O/0290/25

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS:
UK3674890, UK3674897 AND UK3674906
IN THE NAME OF MAJOR LEAGUE BASEBALL PROPERTIES, INC.
TO REGISTER THE FOLLOWING TRADE MARKS:

CLEVELAND GUARDIANS

GUARDIANS

IN CLASSES 25 AND 41

AND

IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO UNDER NOS:
430557, 430558 AND 430559
BY VINELIGHT HOLDINGS, LLC

BACKGROUND AND PLEADINGS

1. These consolidated proceedings involve oppositions against three trade marks that Major League Baseball Properties, Inc. ("the applicant") seeks to register in the UK. The details for those three trade marks are set out below:

1. CLEVELAND GUARDIANS	2. GUARDIANS
UK application no. 3674890	UK application no. 3674897
Filing date: 29 July 2021	Filing date: 29 July 2021
Priority date: 8 April 2021[1]	Priority date: 7 April 2021[2]
Publication date: 5 November 2021	Publication date: 29 October 2021
("the applicant's first mark")	("the applicant's second mark")

3. 

UK application no. 3674906
Filing date: 29 July 2021
Priority date: 7 June 2021[3]
Publication date: 29 October 2021
("the applicant's third mark")

2. The above applications are all in respect of goods and services in Classes 25 and 41.[4] The specifications for all three applications are identical to each other.

The related oppositions

3. The applicant's marks are subject to oppositions based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act"), brought by VineLight Holdings, LLC ("the opponent").[5] The oppositions were brought on 26 January 2022 and are directed at all the applied-for goods and services.

[1] MAURITIUS(MU) MU/M/2021/33355
[2] MAURITIUS(MU) MU/M/2021/33336
[3] MAURITIUS(MU) MU/M/2021/33355
[4] See goods and services comparison.
[5] A Form TM16, dated 26 February 2024, was received at the UKIPO to record a change of ownership of the earlier mark, (via an assignment), from 'Belong Gaming LLC' to 'VineLight Holdings, LLC' ("the opponent"). The effective date of assignment being 22 January 2024.

4. The opponent relies upon the following trade mark for the purpose of its oppositions:

UK registration no. 3616505[6]
Filing date: 25 March 2021
Priority date: 25 September 2020[7]
Registration date: 29 October 2021
("the earlier mark")

5. The opponent relies on all goods in Class 25 and some services in Class 41 for which the mark is registered.[8]

6. The opponent submits that the parties' respective goods and services are identical or highly similar and that the marks are highly similar, resulting in a likelihood of confusion on the part of the relevant public.

7. The applicant filed counterstatements to all the oppositions. With regard to the respective goods and services, the applicant admits identity between the goods 'Clothing; footwear; headwear' in Class 25 but denies that all of the other opposed goods and services in Classes 25 and 41 are identical and/or similar. With regards to the respective marks, the applicant denies that they are visually, phonetically or conceptually similar.

8. On 15 August 2023, the Tribunal wrote to the parties informing them that the opposition proceedings had been consolidated, pursuant to rule 62(1)(g) of the Trade Marks Rules 2008.

[6] The registration, which is effectively a re-filing of a pending European Union ("EU") registration, was filed pursuant to Article 59 of the Withdrawal Agreement between the UK and the EU (hereinafter referred to as "Article 59"). The EU filing date was 25 September 2020 and so, in accordance with Article 59, the opponent's registration is deemed to have the same filing date as the corresponding EU application (EUTM No 018313699).
[7] EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)(EM) 018313699
[8] See goods and services comparison.

9. The opponent's mark qualifies as an earlier mark under section 6(1) of the Act. As it had not completed its registration procedure more than five years before the application date for the contested marks, it is not subject to the use provisions contained in section 6A of the Act. Consequently, the opponent may rely upon all of the goods and services for which the earlier mark is registered without having to establish genuine use.

10. The opponent is represented by Abion UK Limited and the applicant by Gowling WLG (UK) LLP. Both parties filed evidence and both parties chose to file written submissions in lieu of a hearing. I make this decision having taken full account of all the papers, referring to them below as necessary.

11. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

PRELIMINARY ISSUES

12. The following point has been raised by the applicant in its submissions in lieu[9] regarding the co-existence of the marks at issue. Before going any further into the merits of this opposition it is necessary to explain why, as a matter of law, this point will have no bearing on the outcome of this opposition.

> "Both the Earlier Mark and the Marks have co-existed in the UK since January 2022 without any instances of confusion, or even association, emerging. Such a lack of evidence of confusion is apparent given the Opponent would likely have referenced such instances within their evidence, dated 13 October 2023, had they occurred."

[9] Dated 20 June 2024.

13. It is important to note that absence of evidence of confusion does not necessarily mean an absence of actual confusion: *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220 at [80]. Accordingly, I will proceed to make my decision on the likelihood of confusion between the marks by making a multi-factorial assessment based on the particulars of the case before me.

EVIDENCE

14. The opponent's evidence came in the form of the witness statement of Angelo Rossi, dated 13 October 2023, along with twelve exhibits (AR1-AR12). Mr Rossi is the Chief Financial Officer at Belong Gaming LLC,[10] a position he has held since January 2021.

15. I have read and considered all of the evidence and note that it largely concerns the history of the opponent and its mark. Whilst the exhibits show, amongst other things, use of the earlier mark within the UK in relation to gaming, it is noted that Mr Rossi has not stated that the evidence supports a claim to an enhanced distinctive character through use.

16. The evidence will be referred to where necessary during this decision.

17. The applicant's evidence came in the form of the witness statement of Marianne C. Adams, dated 23 January 2024, along with six exhibits (MA1-MA6). Ms Adams is Senior Counsel at the applicant's company, a position she has held since 2020.

18. I have read and considered all of the evidence and note that it largely concerns the history of the applicant and its use of the contested marks in the UK. Ms Adams states that the applicant has built up a substantial reputation in the UK for the Cleveland Guardians baseball team as a result of merchandise sales, broadcasting, advertising and marketing campaigns, social media use and press coverage, all of

[10] On 22 January 2024 the earlier mark was transferred by way of an assignment, from 'Belong Gaming LLC' to 'VineLight Holdings, LLC' ("the opponent").

which has promoted the popularity of the team. Ms Adams further submits that merchandise bearing the contested marks at issue has been available to purchase in the UK since January 2022, via a number of retailers both online and in bricks and mortar stores, as well as via the applicant's own website.

19. However, whether there has been use or not of the applicant's marks is not at issue in the case before me. The grounds brought against the applications are under section 5(2)(b) of the Act only. As such, the evidence provided has no bearing on the case at hand.

20. Accordingly, I consider the applicant's evidence to be of no assistance to me in making my decision on the likelihood of confusion between the marks at hand. As such, it is unnecessary for me to make any further reference to the applicant's evidence.

DECISION

Section 5(2)(b): legislation and case law

21. Section 5(2)(b) of the Act states that:

> "5(2) A trade mark shall not be registered if because-
>
> […]
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

22. I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union ("CJEU") in *SABEL BV v Puma AG* (Case C-251/95),

Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

23. Where the goods or services in the specification of one party are included in a broader term from the other party's specification, those goods or services are considered to be identical: See *Gérard Meric v OHIM*, Case T-133/05 at [29].

24. In *Canon*, Case C-39/97, the CJEU stated that:

> "23. In assessing the similarity of the goods or services concerned, … all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

25. Additionally, the factors for assessing similarity between goods and services identified in *British Sugar Plc v James Robertson & Sons Limited ("Treat ")* [1996]

R.P.C. 281 include an assessment of the users and the channels of trade of the respective goods or services.

26. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court ("GC") stated that "complementary" means:

> "82. ...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 those goods lies with the same undertaking".

27. For the purposes of considering the issue of similarity of goods or services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10), Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

28. The competing goods and services are as follows:

Applicant's goods and services[11]

Class 25

Clothing, footwear, headwear; shirts; sweaters; vests; bottoms; dresses; skirts; athletic uniforms; jerseys; underwear; undergarments; sleepwear; robes; swimwear; jackets; sweatshirts; ponchos; aprons; clothing wraps; infant wear; cloth bibs; ties; belts; socks; hosiery; scarves; gloves; mittens; headbands; wristbands; Halloween and masquerade costumes; parts, fittings and accessories for all of the aforesaid goods.

[11] The contested goods and services are the same for all three applications.

Class 41

Education; providing of training; entertainment; sporting and cultural activities; baseball games and baseball exhibitions; Organizing and conducting an array of athletic events rendered live and recorded for distribution through broadcast media; conducting contests and sweepstakes; Entertainment media production services; production of on-going television, internet and radio programs in the field of sports; Providing news, information, pod casts, web casts and all in the field of sports; Organizing community sporting and cultural events; Entertainment in the nature of live performances by costumed mascots, cheerleaders, dance groups, and musical groups; live music concerts; Fan clubs; Providing sports facilities; Rental of stadium facilities; Conducting guided tours of a baseball stadium; information, advisory and consultancy services for the aforesaid services.

Opponent's goods and services

Class 25

Clothing; footwear; headgear.

Class 41

Education; providing of training; entertainment; video game services; arranging and conducting of conferences; arranging and conducting of workshops [training]; provision of on-line computer games, video games, electronic computer and video games, interactive computer and video games, virtual reality computer and video games, multiple player computer and video games; gaming services; on-line gaming services; computer gaming services; arranging of on-line gaming; arranging and organising of computer gaming events, competitions and tournaments; arranging and organising of on-line gaming events, competitions and tournaments; video game entertainment services; video game arcade services; internet games; rental of video and computer games; provision of online computer games; provision of online video games; provision of online interactive computer and video games; conducting multiple player games; provision of online interactive computer games; providing information relating to computer games and computer enhancements for games; providing information to game players about ranking and scores in respect of gaming; hosting of gaming leagues; game services provided online from a computer network; providing

online information on computer and video game strategies; electronic games services in the nature of computer games provided online of by means of a computer network; provision of online information in the field of computer games; providing interactive multi-player computer games via the internet and electronic communication networks; provision of computer and video game arenas; organisation of parties and events in respect of computer and video gaming; organisation of parties and events in a computer and video game arena; organisation, arranging and provision of conventions; organisation, arranging and provision of conventions in respect of computer and video games, gaming, online gaming, virtual reality gaming; interactive gaming and multiplayer gaming; electronic desktop publishing; entertainment information; film production, other than advertising films; game services provided on-line from a computer network; games equipment rental; movie studios; organization of competitions [education or entertainment]; production of music; production of radio and television programmes; providing on-line electronic publications, not downloadable; publication of books; publication of electronic books and journals on-line; scriptwriting services; television entertainment; providing online games; providing computer games and video games that can be accessed, played and downloaded over computer networks and global communications networks; providing entertainment via computer networks; arranging and conducting competitions for video game players and computer game players; entertainment in the nature of contests, competition and games; organising of games; interactive games, interactive entertainment, interactive competitions and interactive quizzes; providing information on video games and computer games; provision of multimedia entertainment content via computer networks; publishing and providing of computer games; electronic games services provided from a computer database or by means of the internet; electronic games services, including provision of computer games on line or by means of a global computer network; entertainment services, namely, providing temporary use of non-downloadable computer games; providing an online computer game; providing a web site through which people locate information about tournaments, events, and competitions in the video and computer game field; help, advice and support services relating to computer games, namely, consulting relating to how to play the computer games and strategies for winning computer game; information, advisory and consultancy services relating to all the aforesaid.

29. I have lengthy submissions from both the opponent and the applicant on the similarity of the goods and services. Whilst I do not propose to reproduce those here, I have taken them all into consideration in reaching my decision.

Contested goods in Class 25

Clothing, footwear, headwear; parts, fittings and accessories for all of the aforesaid goods

30. With the exception of *parts, fittings and accessories for all of the aforesaid goods,* the above contested goods, although worded slightly differently, appear in both specifications, therefore these goods are identical. With regards to the applicant's *parts, fittings and accessories for all of the aforesaid goods,* I will proceed on the basis that these goods are at least similar to the opponent's *Clothing; footwear; headgear,* given their obvious overlap in user and trade channels. Furthermore, they are complementary to each other.

Shirts; sweaters; vests; bottoms; dresses; skirts; athletic uniforms; jerseys; underwear; undergarments; sleepwear; robes; swimwear; jackets; sweatshirts; ponchos; clothing wraps; infant wear; ties; belts; socks; hosiery; scarves; gloves; mittens; wristbands; headbands; Halloween and masquerade costumes; parts, fittings and accessories for all of the aforesaid goods

31. With the exception of *parts, fittings and accessories for all of the aforesaid goods,* the above contested goods are included in the opponent's broad terms *clothing* and *headgear* and therefore are considered identical in line with the principle set out in *Meric.* However, if I have given too much weight to the identity of some of the goods, for example, *wristbands and headbands,* then I consider there to be an overlap in users, nature, methods of use, and channels of trade, such that I find the goods to be similar to a high degree. With regards to the applicant's *parts, fittings and accessories for all of the aforesaid goods,* I will proceed on the basis that these goods are at least similar to the opponent's *clothing* and *headgear* given their obvious overlap in user and trade channels. Furthermore, they are complementary to each other.

Cloth bibs; aprons; parts, fittings and accessories for all of the aforesaid goods

32. Broadly speaking, *cloth bibs* are worn by the very young in order to protect their clothing when eating, for example. Similarly, *aprons* are generally worn (both by children and adults) in order to prevent clothes from getting dirty while cooking, for example. Therefore, setting aside for a moment *parts, fittings and accessories for all of the aforesaid goods,* I find there to be an overlap between the contested goods and the opponent's broad term *clothing* as they are likely to be made from the same materials and are both worn on the body. However, I acknowledge that their purposes will differ, in that the contested goods are used to protect clothing from food, for example, whereas clothing is used to dress a person. I am of the view that users will overlap as the contested *bibs* and *aprons* will be worn over clothes. Accordingly, I find the goods at issue to be similar to a medium degree. With regards to the applicant's *parts, fittings and accessories for all of the aforesaid goods,* I will proceed on the basis that these goods are similar to a low degree to the opponent's *clothing,* given that users may overlap. Whilst there may also be an opportunity for similarity in trade channels, I consider this to be limited on account of the contested goods being *parts, fittings and accessories* for *aprons* and *bibs* and the opponent's goods being *clothing.* Furthermore, I do not consider the goods to be competitive, nor do I find them complementary. Weighing all factors, I find the competing goods similar to a low degree.

Contested services in Class 41

Education; providing of training; entertainment; information, advisory and consultancy services for the aforesaid services

33. The above contested services also appear in the opponent's specification, therefore these services are identical.

Entertainment media production services; Entertainment in the nature of live performances by costumed mascots, cheerleaders, dance groups, and musical groups; live music concerts; information, advisory and consultancy services for the aforesaid services

34. The above contested services are included in the opponent's *entertainment; television entertainment; provision of multimedia entertainment content via computer networks; information, advisory and consultancy services for the aforesaid services* and therefore are considered identical in line with the principle set out in *Meric.*

Production of on-going television and radio programs in the field of sports; information, advisory and consultancy services for the aforesaid services

35. The above contested services are included in the opponent's *production of radio and television programmes; information, advisory and consultancy services for the aforesaid services* and therefore are considered identical in line with the principle set out in *Meric.*

Production of on-going internet programs in the field of sports; information, advisory and consultancy services for the aforesaid services

36. The contested services facilitate the watching of sport via the internet. Broadly speaking, the watching of sport is considered to be a form of entertainment. Accordingly, I find that these services overlap with the opponent's *entertainment; providing entertainment via computer networks; information, advisory and consultancy services for the aforesaid services* and therefore are considered identical in line with the principle set out in *Meric.* If I have given too much weight to the identity of the services, then I consider there to be an overlap in users, nature, purpose (i.e. to entertain) and channels of trade, such that I find the services to be similar to a high degree.

Organizing and conducting an array of athletic events rendered live and recorded for distribution through broadcast media; information, advisory and consultancy services for the aforesaid services

37. The contested services relate to the distribution of athletic events through broadcast media for the purposes of, inter alia, facilitating or supporting the entertainment industry. Accordingly, I find that there is a clear overlap between the

contested services and the opponent's *entertainment*; *production of radio and television programmes; providing entertainment via computer networks; information, advisory and consultancy services for the aforesaid services.* Therefore, I consider that the services are identical in line with the principle set out in *Meric*. If I have given too much weight to the identity of the services, then I consider there to be an overlap in users, nature, purpose (i.e. to entertain) and channels of trade, such that I find the services to be similar to a high degree.

Sporting and cultural activities; baseball games and baseball exhibitions; Organizing community sporting and cultural events; information, advisory and consultancy services for the aforesaid services

38. Broadly speaking, I find that the above contested services are activities organised in part, for, inter alia, entertainment and educational purposes. Whilst I acknowledge that participants in the above activities, i.e. a player, as opposed to a spectator, may choose to take part in those activities because, for example, they may wish to improve their health and fitness, etc., nonetheless, I am of the view that the contested activities will also likely have the basic aim of providing entertainment, amusement, recreation or education to people, whether they are participating in such activities or merely spectating. A such, I find that there is an overlap between the contested services and the opponent's broad terms, *entertainment; education; information, advisory and consultancy services for the aforesaid services.* Accordingly, I consider that the services are identical in line with the principle set out in *Meric*. However, if I have given too much weight to the identity of the services, then I consider there to be an overlap in users, nature, purpose (i.e. to entertain) and channels of trade, such that I find the services to be similar to a high degree.

Conducting contests and sweepstakes; information, advisory and consultancy services relating to all the aforesaid

39. In general, *contests* and *sweepstakes* are types of competitions where two or more people try to get/win something that not everyone can have. For example, a *contest* is, inter alia, a competition or game, where the aim is to try and win something, for example, money; a *sweepstake* is a type of gambling game/lottery, where people, for

example, place an amount of money on a particular competitor of a race or contest, etc, and the person who has placed their money on the winner receives all the money. As such, I find that there is a clear overlap between the above contested services and the opponent's *organization of competitions [education or entertainment]; entertainment in the nature of contests, competition and games; organising of games; interactive competitions and interactive quizzes; information, advisory and consultancy services relating to all the aforesaid.* Therefore, I consider that the services are identical in line with the principle set out in *Meric*.

Fan clubs; information, advisory and consultancy services relating to all the aforesaid

40. Generally speaking, a *fan club* is an organised group of fans who show their passion and support, for example, to a particular well-known person, group, or team, etc., who appears in certain entertainment shows, music bands, or sports competitions, etc. This may include, inter alia, actors, singers, authors, or athletes. As such, I find that there is a close relationship between fan club culture and the entertainment industry. For example, via online forums, fans can spread excitement and provide feedback about certain films, bands or actors, etc., which acting as a form of unpaid marketing or advertising can play a big part in what film, music, book, TV show, etc., becomes popular. Accordingly, I find that there is a degree of similarity between the above contested services and the opponent's entertainment services, namely, *entertainment; entertainment information; television entertainment; providing entertainment via computer networks; interactive entertainment; provision of multimedia entertainment content via computer networks; information, advisory and consultancy services relating to all the aforesaid.* Since the respective services are all connected to entertainment activities, they may target similar users, coincide in producers and share the same channels of trade. Therefore, I find that the services are similar to a medium degree.

Providing sports facilities; Rental of stadium facilities; information, advisory and consultancy services relating to all the aforesaid

41. Broadly speaking, the contested services are likely to be utilised in relation to, amongst other things, sporting, music and comedy events, such as sporting contests,

competition and games, music concerts and comedy acts. These types of events will, amongst other things, seek to entertain and engage the attention of the viewer/participant. Accordingly, whilst I acknowledge that the above services are not present in the opponent's Class 41 services, I find that there is a degree of similarity between the contested services and the opponent's *entertainment, organization of competitions [education or entertainment]; entertainment in the nature of contests, competition and games; organising of games; information, advisory and consultancy services relating to all the aforesaid.* The purpose of the contested services is to provide a physical space in which sporting, music and comedy events, for example, can take place. Therefore, there is a similarity of purpose between the services, since the purpose of the opponent's services is to provide entertainment to users, while the purpose of the applicant's services is to provide the physical environments in which such entertainment can take place. They may also share similar same trade channels and target the same end consumer. Accordingly, I find that the services are similar to a low degree.

Conducting guided tours of a baseball stadium; information, advisory and consultancy services relating to all the aforesaid

42. Broadly speaking, the above contested activity aims to entertain baseball fans or those with an interest in baseball by, for example, allowing them to explore behind-the-scenes areas of their favourite baseball team's stadium. Such guided tours are likely to include access to various areas of a baseball stadium such as the pitch, changing rooms, the stands, press box and VIP areas. As these specific services will likely provide an entertaining and pleasurable experience to those taking part in the tours, I find that they coincide, to a degree, with the opponent's very broad *entertainment; information, advisory and consultancy services relating to all the aforesaid*, contained in its specification. The services will share a similar purpose, namely, to entertain, they may target the same users, coincide in producers and trade channels. Accordingly, I find the services to be similar to a medium degree.

Providing news, information, pod casts, web casts and all in the field of sports; information, advisory and consultancy services for the aforesaid services.

43. In general, the contested services are likely to be accessed by those users who have an interest in sport. The services will not only provide news and information regarding sport but is also likely to engage with, entertain and provide a pleasurable experience for users. As such, I find that some of the purposes of the above services coincide with some of the opponent's services, namely, *entertainment; entertainment information; providing on-line electronic publications, not downloadable; providing entertainment via computer networks; provision of multimedia entertainment content via computer networks; information, advisory and consultancy services relating to all the aforesaid.* The services will share a similar purpose, target the same user, and may coincide in producers and trade channels. Accordingly, I find the services at issue to be similar to at least a low degree.

The average consumer and the nature of the purchasing act

44. It is necessary to determine who is the average consumer for the respective goods and how the consumer is likely to select them. It must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.[12] In *Hearst Holdings Inc*,[13] Birss J. described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect… the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word "average" denotes that the person is typical… [it] does not denote some form of numerical mean, mode or median."

45. With regards to the goods in Class 25, the average consumer is likely to be the general public, who will likely take into consideration various factors when selecting the goods at issue, such as colour, style, size and suitability, etc. The goods are all

[12] *Lloyd Schuhfabrik Meyer*, Case C-342/97
[13] *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch)

likely to be sought out primarily by eye, including via websites, for example, and so I would expect the purchase to be mainly visual. However, I bear in mind that the goods may sometimes be the subject of word-of-mouth recommendations and therefore aural considerations are also borne in mind. Overall, I find that a medium degree of attention is likely to be paid during the purchase of the goods.

46. In respect of the services in Class 41, the average consumer is likely to include members of the general public as well as businesses and professional users. The services will likely to be sought out primarily by eye, including via websites, for example, and so I would expect the purchase to be mainly visual. However, I bear in mind that the services may sometimes be the subject of word-of-mouth recommendations and therefore aural considerations are also borne in mind. Given the range of services at issue, the price and frequency of purchase will vary depending on their nature and type. The average consumer is likely to take into consideration various factors when selecting the services at issue, but I would not expect the degree of attention to be at the highest end of the scale. Overall, I find that a medium degree of attention is likely to be paid during the purchase of the services. However, I acknowledge that professional and business users may pay a slightly higher degree of attention.

47. That said, with regards to the services relating to *sweepstakes*, I consider that the average consumer will be a member of the general public who will be over the age of 18. For the general public engaging in sweepstake services, this will include those who take part in sweepstakes frequently with the aim of making money, or winning prizes, etc., as well as those that engage in sweepstake activities infrequently. The services are likely to be sought out primarily by eye, on the basis that the purchaser will encounter the service provider either online or upon seeing the physical premises on the street, for example, licensed bookmaker establishments. However, I bear in mind that the services may sometimes be the subject of word-of-mouth recommendations and therefore aural considerations are also borne in mind. It is my view that this average consumer, including for those who take part in sweepstake activities purely for fun and for low stakes will, generally speaking, pay a medium degree of attention. However, I acknowledge that where the prize or prize money is of

significant value the attention paid by the average consumer will likely be higher, although not considerably so.

Comparison of the marks

48. It is clear from *Sabel BV v. Puma AG* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, that:

> "34. […] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

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

50. The trade marks to be compared are as follows:

The opponent's registration	**The applicant's marks**	
	The applicant's **first** mark	CLEVELAND GUARDIANS
	The applicant's **second** mark	GUARDIANS
	The applicant's **third** mark	

51. Both parties have filed lengthy submissions regarding the similarity of the marks. Whilst I do not propose to reproduce those here, I have taken them all into consideration in reaching my decision.

Overall impression

The opponent's mark -

52. The opponent's mark is a composite mark consisting of words and a figurative device element. The words 'TYNESIDE' and 'GUARDIANS' are placed in order, one on top of the other. Both words are presented in uppercase letters, however 'TYNESIDE' is presented in a standard black font and is significantly smaller than the word 'GUARDIANS' which is presented in a much larger outlined, black font. Above the words is a figurative device consisting of the head and shoulders of a winged, faceless figure, wearing what appears to be hoodie-type clothing. Due to its size, I find that the eye is naturally drawn to the device whilst immediately then to the elements of the mark that can be read, keeping in mind *MigrosGenossenschafts-Bund v EUIPO*, T-68/17, where it was stated that:

> "…in the case of a mark consisting of both word and figurative elements, the word elements must generally be regarded as more distinctive than the figurative elements, or even as dominant, since the relevant public will keep in mind the word elements to identify the mark concerned, the figurative elements being perceived more as decorative elements…"

53. However, with regards to the word 'TYNESIDE', due to its size within the mark and for reasons I will come to discuss in the conceptual comparison, I find that this word, whilst not negligible, plays a lesser role in the overall impression. Accordingly, on balance, I find that both the device element and the word 'GUARDIANS' dominate the overall impression in roughly equal measure.

The applicant's first mark - CLEVELAND GUARDIANS

The applicant's second mark - GUARDIANS

The applicant's third mark -

54. The applicant's *first mark* is a word mark comprising the words 'CLEVELAND GUARDIANS', presented in black standard uppercase text. However, for reasons that I will come to discuss in the conceptual comparison, I find that the word 'GUARDIANS' plays a greater role in the overall impression of the mark, with the word 'CLEVELAND', whilst not negligible, playing a lesser role in the overall impression.

55. The applicant' *second mark* is a word mark comprising the word 'GUARDIANS' presented in black standard uppercase text. The overall impression resides in this single element.

56. The applicant's *third mark* is stylised, comprising the word 'Guardians' in upper and lowercase letters which are presented in a black outlined font. Additionally, the letters '_uardians' in the mark are underlined in the same stylised font. The overall impression of the mark resides in this single element as the way the word is presented makes a relatively minor contribution to the overall impression of the mark. Accordingly, I find that the mark is dominated by the word itself, while the stylisation plays a secondary role.

Visual Comparison

The opponent's mark *and* ***the first application*** *'*CLEVELAND GUARDIANS'

57. Visually, the marks coincide insofar as they identically share the same word 'GUARDIANS'. However, the marks differ in that the applicant's mark contains the additional word 'CLEVELAND', not replicated in the opponent's mark, whereas the opponent's mark contains the word 'TYNESIDE' and a figurative device, neither of which are replicated in the applicant's mark. As for the differences between the fonts used in the respective marks, I do not consider this to be a point of significant

difference. Accordingly, I consider the opponent's mark and the applicant's mark to be visually similar to a medium degree.

The opponent's mark  *and* ***the second*** *and* ***third applications*** 'GUARDIANS' and 

58. Visually, the marks coincide insofar as they all identically share the same word 'GUARDIANS', which makes up the applicant's marks. However, the marks differ in that the opponent's mark contains the word 'TYNESIDE' and a device, neither of which are replicated in the applicant's marks. As for the differences between the fonts and letter case used in the respective marks, I do not consider these to be points of significant difference. Accordingly, I consider that the opponent's mark and the applicant's marks to be visually similar to a medium degree.

Aural Comparison

The opponent's mark  *and* ***the first application*** *'*CLEVELAND GUARDIANS'

59. Aurally, as the word 'GUARDIANS' in the respective marks is an English dictionary word, it will likely be pronounced in the ordinary way, therefore this element in the marks will be pronounced identically. The additional word element 'CLEVELAND' (pronounced 'kleev-lund') in the applicant's mark, and the additional word element 'TYNESIDE' (pronounced 'tine-side') in the opponent's mark will act as points of aural difference. The device component in the opponent's mark will not be articulated. Overall, I find the competing marks to be aurally similar to a medium degree.

The opponent's mark  *and* ***the second*** *and* ***third applications*** 'GUARDIANS' and 

60. Aurally, as the word 'GUARDIANS' in the respective marks is an English dictionary word, it will likely be pronounced in the ordinary way, therefore this element in the marks will be pronounced identically. The additional word element 'TYNESIDE' (pronounced 'tine-side') in the opponent's mark will act as a point of aural difference. The device component in the opponent's mark will not be articulated. Overall, I find the competing marks to be aurally similar to a medium degree.

Conceptual Comparison

61. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including Ruiz Picasso v OHIM [2006] E.C.R-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

The opponent's mark  *and* ***the applicant's three marks****, 'CLEVELAND GUARDIANS', '*GUARDIANS' and 

62. Conceptually, the word 'GUARDIANS' present in all the respective marks will likely be attributed its ordinary dictionary meaning, namely, those that guard/protect someone or something. Accordingly, this element in the marks shares the same concept. The fact that this word is stylised in the opponent's mark and the applicant's third mark does not detract from this concept.

63. With regards to the device element present in the opponent's mark, I am of the view that this element merely reinforces the *guardian(s)* concept*,* on the basis that when combined with the word 'GUARDIANS' the winged device element is likely to be

perceived as a depiction of a *guardian angel*, being a biblical reference for an angel assigned to guard/protect a particular person or group, etc.

64. The word 'TYNESIDE' in the opponent's mark and the word 'CLEVELAND' present in the applicant's mark will likely be perceived as geographical locations on the basis that they are both well-known geographical areas in Northern England, UK ('Cleveland' is also a geographical area in Ohio, USA). As such, the respective marks contain additional concepts emanating from the geographical words. Accordingly, I am of the view that neither of these words play a dominant or distinctive role within the respective marks on the basis that they will merely be perceived as indications as to the geographical origin or location of the goods and services at issue. Therefore, whilst these words will not be overlooked, I find that they play a lesser role in the overall impression of the respective marks, which will in my view be dominated by the word 'GUARDIANS'.

65. Accordingly, taking all the above into account, I find that there is a medium degree of conceptual similarity between the respective marks.

Distinctive character of the earlier mark

66. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV,* Case C-342/97 the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Alternberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or

does not contain an element descriptive of the goods or services for which it has been registered, the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark, the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking, and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

67. Registered trade marks possess varying degree of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

68. I note that the opponent has not pleaded that its mark has acquired enhanced distinctive character through use. However, as the opponent has filed evidence of use,[14] I will make a finding in relation to enhanced distinctiveness for the sake of completeness.

69. Turnover and advertising expenditure figures have not been provided, nor have any invoices been submitted in relation to sales of the relevant goods and services during the relevant period. Whilst I am able to ascertain from the evidence that some use has taken place within the UK, without turnover and advertising figures and invoices, etc., it is impossible to determine the extent of that use. Furthermore, there is very little evidence relating to marketing activities undertaken by the opponent. Accordingly, taking all of this into account, I find that the opponent has not demonstrated that its mark has acquired enhanced distinctiveness through use.

70. I have, therefore, only the inherent position to consider. The earlier mark is a composite mark, comprising the words 'TYNESIDE' and 'GUARDIANS' along with a figurative device. Whilst the word 'GUARDIANS' will likely be understood as a

[14] Referenced at paragraphs 14-16 of this decision.

reference to someone or something that guards and protects ('GUARDIANS' being the plural form), it has no obvious connection with the goods or services for which the opponent's mark is registered. With regards to the device element consisting of the head and shoulders of a winged, faceless figure, wearing what appears to be hoodie-type clothing, taking this element in conjunction with the word 'GUARDIANS', I am of the view that it will likely be perceived as a depiction of a type of guardian angel, which again, has no obvious meaning in respect of the goods and services at issue. With regards to the word 'TYNESIDE' consumers will likely recognise this as being a well-known geographical location in Northern England, UK, and as such, upon seeing it present in the mark, consumers will likely perceive it as an indication as to the geographical origin or location of the goods and services at issue. Accordingly, taking the mark as a whole, I find it to be inherently distinctive to a medium degree.

Likelihood of confusion

71. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and services, and the nature of the purchasing process. In doing so, I must be mindful to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

72. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods and services down to the responsible undertakings being the same or related.

73. Earlier in the decision I found that:

- All three contested marks are visually, aurally and conceptually similar to the earlier mark to a medium degree;

- I have found the parties' goods and services to range between identical and similar to a low degree;

- The earlier mark has a medium degree of inherent distinctive character for the goods and services at issue;

- The average consumer for the goods and services would include members of the general public, as well as business and professional users, who will purchase the goods and services predominantly by visual means, although I do not discount an aural component. A medium degree of attention will be paid during the purchasing process for the majority of the goods and services, although I recognise that it may be slightly higher for business and professional users, and with regards to certain services, such as sweepstake services where, for example, the prize or prize money is of significant value.

74. Taking into account the above, particularly the visual differences between the marks, namely the addition of the word 'TYNESIDE' and the figurative device element present in the opponent's mark, and the addition of the word 'CLEVELAND' in the applicant's first mark, I am satisfied that the opponent's mark and the applicant's three marks are unlikely to be mistakenly recalled or misremembered as each other. Accordingly, I do not consider there to be a likelihood of direct confusion.

75. Having found no likelihood of direct confusion, I now go on to consider indirect confusion.

76. In *L.A. Sugar Limited v By Back Beat Inc,* Case BL O/375/10, Mr Iain Purvis QC (as he then was), as the Appointed Person, explained that:

> “16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).
>
> (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).
>
> (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

77. These examples are not exhaustive but provide helpful focus.

78. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was),

sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

79. I acknowledge that a finding of indirect confusion should not be made merely because the respective marks share a common element. However, it is not sufficient that a mark merely calls to mind another mark:[15] this is mere association not indirect confusion.

80. Given the stated similarities between the marks and the identity and similarity to varying degrees between the goods and services at issue, I find that the potential for the marks to be seen as alternative marks from the same or economically linked undertakings is increased. Whilst consumers will recognise that there are differences between the competing marks, they will also recognise the shared distinctive word 'GUARDIANS' present in all of the marks. Furthermore, I am also mindful of the fact that 'TYNESIDE' in the opponent's mark and 'CLEVELAND' in the applicant's first mark are fairly weak in distinctive character, as they are likely to be perceived as allusive in respect of the geographical location of the goods and services at issue. Additionally, with regards to the winged device element present in the opponent's mark, for the reasons previously stated, I find that this decorative element merely reinforces the *guardian* message in the mark when viewed in conjunction with the dominant and distinctive word 'GUARDIANS' present in the mark.

81. Accordingly, I find that the addition of the geographical locations and the device element in the respective marks, do little to alter the distinctiveness of the opponent's mark or the applicant's first mark, as a whole, to the extent that consumers would see the opponent's mark and all the applicant's marks as entirely different undertakings. Moreover, in my view the addition of the said elements is consistent with brand variants. Consequently, I am of the view that consumers will simply consider that the parties' marks, for the goods and services that I have found to be identical and similar

[15] *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17

to varying degrees, are variations used by the same or economically linked undertakings. Therefore, I find that there is a likelihood of indirect confusion between the opponent's earlier mark and the applicant's three contested marks.

Conclusion

82. The oppositions under section 5(2)(b) of the Act succeeds against all the applicant's marks, namely application nos. UK3674890 (CLEVELAND GUARDIANS), UK3674897 (GUARDIANS) and UK3674906 – (). Subject to any successful appeal against my decision, the applications will be refused in their entirety.

Costs

83. As the opponent has succeeded, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice ("TPN") 1/2023. I appreciate that the evidence filed by the opponent was not particularly relevant to the decision I have made. As a result, I am of the view that it is not appropriate to grant the opponent costs for the filing of its evidence. In the circumstances, I award the opponent the sum of £1,400 as a contribution towards its costs. The sum is calculated as follows:

Official fees (Form TM7 - £100 x 3)	£300
Preparing notices of opposition and considering the applicant's counterstatements	£600
Considering the applicant's evidence and written submissions in lieu of a hearing	£300
Preparing written submissions in lieu of a hearing	£200
Total:	**£1,400**

84. I therefore order Major League Baseball Properties, Inc. to pay VineLight Holdings, LLC the sum of £1,400. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 27th day of March 2025

Sam Congreve
For the Registrar