier Sunday on-air times at around midnight. Pages from the "Independent" of 7 July 2003 show that in July 2003 a game between Chicago Cubs and Atlanta Braves was broadcast on Channel 5 between 01.05 and 04.00.

31) Mr Orlinsky states that there are also broadcasts of the programmes "Baseball Tonight", "This Week in Baseball" and "Baseball Max". In support of this he exhibits various material at V. This includes pages downloaded on 14 October 2004 relating to July schedules showing the broadcasts of the first and second programmes on NASN.

32) Mr Orlinsky states that world renowned celebrities have been seen on television wearing caps bearing Major's trade mark. He states that an R&B singer of the name Usher has been seen photographed wearing caps bearing Major's trade mark. He exhibits at W pages downloaded from the Internet on 24 October 2004 showing this gentleman wearing various headgear displaying a letter A similar to that of Major's trade mark, although not in black.

33) Mr Orlinsky states that the Atlanta Braves has competed in nine World Series championships, winning three of them. He states that in addition the club has participated in eleven National League Championship Series contests and made seven Division Series appearances. Mr Orlinsky explains that the Major League Baseball clubs are comprised of members of the American League and the National League; each league is divided into three divisions. The Atlanta Braves is a member of National League East Division. At the end of the baseball season the best teams in each league compete against one another for championship titles in the Division Series games, League Championship Series and, finally, World Series games. Mr Orlinsky states that the Atlanta Braves has won a record thirteen consecutive National League East Division titles.

34) Mr Orlinsky states that many of the most famous Major League Baseball players are known for their accomplishments whilst they were members of the Atlanta Braves. He states that forty two members of the National Baseball Hall of Fame have played for the Atlanta Braves. Six members of the Atlanta Braves have won the

National League Most Valuable Player Award. Four members of the Atlanta Braves have been awarded the Cy Young Award, an honour given out every year to the best pitcher in each of the two Major League Baseball leagues. The club has also had six winners of the National League Rookie of the Year Award. Eleven members of the Atlanta Braves have been winners of the Gold Glove, an annual award that is presented to the best player in his position. Mr Orlinsky exhibits material relating to awards at Y. This material indicates that certain of the awards were given to players prior to the advent of the Atlanta Braves ie prior to 1966; six players on seven occasions are listed as winners of the Most Valuable Player Award but the first three players received the award prior to the advent of the Atlanta Braves (two would have played for the Boston team and one for the Milwaukee team).

35) Mr Orlinsky states that over 35 million people have attended Atlanta Braves games at the club's home stadium and many more have attended their away games in the United States and Canada. He states that Major's trade mark appears prominently on the stadium scoreboard and on top of the club's dugout. He states that the trade mark appears on a wide variety of products sold at the Atlanta Braves stores in the ballpark as well as at numerous stands around the ballpark. Exhibited at Z are details of attendance figures, a picture of the ground downloaded on 12 July 2004 and material about Turner Field, the current home ground of the Atlanta Braves. Major's trade mark in white appears on a picture of an advertising/scoreboard in the stadium.

36) Mr Orlinsky states that many print and on-line news publications worldwide have consistently featured articles and new items about the Atlanta Braves, accompanied by pictures of the club's players wearing caps and batting helmets prominently displaying Major's trade mark. Mr Orlinsky exhibits various materials at AA. A good deal of this material is not designed for the United Kingdom, not being in English, or clearly has an American provenance. There is some material from the United Kingdom, eg from the BBC website, emanating from 6 November 2003 onwards, in a section dedicated to sport in the United States of America. There are also printout of articles from the "Evening News" of Edinburgh of 20 October 1999 and a piece emanating from the Associated Press on 8 July 2004 (there is no indication that this was picked up by any United Kingdom publications).

37) Mr Orlinsky states that Major's trade mark has been displayed in major United Kingdom print and on-line news publications such as "The Independent", "The Guardian", "The Daily Mirror", "The Times", BBC Sport and Sky Sports. He exhibits various material relating to this at BB. Extracts from various print publications are exhibited, these have been downloaded from the Internet and are not in the format of the publications and do not reproduce any pictures. Mr Orlinsky again exhibits pages downloaded from the US Sport part of the BBC website; there are a large number of these printouts but all but one, from 7 November 2000, emanate from after the date of application. In the latter printout there is a photograph of Atlanta Braves shortstop Rafael Furcal, it is not possible to discern what is written on his cap. The exhibit also contains pages downloaded from the Sky Sports website, all of which emanate from after the application date.

38) Mr Orlinsky states that United States publications that are circulated internationally, as well as many international publications, have contained news items accompanied by photographs featuring Atlanta Braves players as well as Major's

trade mark. He states that "Sports Illustrated", a weekly sports magazine, has published many front page photographs and news stories featuring Atlanta Braves players and reports regularly on Major League Baseball in general. Mr Orlinsky states that as of 2000 "Sports Illustrated" has a monthly foreign circulation of approximately 12,000. I presume by foreign Mr Orlinsky means non United States. He states that each year one issue is devoted exclusively to Major League Baseball. Exhibited at CC are various articles and photographs from "Sports Illustrated" many of which show Atlanta Braves players wearing caps with Major's trade mark in white upon them.

39) Mr Orlinsky states that CNN regularly broadcasts highlights of Major League Baseball games. He states that CNN provides coverage of Atlanta Braves games accompanied by video of Atlanta Braves players wearing caps and batting helmets bearing Major's trade mark. Mr Orlinsky states that numerous articles and features devoted to Major League Baseball have appeared in the sports section of the on-line version of CNN. He states that Major's trade mark has been featured on the website. Exhibited at DD are various pages downloaded from the CNN Sports Illustrated website. Various of the photographs on the pages show Atlanta Braves players wearing caps with Major's trade mark in white upon them.

40) Mr Orlinsky states that the "International Herald Tribune" reports daily on virtually every Major League Baseball game played and features stories about the Atlanta Braves. He states that the newspaper has an international daily circulation in excess of 237,000. Mr Orlinsky states that there is an on-line version of the newspaper. Exhibited at EE are Internet versions of articles from the newspaper; they are not in the format of the newspaper and have no accompanying photographs. All of the articles emanate from after the date of application. Mr Orlinsky states that "USA Today" is a popular daily newspaper with both United States and international editions which reports extensively on all Major League Baseball games. He states that articles featuring the club often display Major's A trade mark. He states that the international edition of "USA Today" as of 2000 reached more than 250,000 persons daily, including persons in the United Kingdom. Mr Orlinsky states that there is an on-line version of "USA Today" which regularly presents stories about the Atlanta Braves. Exhibited at FF are copies of pages from "USA Today" and its website. Various of the pages show pictures of Atlanta Braves players wearing caps or helmets bearing Major's A trade mark.

41) Mr Orlinsky states that "USA Today" also publishes the weekly sports newspaper "Sports Weekly" (formerly known as "Baseball Weekly"). "Sports Weekly" devotes news and feature articles to all Major League Baseball games and events. Mr Orlinsky states that "Sports Weekly" is available on the Internet. He exhibits at GG copies of various pages from "Sports Weekly" and "Baseball Weekly". The cover gives the price of the publication in the USA and Canada. There are various pictures of Atlanta Braves players wearing caps or helmets bearing Major's A trade mark.

42) Mr Orlinsky states that "The Sporting News" is a weekly newspaper devoted to sports. He states that it has had an annual international circulation of approximately 28,000 since 2000. Mr Orlinsky states that there is an on-line version of the publication. In both versions there are photographs of Atlanta Braves players wearing

caps and batting helmets bearing Major's A trade mark. Exhibited at HH are copies of pages from both versions of the publication.

43) Mr Orlinsky states that "The New York Times" has had a foreign circulation of 9,500 daily and 28,000 for its Sunday edition since 2001. He states that the newspaper provides coverage of Atlanta Braves games during the Major League Baseball season. Mr Orlinsky states that there is an on-line version of "The New York Times" which regularly presents stories about the Atlanta Braves club accompanied by photographs of the club's players and personnel wearing caps and batting helmets bearing Major's A trade mark. Exhibited at II are copies of pages from both versions of the newspaper; all but three of the articles emanate from after the date of application.

44) Mr Orlinsky states the game of baseball was created in the United States and soon became the "American National Pastime". He states that efforts are being made through affiliated and related entities of Major to promote Major League baseball games and events internationally, including in the European Union. He exhibits at JJ material relating to this. Certain of the material emanates from after the date of application. The material shows attempts to promote the game of baseball in the United Kingdom under the auspice of Major. There is little reference to baseball teams in the United States and appears to be no reference to the Atlanta Braves. There is a copy of an article from "USA Today" from March 2000. This relates to Major's attempts to develop the game across the world. Included in the article is the following:

"Three years ago, MLB opened a London office to service the burgeoning European market, which ranks second only to Japan.

'Other than Italy and the Netherlands , they're just starting to play baseball in Europe but they buy our merchandise,' Beeston says."

45) Mr Orlinsky states that Major League baseball coaches visit the United Kingdom as part of its "Envoy Program". He states that they stage events where the fundamentals of baseball are taught to participants of all ages in order to foster international growth of baseball in general and recognition of Major League baseball. Mr Orlinsky states that Major League baseball and its related entities have organised junior elite camps since 1999. These bring together Europe's top fifty baseball players, from between 15 and 17 years of age, for five days of on-field instruction by Major League baseball coaches and players. Mr Orlinsky states that the Major League baseball festival, "an interactive free exhibit held in Europe", has introduced the game of baseball in general and Major League baseball clubs to hundreds of thousand of visitors. Mr Orlinsky does not identify where in Europe these festivals took place or to which years his estimate of the number of visitors attending relates. He states that at these festivals participants can practice batting, pitching and running the bases under the supervision and instruction of Major League baseball coaches. He states that the participants can even have their own baseball card made showing them wearing their favourite Major League baseball kit, including the kit of the Atlanta Braves, which bears Major's A trade mark.

46) Mr Orlinsky states that the Major League Baseball show event is administered jointly by Major and BaseballSoftball UK. This is "an interactive traveling exhibit

that allows participants to experience and appreciate the MAJOR LEAGUE BASEBALL professional baseball tradition by providing them the opportunity to bat, pitch and run bases". Mr Orlinsky states that the participants in the programme often wear caps bearing the trade marks of Major League Baseball clubs, including the Atlanta Braves. He states that the Major League Baseball Playball! programme is an after-school youth development programme which gives boys and girls, between the ages of 9 and 12, in the United Kingdom the opportunity to play organised baseball and to learn more about Major League Baseball and its clubs. Mr Orlinsky states that BaseballSoftball UK, created in January 2000 by the British Baseball Federation and the British Softball Federation to carry out most of the administrative and development functions of the two sports, together with Major League Baseball, "facilitates" the programme. He states that the programme has benefited from Yoplait's sponsorship of Major's school and youth development programmes in the United Kingdom, including the Playball! programme. Mr Orlinsky states that in the United Kingdom the Playball! programme has been renamed Playball! with Frubes; Frubes being a brand of Yoplait yoghurt. Mr Orlinsky states that the Major League Baseball, Pitch, Hit and Run programme is "facilitated" by BaseballSoftball UK and Major League Baseball. He states that it is a scholastic programme operating in more than 700 schools in the United Kingdom for girls and boys between the ages of 8 and 12 designed to teach baseball fundamentals. The programme culminates in local, regional and national throwing, hitting and base-running competitions.

47) Mr Orlinsky states that the worldwide fame and popularity of Major League Baseball is reflected in the fact the 27 per cent of the 830 players in 2004 were born from outside of the United States. He states that seven of the Atlanta Braves were born outside of the United States; they are from South Korea, Venezuela and the Dominican Republic. He states that Lance Painter, born in Bedford, England, has played for four Major League Baseball clubs. Material exhibited at OO relates to players born outside of the United States, sometimes these are referred to as foreign players and sometimes to players born outside of the United States; the two are clearly very distinct things. All of the material exhibited at OO emanates from after the date of application. It appears that one player from England and one from Germany were playing in Major League Baseball in 2003. As of 3 April 2002 in minor league there were four players born in Germany, two born in Italy, five born in the Netherlands and one born in Russia. There is no indication as to the nationalities of the players or when they came to the United States. Mr Orlinsky states that since 1910 it has been common practice for a president of the United States to throw out the first ball at an opening day game of the Major League Baseball season. He states that President Mubarak and Queen Elizabeth have accompanied the President of the United States to Major League Baseball games. Mr Orlinsky states that baseball is one of the fastest growing sports in the United Kingdom and a large portion of the United Kingdom's population takes part in the sport. He states that BaseballSoftballUK is dedicated to fostering baseball in the United Kingdom. He states that the official website of BaseballSoftballUK offers extensive information about baseball games and events in the United Kingdom as well as news, links and broadcast information about Major League Baseball games, including games played by the Atlanta Braves. Exhibited at QQ are various pages downloaded from the Internet. Several of them are in German, all of them emanate from well after the material date. I cannot see that in any of the pages in English is there any reference to the Atlanta Braves or the trade mark which is the basis of the opposition. Mr Orlinsky states that he believes that knowledge of

the Atlanta Braves and its A trade mark is widespread in the United Kingdom and that the general public will consider merchandise sold under or in connection with the A trade mark to be distinctive and exclusively associated with Major, the Atlanta Braves and/or their affiliated and related entities.

Evidence of Aloha

48) This consists of a witness statement by Gregory Warwick McCarry. Mr McCarry is a director of Aloha. Prior to this he was the founding director of Aloha UK Limited (formerly known as Revo (UK) Limited). Aloha UK Ltd is and always has been Aloha's exclusive licensee in the United Kingdom. Parts of Mr McCarry's statement are submissions rather than evidence of fact. I will say no more about the submissions here; although I bear them in mind in reaching my decision. Mr McCarry states that Aloha is a provider of surfboards, surfing accessories and related goods and services. He exhibits at GWM1 pages from the Internet giving the history of Aloha. From its inception Aloha used a stylised version of the name Aloha. Exhibited at GWM2 is a picture of an advertisement from a 1978 edition of the surfing magazine 'Surfing World' showing the name Aloha in stylised form. The letter A is in a similar form to that of the trade mark, although the "right leg" of the letter is more elongated. Mr McCarry states that the trade mark was adopted in August 1988; since then it has been continuously used in connection with goods and services offered or provided by it. Exhibited at GWM3 are the front covers of various magazines. Inside the cover of 'Wavelength' of 1994, described as Britain's number one surfing magazine, is an advertisement for Aloha surfboards which is dominated by the trade mark. The four other magazine covers do not appear to be from United Kingdom publications, they all show surfboards bearing the trade mark.

49) Mr McCarry exhibits at GWM4 printouts of the details of United Kingdom and Community trade marks for the trade marks Hermès and Ralph Lauren. The printouts show registrations for Ralph Lauren in classes 2, 8, 9, 14, 18, 20, 21, 24, 25 and 27 and for Hermès in classes 8, 9, 13, 14, 20, 21, 24, 26 and 34. Mr McCarry states that manufacturers of empty cosmetic cases and empty toiletry cases such as Samsonite, Antler, Delsey and Portland do not also sell cosmetics. There is no evidence to show use in relation to such cases or to show an absence of use in relation to cosmetics. Exhibited at GWM5 are pages from the websites of Chanel and Escada. The Chanel pages show use of the trade mark in relation to fashion, eyewear, fragrances, timepieces and fine jewellery. The pages from the Escada website show a mobile phone, jewellery and a motor scooter. There are also pages from the D&G website that show watches and sunglasses and list perfumes and underwear.

Evidence in reply of Major

50) A witness statement was filed by Keith Francis Gymer. Mr Gymer is a partner in Page Hargrave, who are acting for Major in this case. Mr Gymer exhibits to his witness statement what he himself describes as submissions in reply. No actual evidence of fact has been filed. I will say no more about Mr Gymer's statement, although I bear in mind his submissions in reaching my conclusion in this case.

DECISION

Findings of fact

51) Major has furnished a great deal of evidence. A large amount of it emanates from after the material date. A large part of it does not relate to the United Kingdom. The vast bulk of it has no direct link to the trade mark upon which Major relies. Part of the argument of Major appears to be based on the premise that baseball is well-known in the United Kingdom, so Major League Baseball is well-known, so the individual teams are well-known, so the insignia they use are well-known, so their individual trade marks are well-known, so the trade mark upon which Major relies is well-known. Mr Orlinsky states:

“baseball is one of the fastest growing sports in the United Kingdom and a large portion of United Kingdom’s population take part in the sport.”

He also states:

“I believe that knowledge of the ATLANTA BRAVES Club and MLBP “A” Mark is widespread in the United Kingdom.....”

Mr Orlinsky tries to illustrate the popularity of baseball by the fact that one Major League player was born in England. He does give the nationality of the player, it may be that he was born of American parents on an American military base; it may be that he left England at a young age. Even if that were not the case it really tells one nothing. Roland Lefebvre, from the Netherlands, played cricket for Somerset and Glamorgan. Three Danes, Freddie Klokke, Ole Mortensen and Amjad Khan, have all played first class country cricket in England. This does not mean that the average citizen of the Netherlands or Denmark has any knowledge of cricket, even less that he or she would identify the various insignia of the counties. The position is more likely to be that described by a Danish cricketer. Having explained the game to a casual passer-by, who saw a game taking place, the passer-by looked quizzically, pointed at the umpires and asked, “But what are the two butchers doing out there?”. I have seen games of cricket being played in the Bois de Boulogne, this does not mean that the average French person has any knowledge of the game. Mr Orlinsky’s statement that a large portion of the population of the United Kingdom takes part in the sport leaves me wondering what Mr Orlinsky means by large. From references in American films and television programmes many people in the United Kingdom will no doubt have heard of the more famous teams but that does not extrapolate into a knowledge of all teams, and certainly not of the insignia of all or any teams.

52) What Major has to show is the knowledge of the trade mark in the United Kingdom, prior to the date of application, upon which it relies in relation to the goods encompassed by its registration; that is the issue before me. Does the relevant consumer know the trade mark? The details in relation to such use are sparse. Exhibited at N, to the affidavit of Mr Orlinsky, are the following:

- “High 5”, which describes itself as “the US pro sports monthly”, of January 1995. It has a price in sterling. Pictured on the cover and in an article is a Greg Maddux. He is shown in both photographs wearing a baseball cap with

Major's trade mark in white. An advertisement by Stateside American Sportswear, based in Derby, includes various of Major's baseball caps including one bearing its trade mark in white. The rubric to the advertisement refers to Braves.

- An advertisement for "USA Today", which promotes getting the latest baseball news from the USA via the publication. The mail address is in London. There are various pictures of baseball players, one on whom is sporting a cap of the Atlanta Braves with the trade mark in white upon it. The advertisement states that the offer it is publicising expires on 31 December 1999.
- A publication called "Double Play", which is for those in the United Kingdom with an interest in baseball and softball. The publication would appear to emanate from 2000. There is an advertisement for Hallmark Cards which shows a paper bag with a number of Major's logos upon it, including the trade mark in white.
- "Double Play" for Summer 2001 (so this could emanate from after the date of application). There is an advertisement for various baseball caps, including one of the Atlanta Braves with the trade mark in white upon it.

Exhibited at P are yearly reports detailing sales of goods bearing trade marks designating the Atlanta Braves club. There is no indication as to what trade mark has been used in relation to the goods. The copy of an advertisement from "The Face" exhibited at P shows use of the sign Braves written over a tomahawk on a baseball jacket; so there is no certainty as to what trade marks have appeared on the goods.

53) Mr Orlinsky refers to the use of the Internet. However, he does not give any details of any sales to the United Kingdom in respect of goods bearing the trade mark upon which Major relies. This would seem a simple enough thing to obtain from a computer based purchasing system. So prior to the date of application, in relation to goods bearing the trade mark, all that is shown are advertisements for baseball caps and one paper bag which has a large number of insignia upon it. The number of hats and caps sold, from the figures given at exhibit P, prior to the date of application amount to 491. So assuming that all the caps bore the trade mark, on the basis of the evidence, between March 1999 and the date of application there were sales of 491 baseball caps; that is Major's best position. Mr Orlinsky refers to the showing of baseball games on television. The exhibits show that this commenced in the summer of 2001 on Channel 5 late at night/early in the morning. There is no indication that by the date of application Atlanta Braves matches had been shown. Even if an Atlanta Braves game(s) had been broadcast it would tell little about the public perception of the trade mark.

54) The evidence before me in no way suggests that at the date of application, for the purposes of section 5(2)(b) of the Act, that Major could benefit from an enhanced reputation in relation to the trade mark upon which it relies for any of the goods and services. The basis for a reputation for section 5(3) of the Act was given by the European Court of Justice in *General Motors Corporation v Yplon SA* Case C-375/97 [2000] RPC 572 (*Chevy*):

“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.”

The evidence of Major signally fails to clear this hurdle. **Consequently, the claim under section 5(3) of the Act must fail.** I now turn to the passing-off claim. It is first necessary to establish the material date for passing-off purposes. The material date for passing-off is the date of the behaviour complained of (see *Cadbury Schweppes Pty Ltd v The Pub Squash Co Pty Ltd* [1981] RPC 429 and *Inter Lotto (UK) Ltd v Camelot Group Plc* [2004] RPC 8 and 9). Section 5(4)(a) is derived from article 4(4)(b) of First Council Directive 89/104 of December 21, 1998 which states:

“rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark”.

Consequently, the material date cannot be later than the date of application for registration of the trade mark. Aloha has shown use of the trade mark in the United Kingdom in relation to surfboards prior to the date of application. However, there is no evidence of any use in relation to any of the goods of the application, which are an awfully long way away from surfboards. Consequently, there is no evidence of use of the trade mark in relation to the goods of the application or any goods closely related to them. Therefore, the behaviour the subject of the complaint rests squarely with the trade mark application and so the material date is the date of application, 16 June 2001. Pumfrey J in *South Cone Inc v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 stated:

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

28 Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.”

Professor Annand, sitting as the appointed person, in *Loaded* BL O/191/02, accepted that proof of goodwill could be accomplished by other means. The evidence of Major clearly fails to satisfy the requirements set out by Pumfrey J. Its case rests upon whether a goodwill in relation to the sign upon which it relies can be established upon the possible use on 491 baseball caps between March 1999 and the date of application. Such goods were advertised prior to the material date in the United Kingdom. There is no indication of actual sales to retail customers rather than

retailers/wholesalers but a goodwill can exist on the basis of a business with wholesalers (see *Ewing v Buttercup Margarine Co Ltd* [1917] 34 RPC 232). After a good deal of deliberation, despite the inadequacies of the evidence, I have come to the conclusion that Major has established a goodwill in relation to the trade mark upon which it relies in relation to baseball caps.

Likelihood of confusion – section 5(2)(b) of the Act

55) According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

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

The trade mark registration upon which Major relies was filed on 10 October 2000 and so is an earlier trade mark as defined by section 6(1)(a) of the Act.

56) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77, *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723 and *Vedial SA v Office for the Harmonization of the Internal Market (marks, designs and models) (OHIM) C-106/03 P*.

Comparison of trade marks

Earlier trade mark:



Application:



57) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*). The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel BV v Puma AG*). Consequently, I must not indulge in an artificial dissection of the trade marks, although taking into account any distinctive

and dominant components. The average consumer 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 he/she is deemed to be reasonably well informed and reasonably circumspect and observant (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*). “The analysis of the similarity between the signs in question constitutes an essential element of the global assessment of the likelihood of confusion. It must therefore, like that assessment, be done in relation to the perception of the relevant public” (*Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02).

58) In this case the trade marks are so clearly and markedly similar that I see no point in conducting an analysis. Taking into account imperfect recollection it is difficult to envisage the average consumer for any of the goods of the application being able to distinguish the trade marks. **I find that the trade marks are similar to a high degree.**

Comparison of goods/services

59) The goods of the application are:

shower gels, body sprays, shampoo, soaps, hair lotions and gels, essential oils and perfumery;

book binders, pencil/stationery cases, stationery, artists' materials.

The goods and services of the earlier registration are:

athletic bags, overnight bags, backpacks, duffel bags, tote bags, knapsacks, attache cases, briefcases, purses, handbags, wallets, billfolds, fanny packs, waist packs, cosmetic cases sold empty, toiletry cases sold empty, key cases, luggage, suitcases, garment bags for travel, trunks for travelling, umbrellas, canes, card cases, dog collars and dog leashes;

clothing; caps, hats, visors, knitted headwear, headbands, bandannas, shirts, t-shirts, tank tops, sweaters, turtlenecks, pullovers, vests, shorts, pants, dresses, skirts, overalls, bodysuits, baseball uniforms, jerseys, warm-up suits, sweatshirts, sweatpants, underwear, boxer shorts, robes, sleepwear, swimwear, clothing wraps, coats, jackets, ponchos, raincoats, cloth bibs, infant wear, infant diaper covers, cloth diaper sets with undershirt and diaper cover, jumpers, rompers, onesies, coveralls, creepers, baby booties, ties, suspenders, belts, money belts, mittens, gloves, wristbands, earmuffs, scarves, footwear, socks, hosiery, slippers, aprons, sliding girdles and costumes;

toys and sporting goods; stuffed toys, plush toys, bean bag toys, bean bags, puppets, balloons, marbles, checker sets, chess sets, board games, dart boards and dart board accessories, toy cars and trucks, toy mobiles, puzzles, spools incorporating coiled string which rewind and return to the hand when thrown, toy banks, toy figures, dolls and doll accessories, inflatable baseball bats, decorative wind socks, toy tattoos, flying discs, mini bats, neck and wrist lanyards for mini bats, mini baseballs, toy figures and sports whistles, video game cartridges, hand held video and electronic

games, coin-operated pinball machines, baseballs and holders for baseballs, autographed baseballs, basketballs, footballs, playground balls, rubber action balls, golf balls, golf club covers, golf club bags, golf putters, bowling balls, bowling bags, baseball bases, pitcher's plates, baseball bats, catcher's masks, grip tape for baseball bats, baseball batting tees, pine tar bags for baseball, rosin bags for baseball, batting gloves, baseball gloves, mitts, umpire's protective equipment, chest protectors for sports, athletic supporters, baseball pitching machines, fishing tackle, swim floats for recreational use, party favors in the nature of noise makers, and Christmas tree ornaments;

entertainment, education and information services; baseball games, competitions and exhibitions rendered live, through broadcast media including television and radio and via a global computer network or a commercial on-line service; providing information in the field of sports, entertainment and related topics, providing multi-user interactive computer games, and providing for interactive exchange of messages and information, all via a global computer network or a commercial on-line service.

In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* the European Court of Justice held in relation to the assessment of the similarity of goods that the following factors, inter alia, should be taken into account: their nature, their intended purpose (the original incorrect translation of 'Verwendungszweck' in the English version of the judgment has now been corrected), their method of use and whether they are in competition with each other or are complementary. In relation to the terms used in specifications Jacob J, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, stated:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade.”

Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 stated:

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

I take on board the class in which the goods or services are placed is relevant in determining the nature of goods and services (see *Altecnic Ltd's Trade Mark Application* [2002] RPC 34). Although it dealt with a non-use issue, I consider that the words of Aldous LJ in *Thomson Holidays Ltd v Norwegian Cruise Line Ltd* [2003] RPC 32 are also useful to bear in mind:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the

public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

In considering the cover of the services I take into account the comments of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

Taking into account the above, I cannot see that any of the respective goods and services coincide in respect of any of the five categories set out by the ECJ in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*; with the possible exception of *cosmetic cases sold empty* and *toiletory cases sold empty* in the earlier registration and the class 3 goods of the application, which might be considered complementary. The considerations that are to be taken into account as to whether goods are complementary have been outlined by the CFI in several judgments. In *Alecansan, SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-12/04 the CFI held:

“46 As regards the complementary nature of the goods and services, it must be pointed out that, according to the definition given by OHIM in point 2.6.1 of Part 2, Chapter 2, of the Opposition Guidelines of 10 May 2004, goods or services are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods or for the provision of those services lies with the same undertaking (see also to that effect Case T-85/02 *Díaz v OHIM* [2003] ECR II-4835, paragraph 36).”

In *Sergio Rossi SpA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-169/03 it held:

“62 However, the applicant has failed to demonstrate, during either the proceedings before OHIM or those before the Court, that this aesthetic or subjective complementary nature has reached the stage of a true aesthetic ‘necessity’ in the sense that consumers would think it unusual or shocking to carry a bag which does not perfectly match their shoes. The Court takes the view, first of all, that the search for a certain aesthetic harmony in clothing is a common feature in the entire fashion and clothing sector and is too general a factor to justify, by itself, a finding that all the goods concerned are complementary and, thus, similar. The Court observes, in addition, that the facts and evidence submitted by the applicant for the first time before the

Court cannot, in the present case, call into question the lawfulness of the contested decision as shown in paragraphs 19 et seq. above.”

In *Eurodrive Services and Distribution NV c Oficina de Armonización del Mercado Interior (marcas, dibujos y modelos) (OAMI)* Case T- 31/04 the Court held:

“35 En cuanto a la complementariedad de los productos y servicios de que se trata, invocada por la demandante, el Tribunal de Primera Instancia recuerda que, según la jurisprudencia, los productos o servicios complementarios son aquellos entre los que existe una estrecha conexión, en el sentido de que uno es indispensable o importante para el uso del otro, de manera que los consumidores pueden pensar que la empresa responsable de la fabricación de ambos productos es la misma [sentencia del Tribunal de Primera Instancia de 1 de marzo de 2005, Sergio Rossi/OAMI – Sissi Rossi (SISSI ROSSI), T-169/03, aún no publicada en la Recopilación, apartado 60]. La demandante no ha acreditado la existencia de tal complementariedad.”

(Judgment only published in Castellano and French.)

The evidence does not suggest any true aesthetic necessity between the goods under consideration. One is, therefore, left with deciding whether the respective goods are “indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods or for the provision of those services lies with the same undertaking”. There is no necessity for the class 3 goods of the application to be in cosmetic cases or toiletry cases, indeed, in my experience such goods are seldom in such receptacles other than when someone is travelling. The purpose of the cosmetics and toiletry cases is to carry cosmetics; but the purpose of suitcases is to carry clothes, it does not mean that these latter goods are complementary and/or similar. In my view the decision as to whether the goods can be considered to be complementary turns upon whether customers may think that the suppliers of ‘unfilled’ cosmetics and toiletry cases would be responsible for the class 3 goods of the application. The evidence that Major has furnished in relation to the United Kingdom, and indeed for the most part in the United States, does not show that it is a norm in trade for cosmetic and toiletry cases sold empty to emanate from the same undertakings. The closest it comes to supporting its claim are purses supplied by Harrods, and purses are not cases. The evidence it has supplied shows that the suppliers of toiletries only supply cases or bags filled, they do not supply them empty. However, that there is no tradition in trade in the United Kingdom to support Major’s premise does not mean that the purchaser of toiletries or cases for holding toiletries, the relevant consumer, would not consider that “the responsibility for the production of those goods or for the provision of those services lies with the same undertaking”. I am of the view that the customer could make that connection owing to the sole purpose of the class 18 goods that I am considering. **I am of the view that there is a complementary relationship between the class 3 goods of the application and the cosmetic and toiletry cases sold empty of the earlier registration and a low degree of similarity.**

60) The other leg of Major’s claim to the similarity of goods lies with various undertakings supplying a wide spectrum of goods. I consider that it can now be taken on judicial notice that it is not uncommon for producers of clothing to use their house

mark in relation to perfumes. That this is a common brand expansion does not make the goods similar. The tests for similarity have been set out by the ECJ. Several of the major United Kingdom supermarkets' brands are now used for insurance and banking services. It does not mean that a loaf of bread or a jar of pickles is similar to financial services. The premise that lies behind the evidence and argument of Major is that of association in the strict sense and not likelihood of confusion. This was a matter dealt with by the CFI in *Eurodrive Services and Distribution NV c Oficina de Armonización del Mercado Interior (marcas, dibujos y modelos)* (OAMI):

“40 El concepto de riesgo de asociación no es una alternativa al concepto de riesgo de confusión, sino que sirve para precisar el alcance de éste. Los propios términos de esta disposición excluyen, pues, la posibilidad de aplicarla si no existe, por parte del público, un riesgo de confusión (sentencias del Tribunal de Justicia de 11 de noviembre de 1997, SABEL, C-251/95, Rec. p. I-6191, apartado 18, y de 22 de junio de 2000, Marca Mode, C-425/98, Rec. p. I-4861, apartado 34).”

In *Sihra's Trade Mark Application* [2003] RPC 44 Patten J indicated that the limits to the parameters of what might be considered similar:

“12. It is clear that the flexibility inherent in this global approach leaves intact the threshold requirement for a recognisable degree of similarity between the goods and services in question. The distinctiveness and strength of the earlier mark may lessen the degree of similarity required, but it does not eliminate it. The remedy for the proprietor of a distinctive mark which is challenged in respect of non-similar goods is to oppose registration under s.5(3).....”

15 Similarity and confusion as to origin are both largely matters of fact and impression. Clearly, the strength and reputation of the earlier mark is likely to play a pivotal role in determining whether the new mark will cause confusion in the mind of the average consumer. But that possibility (however strong the earlier mark) is obviously at its highest in cases where the goods in question are identical or very similar. When one gets to more marginal cases, the likelihood of confusion inevitably diminishes. Some marks (as recognised in *British Sugar*) may be so uniquely strong as to override almost any lack of similarity in the goods or services under scrutiny. But if the statutory requirement for similarity prescribed by s.5(2) is not to be diluted to a point beyond recognition, then one needs to be careful in such cases to avoid straining the concept of similarity in order to accommodate what might be regarded as the unfair use of a well-established mark. The remedy for such cases, as I have already indicated, lies in s.5(3).”

I reject the argument that because various goods are sold under the same brand that they are similar. In relation to a conflict, for instance, between perfumery and clothing, there are other potential, and proper, remedies, as indicated by Patten J, to be had and, indeed, Major has also looked to these.

Conclusion

61) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). In this case I have no doubt that the respective signs are highly similar, indeed, I consider that they are hardly distinguishable. I have found that only the class 3 goods of the application are similar to any of the goods of the earlier registration and that there is a only low degree of similarity. It is necessary to consider the distinctive character of the earlier trade mark, the more distinctive the earlier trade mark (either by nature or nurture) the greater the likelihood of confusion (*Sabel BV v Puma AG*). The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (CFI Case T-79/00 *Rewe Zentral v OHIM (LITE)* [2002] ETMR 91). 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, the judgment of 4 May 1999 of the ECJ in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ETMR 585). I have already stated that Major cannot claim an enhanced distinctiveness because of reputation; in the case of the similar goods there is no indication of use at all, effectively it is an unused trade mark. The earlier trade mark is a stylised letter A. The Trade Marks Registry has taken a cautious attitude towards the registration of single letter trade marks. The main impetus for this has been because of the need to leave free, not necessarily because the trade mark might not be capable of distinguishing. Taking into account the stylisation of the earlier trade, and the conflicting goods for which it is registered, I consider the mark has a reasonable capability to distinguish. This is not to say that it has a large penumbra of protection; clearly being the letter A, it can be readily envisaged that other, differently stylised A trade marks could be distinguished from it. However, in this case, owing to the overwhelming and striking similarity with the trade mark of the application, there will not be a capability to distinguish. I have to consider the average consumer for the respective goods. The average consumer for both sets of goods will be the public at large. The respective goods could be of high or very low value, they could involve a careful or a very superficial purchasing decision. Whatever the purchasing decision, the degree of similarity between the trade marks will make it exceptionally difficult to distinguish between them. The degree of similarity between the trade marks is such that it is difficult to imagine that for even only slightly similar goods that confusion would not arise.

62) Taking into account all the above factors, I find that the average consumer will believe that the class 3 goods of the application and the cosmetic and toiletry cases of the earlier registration sold empty come from the same undertaking or an economically linked undertaking (see *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). There is a likelihood of confusion in respect of the class 3 goods of the application and the application is refused in respect of such goods.

Passing-off – section 5(4)(a) of the Act

63) Section 5(4)(a) of the Act states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade,”

I adopt the guidance given by Geoffrey Hobbs QC, sitting as the appointed person, in the *Wild Child case* [1998] RPC 455. In that decision Mr Hobbs stated that:

“A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.*[1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] A.C. 731 is (with footnotes omitted) as follows:

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

- (1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

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

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

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

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

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

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

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

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

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

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

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

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

64) I have already decided that the material date in respect of the passing-off is the date of application and that the goodwill of Major at that time relates to baseball caps. Although the use has been limited I consider that it is more than a trivial goodwill and so warrants protection (see *Hart v Relentless Records Ltd* [2003] FSR 36). There has been a real if very limited trade. Major has to establish confusion and subsequent damage in relation to the goods of the application on the basis of its very limited goodwill for baseball caps. Major has put in evidence to show that there is brand expansion, for instance, from clothing to perfumery. This is no doubt the case, but the issue before me is not what other traders have done but what Major has done and the effects of what it has done. Equally I have to consider what Major has done in relation to the use of its trade mark, not what merchandising hopes it might have or what others have done in respect of merchandising. It has a very limited goodwill in relation to the trade mark upon which it relies, which is in turn linked, through the nature of use, to a baseball team. Millet LJ in *Harrods v Harrodian School* [1996] RPC 697 Millet LJ stated:

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant’s goods or services”

In the same judgment he also stated:

“The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration.”

Taking into account the nature of the goodwill associated with Major’s trade mark and the goods of the application, I consider that there is no common field of activity and no likelihood of confusion.

65) In *Stringfellow v McCain Foods (GB) Ltd* [1984] RPC 501 Slade LJ considered the difficulty of establishing damage where the parties are in different lines of business:

“even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than a minimal loss is in my opinion a heavy one.”

In *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31 Lord Fraser commented upon what the plaintiff must establish:

“That he has suffered, or is *really likely* to suffer, substantial damage to his property in the goodwill by reason of the defendants selling goods which are falsely described by the trade name to which the goodwill is attached.”

I am of the view that Major’s case would also fail in that it does not establish that there would be any likelihood of any damage occurring, let alone substantial damage.

66) The grounds of opposition under section 5(4)(a) of the Act are dismissed.

OVERALL FINDING

67) I find have found that there is a likelihood of confusion in relation to the class 3 goods of the application. Aloha should file, within one month of the expiry of the appeal period from this decision, a form TM21 to amend the specification so as to delete the class 3 goods of the application. If form TM21 is not filed within the period set the application will be refused in its entirety. (If an appeal is filed the period for filing form TM21 will be one month from the final determination of the case, if the appeal is unsuccessful.)

COSTS

68) In the matter of costs the registrar has a wide discretion (see *Rizla Ltd's Application* [1993] RPC 365). In *BUD and Budweiser Budbräu Trade Marks* [2002] RPC 38, Mr Simon Thorley QC, sitting as a deputy judge of the High Court, accepted that off the scale costs could be awarded where a side had behaved unreasonably or put in a large amount of evidence that is of little or no relevance. In this case Major has succeeded in relation to part of the specification. It has filed a large volume of evidence that was neither directed to the relevant date nor the relevant jurisdiction. A large part of the evidence was directed to establishing the fame of baseball in the United Kingdom, rather than addressing the actual issues of the case. The amount of evidence that was relevant to the outcome of the case was exceedingly limited, and finding it took a great deal of sifting. Aloha could have been put to a large amount of trouble and expense in having to sift through four large volumes of what, quite bluntly, was largely irrelevant evidence. Consequently, I consider that Aloha should receive compensation in relation to dealing with the evidence filed by Major. I have, therefore, decided to defer an award of costs until Aloha advise me of the costs it incurred in scrutinising the evidence of Major. Aloha should advise me of these costs within two weeks of the date of this decision. I will then issue a supplementary decision in relation to the costs. If Aloha does not advise me of the costs in relation to this matter within this time an award as per the scale will be made.

Dated this 11th day of May 2005

**David Landau
For the Registrar
the Comptroller-General**