BL O/0662/25

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBERS 3,674,890, 3,674,897 AND 3,674,906 IN THE NAME OF MAJOR LEAGUE BASEBALL PROPERTIES, INC

AND IN THE MATTER OF OPPOSITIONS UNDER NO 430,557, 430,558 AND 430,559 BY VINELIGHT HOLDINGS, LLC

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF SAM CONGREVE (O/290/25) DATED 27 MARCH 2025

DECISION

Introduction

1. This is an appeal from the decision of Sam Congreve, for the Registrar, dated 27 March 2025 (O/290/25). Vinelight Holdings LLC opposed the application of Major League Baseball Properties Inc to register three trade marks (No 3,674,890, 3,674,897 and 3,674,906) under section 5(2)(b) of the Trade Marks Act 1994. The opposition was successful against all three marks. MLB Properties appeals.

2. MLB Properties applied to register the word mark CLEVELAND GUARDIANS (No 3,674,890) in relation to the following goods and services is Classes 25 and 41:

> **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.
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> **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.

3. It also applied to register the word mark GUARDIANS (No 3,674,897) for exactly the same goods and services in Classes 25 and 41. Finally, it applied to register the following figurative mark (No 3,674,906) also in relation to the same goods and services in Classes 25 and 41:

4. Vinelight Holdings opposed the three marks based on the following earlier mark (No 3,616,505) in relation to goods and services covered by Classes 25 and 41.

5. The Hearing Officer found the goods and services covered by the Opponent/Respondent's Mark to be either identical or to have some degree of similarity to those covered by the Applicant/Appellant's Mark. These findings are not challenged by the Appellant.

Standard of appeal

6. The standard of appeal is by way of review. Neither surprise at a Hearing Officer's conclusion nor a belief that the Hearing Officer has reached the wrong decision will suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer's findings were rationally insupportable. The principles to be applied were summarised by Joanna Smith J in *Axogen Corporation v Aviv Scientific Ltd* [2022] EWHC 95 (Ch), [24] and in terms of evaluative decisions the Supreme Court's guidance in *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8, [49] where it stated that:

> …on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out the balancing exercise afresh but must ask whether the decision of the judge was wrong by reason of an identifiable flaw in the judge's treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account some material factor, which undermines the cogency of the conclusion.

7. Subsequently, in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc* [2025] UKSC 25 the Supreme Court highlighted at [93] and [94]:

> The question whether there is a trade-mark infringement under section 10(2)(b) of the Act is a classic example of what has come to be known as a multi-factorial assessment. It involves the finding of primary facts, the application of relevant principles or rules of law to those facts and the evaluative decision whether, thus considered, something has happened which falls within (here) a statutory definition.…It is perhaps obvious, and certainly an inevitable conclusion drawn from experience, that reasonable minds, and in particular reasonable judicially trained minds, each faithfully applying the relevant law and principles, will come to different conclusions about the answer to these multifactorial questions…

8. When considering this appeal, and applying these principles, it is important to remember the high bar set.

Grounds of appeal

9. The Appellant challenges the Hearing Officer's decision on four grounds. First, it is claimed that the Hearing Officer failed to take into account three of her findings when assessing the likelihood of confusion. Secondly, it is said that the Hearing Officer improperly assessed the issue of indirect confusion. Thirdly, it is alleged that the Hearing Officer did not consider any evidence when making her finding on the absence of actual confusion in the marketplace. Finally, it is submitted that the Hearing Officer erred, in relation to sporting services, when she failed to consider that geographical place + second word is common in naming sports teams and, in this context, the geographical name can be very distinctive.

Ground 1: Hearing Officer failing to take account of earlier findings

10. The first ground of appeal relates to three findings by the Hearing Officer. The first is that the selection of the relevant goods would be "sought out primarily by eye" (Decision, [45] and [46]). The second relates to the earlier mark, where the Hearing Officer found that "the eye is naturally drawn to the device whilst immediately then to the elements of the mark that can be read" (Decision, [52]) and later, "the device element and the word 'GUARDIANS' dominate the overall impression in roughly equal measure" (Decision, [53]). The third relevant finding by the Hearing Officer was that the winged device in the earlier mark is likely to be perceived as being a depiction of a guardian angel and therefore it reinforces the guardian concept in the mark (Decision, [63]).

11. Ms Blythe, for the Appellant, submits that these three findings were not all taken into account by the Hearing Officer when she moved on to consider whether there would be a likelihood of confusion between the marks. The crux of her submission is that the Hearing Officer had found the winged device and the words to be equally dominant in the earlier mark, but does not go on to apply this in her reasoning.

12. The Appellant relies on two things to support this submission. The first is that the second finding regarding equal dominance is not referred to again in the discussion on the likelihood of confusion and the second is that the Hearing Officer suggests that the winged device was decorative (Decision, [80]). Being decorative, Ms Blythe submits, means it could not also be equally dominant.

13. It is well established that the Appointed Person has to assume, unless there are compelling reasons to the contrary, that the Hearing Officer has taken into account any earlier findings when making a decision: see *Henderson v Foxworth Investments* [2014] UKSC 41 at [48]. There is nothing in the Hearing Officer's assessment of the likelihood of confusion which provides compelling reasons to suggest that one or more of the earlier findings were not taken into account. Indeed, it does not appear to me that it is inconsistent for a device in a mark to be dominant, but also to be described as decorative. Furthermore, a dominant element can clearly reinforce the overall conceptual message of the mark.

14. I therefore reject the first ground of appeal.

Ground 2: Assessment of the likelihood of confusion

15. The Hearing Officer did not consider that the earlier mark would be directly confused with the Appellant's marks, but rather that there would be indirect confusion. As Arnold LJ explained in *Liverpool Gin Distillery Ltd v Sazerac Brands, LLC* [2021] EWCA Civ 1207 at [10]:

> …"indirect confusion", is where the consumers do not mistake the sign for the trade mark, but believe that goods or services denoted by the sign come from the same undertaking as goods or services denoted by the trade mark or from an undertaking which is economically linked to the undertaking responsible for goods or services denoted by the trade mark.

16. The decision of Mr Iain Purvis QC, sitting as the Appointed Person, in *LA Sugar Ltd v Back Beat Inc* (O/375/10) is routinely cited when referring to indirect confusion (as it was by the Hearing Officer in this case (Decision, [76])). Mr Purvis gave three examples of things which might cause indirect confusion. However, it has long been established that these examples are not an exhaustive list. Indeed, this was confirmed in *Liverpool Gin* at [12].

17. *LA Sugar* is not a legal test which needs to be strictly applied, rather it is explaining (in a particularly helpful way) when an economic link might be perceived as existing between two undertakings. Therefore, a Hearing Officer is not obliged to mention *LA Sugar* at all or to explain whether something falls inside or outside of the three examples identified by Mr Purvis. What a Hearing Officer is obliged to do is to set out a proper basis for reaching the conclusion that the relevant public would perceive there to be an economic link between the marks.

18. Ms Blyth's criticism of the Hearing Officer is that she failed to consider the three types of indirect confusion set out in *LA Sugar*, and then, Ms Blyth submits, she went on to improperly conclude that the relevant public might see the later marks as "brand variants" and that "consumers will simply consider the parties' marks…are variations used by the same or economically linked undertakings" (Decision, [81]).

19. As I have explained, the Hearing Office was obliged to consider whether there would be perceived to be an economic link between the marks. She was not obliged to apply *LA Sugar* in the strict sense and so she cannot be criticised for not considering the three examples of indirect confusion. Furthermore, she did explain why she came to the conclusion that the relevant public might perceive there to be a link between the marks (Decision, [80]) before going on to apply the correct test, namely that the marks are perceived as used by the same or economically linked undertakings.

20. Ms Blyth also submits that was no explanation by the Hearing Officer as to what kind of brand variant the Appellant's mark would be; and that there was no evidence filed as to this sort of variant being common in the sports sector. The second point can be dealt with quite briefly. Most of the goods covered by the Appellant's marks are not restricted to the sports sector. And in respect of those that are so restricted, as I said in *Brewdog* (O/48/18) at [13]:

> Hearing Officers routinely rely on their own experience when making findings of fact. Indeed, as the quality of evidence filed by parties is sometimes so poor (or there is none at all), Hearing Officers are often compelled to make findings of fact without evidence at all as otherwise the outcome of oppositions might be arbitrary or capricious.…

21. In the absence of evidence, Hearing Officers have to make factual findings based on their own experience of the marketplace. The parties have an opportunity to file evidence and make submissions, but in most cases there will be things the Hearing Officer has to decide for which there is no evidence neither was the issue substantively addressed in submissions. In such cases, Hearing Officers simply have to do the best they can. A decision cannot be overturned merely because (in the absence of evidence) an appellate tribunal might have made a different factual finding from that of the Hearing Officer: *O2 Holdings Ltd's Trade Mark Application* [2011] RPC 22 at [60]. In any event, I am not sure I would make a different finding if it had been open to me to do so.

22. Finally, in relation to this ground of appeal, Ms Blyth submits that the Hearing Officer applied the wrong test when she said at Decision, [81]:

> 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.

23. I am not sure that the Hearing Officer was applying any test as such. She was explaining her reasoning as to why the marks would be seen as brand variants. The assessment of whether an earlier mark is economically linked to a later one is multi-factorial in nature. It is my view that the Hearing Officer was doing no more than explaining the factors she considered when reaching her conclusion.

24. I therefore dismiss the second ground of appeal.

Ground 3: Failure to consider any evidence of absence of actual confusion

25. The Appellant's third ground of appeal is that the Hearing Officer dismissed its argument, that the Appellant and Respondent's marks had peacefully co-existed in the marketplace, without considering the evidence.

26. An argument that two marks have lived side-by-side in the marketplace clearly requires there to be evidence of co-existence. The Appellant filed evidence which it claimed supported peaceful co-existence and the Hearing Officer did not consider the evidence in relation to this argument at all. Indeed, she found all the evidence filed to be of no assistance to her in making her decision (Decision, [20]).

27. Where a submission is made of co-existence in the marketplace and evidence is filed of use in the marketplace, it must be considered by the Hearing Officer. This was clearly a failing by the Hearing Officer.

28. Nevertheless, in my view the evidence filed was wholly insufficient to support peaceful co-existence. At its height, the Appellant's evidence is that "tens of thousands" of pounds worth of (unspecified) goods had been sold in the United Kingdom since 2022. There is also some evidence showing screenshots of Cleveland Guardians merchandise being available from a website, that largely comprises clothing of which some (but not all) bears one of the Appellant's marks.

29. To establish co-existence it is necessary for there to be evidence that both the earlier and later mark are used in the same marketplace at the same time in a way which would (in the absence of evidence) be seen as giving rise to a likelihood of confusion.

30. Accordingly, it is not possible to establish peaceful co-existence with an earlier mark which has not been used (ie where it is less than 5 years old; and so attracts no requirement to prove use). There was no evidence of the use made of the earlier mark in the case and so this ground falls at this hurdle.

31. In any event, the evidence to support co-existence is just too thin. There is evidence that some clothing is available for sale on a website. There is no evidence of how many visitors from the UK purchased from the website. There is no evidence of how many units of any particular good were sold to consumers in the United Kingdom. Finally, the price of the units sold to consumers is such that "tens of thousands" of pounds of sales even if concentrated in one good does not amount to many units being sold in the grand scheme of things.

32. Accordingly, while the Hearing Officer should have considered the evidence tendered to support this ground of appeal, it is my view that had she done so it would have been dismissed for the same reasons I have done so.

33. Accordingly, I reject the third ground of appeal.

Ground 4: Distinctiveness of geographical names in relation to sports teams

34. The fourth ground of appeal is confined to the Appellant's mark CLEVELAND GUARDIANS and in relation to the following services in Class 41 (which narrowed from a slightly wider list during the hearing):

> sporting activities; baseball games and baseball exhibitions; Organizing and conducting an array of athletic events rendered live and recorded for distribution through broadcast media; 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; Providing sports facilities; Rental of stadium facilities; Conducting guided tours of a baseball stadium; information, advisory and consultancy services for the aforesaid services

35. Ms Blythe submits that it is notorious that sports teams' names often comprise a geographical location together with a second word. She made reference to football teams: for instance, Wigan Athletic and Oldham Athletic; and rugby teams such as Castleford Tigers (Rugby League) and Leicester Tigers (Rugby Union).

36. The Appellant's position is a simple one. The relevant public would never think Wigan Athletic and Oldham Athletic were economically linked, neither would they think the Castleford Tigers were linked to the Leicester Tigers (and so on). In the United Kingdom, the argument goes, we are so familiar with seeing sports teams with a geographical name and a second word (and often the same second word) that the relevant public would never assume a link because the geographical element is very distinctive in this context.

37. Accordingly, it is said, the TYNESIDE element in the earlier mark and the CLEVELAND element in the latter mark should—when used in relation to a sports team—establish that the undertakings behind them are not economically linked even if they share a common second word (GUARDIANS). The Hearing Officer on the other hand took the view that Cleveland and Tyneside would be seen as geographical places and so were fairly weak in distinctive character (see Decision, [80]). Put another way, the Hearing Officer was saying the brand was "Guardians" and Tyneside and Cleveland are localised versions of that brand.

38. The submission before me (that sports teams names are different) was not squarely put to the Hearing Officer. The written submissions before her simply stated that, given the words CLEVELAND and TYNESIDE appear at the start of the sign, they create a geographical link to the parties' goods and services.

39. I agree with the Appellant's submissions that if the relevant public see the sign Cleveland Guardians as the name of a sports team they would not think that it is economically linked to another team called the Tyneside Guardians (whether in the same sport or different).

40. It is also my view that had Ms Blyth's sports team argument been put squarely to the Hearing Officer she would have accepted it in the same way that I have done so. This is yet another example of a case being determined on the papers before the registrar (with the parties forgoing any opportunity to point out specific matters or develop arguments) and then on appeal an attempt is made to make the points they did not properly set out below.

41. As I have accepted the basic proposition that CLEVELAND GUARDIANS would not be confused with another sports team which includes the word "guardians', the question becomes which of the services listed in paragraph 34 above would be seen as provided by or associated with a sports team. Only in such circumstances could the Hearing Officer's decision be seen as rationally insupportable (as in other circumstances her decision is entirely conventional). Where I am not confident that the services would be seen by the relevant public as something provided by a sports team then the Hearing Officer's decision should stand.

42. The provision of "baseball games and baseball exhibitions" would usually be conducted by the tournament operator, but I am confident that if the relevant public saw a game promoted with the name CLEVELAND GUARDIANS nobody would think it were anything other than linked to a sports team; and the relevant public would not think that that team was linked to another called the Tyneside Guardians. The same applies to the "organizing and conducting an array of athletic events rendered live and recorded for distribution through broadcast media". While the services relate to the organising of the event, it is my view that the relevant public would assume upon seeing something like Cleveland Guardians or Tyneside Guardians connected to these services that it was a sports team (of some sort) and that it was responsible for the athletic event.

43. It is my view that the "provision of stadium facilities" and "conducting guided tours of a baseball stadium" under CLEVELAND GUARDIANS would be assumed to be the rental or tour of the stadium where the sports team bearing that name plays.

44. In relation to "production of on-going television, internet and radio programs in the field of sports "and "providing news, information, pod casts, web casts and all in the field of sport" the issue is more difficult as I cannot be as confident that the sign Cleveland Guardians would be seen as referring to a sports team. "Guardian" (singular) is a word that is associated with news (and not just the current national newspaper with that name) and the geographic link might suggest a regional version of that news outlet. Furthermore, the plural Guardians may go unnoticed in by the relevant public in this context. Accordingly, I do not think that the Hearing Officer's decision should be disturbed in relation to these services.

45. Finally, "providing sporting facilities" and "sporting activities" is very broad. I think there might be something, like a local leisure centre, in relation to which the relevant public might think there is a brand called "Guardians" with a branch in Cleveland and one in Tyneside. Accordingly, I am not confident that the Hearing Officer's finding is wrong in this respect.

46. Accordingly, I allow the appeal in relation to the mark CLEVELAND GUARDIANS but only in relation to the following services in Class 41:

> baseball games and baseball exhibitions; Organizing and conducting an array of athletic events rendered live and recorded for distribution through broadcast media; Rental of stadium facilities; Conducting guided tours of a baseball stadium; information, advisory and consultancy services for the aforesaid services

Conclusion

47. I have allowed the appeal in relation to the mark CLEVELAND GUARDIANS to the extent set out in paragraph 46, and dismissed it in relation to the other goods and services covered by that mark and also in relation to the other two of the Appellant's marks.

48. While the Appellant has had some success, the Respondent has won more of the appeal. Furthermore, where the Appellant has been successful it is largely in relation to an argument which should have been more explicitly before the Hearing Officer; and so the costs award below should stand. Accordingly, I order the Appellant to pay a contribution towards the Respondent's costs of £2,500 for this appeal (along with the £1,400 ordered by the Hearing Officer below) by 4pm on 31 July 2025.

PHILLIP JOHNSON
THE APPOINTED PERSON
17 July 2025

Representation:

For the Appellant: Charlotte Blyth (instructed by Gowling WLG (UK) LLP

For the Respondent: Robert Snell (of Albion UK Limited)