

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION No. 2248224
IN THE NAME OF MAJOR LEAGUE BASEBALL PROPERTIES INC**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER No. 90816
BY THE SECRETARY OF STATE FOR DEFENCE**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY THE APPLICANT
AGAINST THE DECISION OF MR. G. W. SALTHOUSE
DATED 19 NOVEMBER 2003**

DECISION

Background

1. On 10 October 2000, Major League Baseball Properties Inc. (“MLB”) applied to register the designation represented below for use as a trade mark in the UK:



2. The goods in respect of which registration was sought were as follows:

Class 16

Paper goods and printed matter; trading cards, playing cards, posters, stickers, decals, temporary tattoos, bumper stickers, score books, scorecards, game programs, magazines and books featuring baseball, writing pads, note paper, notebooks, binders, stationery-type portfolios, stationery folders, stationery sets, paper activity sets, preprinted agenda organizers, scrapbooks, autograph books, baseball card albums, book covers, calendars, greeting cards, postcards, bank checks, checkbook covers, credit cards, collectable stamps, gift wrapping paper, paper gift and party bags, paper party decorations, paper coasters, paper flags, paper napkins, paper tablecloths, mounted and unmounted photographs, photograph albums, lithographs, printed paper signs, printed paper door signs, plastic baseball card holders and collectors cases, business card holders, metal bulletin boards, paperweights, letter openers, pens, pencils, pencil top ornaments, markers, desk stands and holder for pens, pencils and ink, non-electric erasers, pencil sharpeners, ungraduated rulers, ticket holders and lanyards for ticket holders

Class 25

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

Class 28

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.

3. On 11 July 2002, The Secretary of State for Defence (“the MOD”) filed notice of opposition against the Application under sections 3(1)(b), 3(1)(c) and 3(1)(d) and 5(2)(a), 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994. The grounds under sections 3(1)(b), 3(1)(c) and 3(1)(d) and 5(2)(a) were subsequently withdrawn.
4. For the purposes of section 5(2)(b), the MOD relied on two earlier trade marks within the meaning of section 6 of the Act: (i) UK Registration number 2235926 for the trade mark MET OFFICE; and (ii) CTM Application number 00826610 for the trade mark MET. For the purposes of the section 5(4)(a) ground of opposition, the MOD relied upon alleged earlier rights in MET.
5. The Hearing Officer, acting for the Registrar, in a written decision issued on 19 November 2003, BL O/356/03, rejected the opposition under section 5(2)(b) insofar as it was based on UK Registration number 2235926 and also under section 5(4)(a). However, he accepted the opposition under section 5(2)(b) based on CTM Application number 00826610.
6. The Hearing Officer noted in his decision that: “At the hearing it was common ground that all the goods in the applicant’s specification were similar to those of the opponent” (para. 41). He found that there were clear visual and phonetic similarities

between the respective trade marks METS figurative and MET such that when globally assessed the likelihood of confusion on the part of the public was made out.

7. Accordingly, the Application was to be refused in its totality. However, since the successful earlier trade mark was a CTM *application* his decision under section 5(2)(b) was stayed pending its registration or otherwise and he directed that his decision would not take effect until one month following the resolution of CTM Application number 00826610.

The appeal

8. On 17 December 2003, the Applicant filed notice of appeal to the Appointed Person under section 76 of the Act against the Hearing Officer's decision under section 5(2)(b). The Applicant also requested a stay of the substantive appeal hearing until one month after the status of CTM Application number 00826610 was determined, which in the circumstances was granted by me.

CTM 00826610

9. On 22 October 2010, CTM Application number 00826610 was registered with a reduced specification of goods and services. Insofar as the goods in the earlier trade mark were concerned, this was as a result of a decision of the OHIM Opposition Division (4242/2004 of 263 519, 16 December 2004) taken in an opposition brought by MLB.
10. In that decision, OHIM rejected CTM Application number 00826610 for the following goods (which had been in the earlier trade mark when the Hearing Officer decided the present opposition):

Class 9

Computers; parts and fittings for all the aforesaid goods

Class 16

Printed data, graphic images and tickets; stationery, envelopes, bags, labels, tags; printed matter, newsletters, magazines, pamphlets, periodicals; writing instruments, pens, pencils, paper clips, paperweights; coasters; playing cards, maps, posters, photographs, diaries and calendars; teaching, educational and instructional material; brochures, catalogues and advertising material; parts and fittings for all the aforesaid goods

Class 25

Articles of outer clothing; Sweatshirts; T-shirts; overcoats; rainwear, waterproof clothing; sweaters, pullovers, cardigans; ties, scarves; footwear; caps, hats, headgear; gloves, parts and fittings for all the aforesaid goods

Class 28

Toys, games, and playthings.

11. As a consequence, CTM Application number 00826610 was registered for the following *goods* only:

Class 28

Soft toys; dolls; figurines; electronic games machines; souvenirs; novelty items; jigsaw puzzles; toy action figures; parts and fittings for all the aforesaid goods; all included in Class 28.

Request for information and subsequent correspondence

12. Given those facts, it appeared to me that the concession as to the similarity of the respective goods, upon which the Hearing Officer's decision under section 5(2)(b) proceeded (para. 6 above), had been effectively robbed of all meaning and significance.
13. Pursuant to Rule 62(1)(a) of the Trade Marks Rules 2008, on 22 November 2010, I requested the MOD to indicate in writing which of the goods in the present Application it still wished to oppose under section 5(2)(b) on the basis of the evidence on file and notwithstanding the reduced specification with which CTM number 00826610 was registered.
14. The MOD complied with my request by letter dated 9 December 2010 stating that in the light of the reduced specification of CTM number 00826610 the goods in Classes 16 and 25 were no longer opposed. Moreover, the opposition was maintained against the Application in Class 28 *only* in respect of the following goods (subject to interpretation of the specification in relation to the asterisked items):

Class 28
Toys and sporting goods*; stuffed toys, plush toys, bean bag toys, bean bags, puppets, board games, puzzles, toy figures, dolls and doll accessories, toy figures and sports whistles*, video game cartridges, hand held video and electronic games, coin-operated pinball machines, playground balls, party favors in the nature of noise makers, and Christmas tree ornaments.
15. By letter to the parties dated 20 December 2010, I called upon MLB to inform me in writing which of the above goods in Class 28 it sought to defend. Further, I anticipated that thereafter it would be necessary to hold a directions hearing.
16. However, since the MOD's letter of 9 December 2010 contained a suggestion of settlement, I agreed to defer such directions hearing for a defined period to allow the parties to explore possible bases of settlement.
17. By letter dated 28 January 2011, MLB told me that it intended to defend the Application in Class 28 or for the goods listed at paragraph 14 above but confirmed that the parties were engaged in settlement negotiations.

Settlement

18. On 6 September 2011, I was informed by the parties that they had duly concluded a settlement agreement between them, dated 29 June 2011, under which it was agreed that: (a) the MOD would withdraw the opposition in its entirety; and (b) each party would bear their own costs of the opposition and this appeal.
19. The parties made a joint application to me for an Order by Consent that:
 - (i) the Decision (BL O/356/03) of the Hearing Officer, Mr. G. W. Salthouse, dated 19 November 2003, be set aside in its entirety;
 - (ii) Opposition number 90816 be confirmed as withdrawn;
 - (iii) there be no award of costs against any party in these proceedings;
 - (iv) Application number 2248224 be permitted to proceed to registration for the goods specified in Classes 16, 25 and 28.
20. The Registrar confirmed that he had no objection to the course of action contemplated by the parties' settlement agreement and their joint application.
21. Following the approach adopted by the Appointed Person in *OKO Trade Mark* (BL O/195/03), *QUORN HUNT Trade Mark* (BL O/127/05) and subsequent cases, and with the consent of the parties envisaged by the settlement agreement and expressed in the joint application, I determine and direct that:
 - (1) Mr. Salthouse's decision dated 19 November 2003 be set aside.
 - (2) The MOD's appeal from that decision stands withdrawn with no order as to costs.
 - (3) Opposition number 90816 stands withdrawn with no order as to costs.
 - (4) Application number 2248224 stands remitted to the Registrar for further processing in accordance with the Act and the relevant Rules and in conformity with the terms of the parties' settlement agreement, which they have notified to me.

Professor Ruth Annand, 14 September 2011