

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 2016087  
BY C. BREWER & SONS LIMITED  
TO REGISTER A SERIES OF TWO TRADE MARKS IN CLASSES 2,3,6,7,8,16,19 & 27

AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 44226  
BY MAJOR LEAGUE BASEBALL PROPERTIES INC.

## BACKGROUND

1) On 29 March 1995, C. Brewer & Sons Limited of Albany House, Ashford Road, Eastbourne, East Sussex, BN21 3TR applied under the Trade Marks Act 1994 for registration of a series of two trade marks (reproduced below):



The second mark in the series is limited to the colours grey, red, brown and yellow.

2) In respect of the following goods:

Class 2: Paints; undercoats; primers; emulsions; thinners; sealers; varnishes; exterior and interior wall finishes; distempers; enamels; lacquers; wood stains and preservatives against rust and deterioration of wood; colouring matters; dye stuffs; pigments; mordants; natural resins; creosote; coatings; wood treatments.

Class 3: Bleaching preparations; cleaning, polishing, scouring and abrasive preparations; paint stripping preparations; glass paper and sand paper.

Class 6: Common metals and their alloys; principally metallic building materials; non-electric cables and wires; ironmongery, small items of metal hardware; ladders, tool boxes and doors, being principally metallic; door furniture; handles and knockers; locks; pipes and tubes made principally of metal; screws and nails; safes; parts and fittings for all the aforesaid goods.

Class 7: Colour tinting machines; mixing and dispensing machines; electrically powered tools, electrically powered drills, paint strippers and wallpaper strippers; jigsaws, circular saws and blades therefor; motors and engines; parts and fittings for all the aforesaid goods; but not including cleaning or polishing machines or vacuum cleaners.

Class 8: Hand tools and implements, files, planes, hacksaws, hand saws, hammers, chisels, screwdrivers, trowels and scrapers; parts and fittings for all the aforesaid goods.

Class 16: Brushes and rollers for painters, decorators and sign writers; artists' materials; parts and fittings for all the aforesaid goods

Class 19: Building materials; cement and mortar; building boards, plaster boards, plywood and chipboard; wall and floor tiles; fillers including plaster fillers for walls; plastic guttering; rigid pipes for building; parts and fittings for all the aforesaid goods.

Class 27: Wall hangings; wall coverings and lining papers.

3) On the 29 February 1996 Major League Baseball Properties Inc., of 350 Park Avenue, New York, NY 10022, United States of America filed notice of opposition to the application. An amended statement of grounds was later filed. The new grounds of opposition are in summary:

a) The opponent is the proprietor of the trade mark MILWAUKEE BREWERS & Device numbers 1333493, 1333494, 1452981, 1452982 and 1452983 (see annex A).

b) The opponent claims to have exclusive authority from the United States Commissioner of Baseball to own and control the use of the trade marks deriving from US professional baseball in the UK, two such trade marks are MILWAUKEE BREWERS & Device and MILWAUKEE BREWERS. By said authority, the popularity of US professional baseball in the UK (via television and other media coverage) and extensive use of the marks on a wide range of goods and services the opponent has gained a substantial reputation and goodwill in its marks.

c) As such the application offends against Sections 5(2), (3) & (4) of the Trade Marks Act 1994.

d) The applicant's mark is tantamount to the dictionary word "Brewers" and to the extent that the specified goods are for use on breweries registration is barred by Section 3(1)(c); and to the extent that the specified goods are for other uses registration is barred by Section 3(3)(b).

e) By virtue of the opponent's goodwill the application offends against Section 3(4).

f) The applicant has been aware of the opponent's rights since 31 January 1996 and so the application is made in bad faith and is barred by section 3(6).

4) The applicant subsequently filed a counterstatement denying the opponent's claims.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 5 March 2001 when the applicant was represented by Mrs Rawlence of Messrs Roystons. The opponent was not represented but instead submitted written submissions.

## OPPONENT'S EVIDENCE

6) The opponent filed a declaration, dated 27 December 1996, by David Leslie Brown, a trade mark attorney and partner in Page Hargrave, the opponent's trade mark agent.

7) At exhibit DLB1 he provides copies of pages 224 and 225 of the 1990 edition of the British Telecom London Residential Phone Book. This contains entries of the surname Brewer. I counted 205 entries on the two pages.

8) At exhibit DLB2 he provides a copy of page 236 of the third edition of the Shorter Oxford English Dictionary (Ed. C T Onions, 1987) containing an entry of the word "Brewer". This states "1. One who brews: *spec.* one whose trade is to make malt liquors. 2 A concocter of 1563."

9) At exhibit DLB3 he provides a copy of the letter dated 31 January 1996 from Messrs Page Hargrave to Messrs Roystons (the applicant's trade mark agent), which states that the opponent has a number of marks which include the word BREWERS and claiming possible conflicts.

10) The opponent also filed an affidavit, dated 20 December 1996, by Ethan G Orlinsky. Mr Orlinsky is the Secretary of Major League Baseball Properties Inc. (the opponent) a position he has held since November 1995. He confirms that all statements made are either from his personal knowledge or derived from the records of his corporation.

11) Mr Orlinsky states that the trademarks BREWERS, MILWAUKEE BREWERS and Brewers Primary Logo (herein after referred to as the "club's marks") are used to designate the Milwaukee Brewers Professional Baseball Club and those goods and services provided by and made famous by the club.

12) Mr Orlinsky states that the club began playing in Seattle in 1969 as the Seattle Pilots. It relocated to Milwaukee in 1970 and was renamed the Milwaukee Brewers. It began using the marks BREWERS in 1968, MILWAUKEE BREWERS in 1970 and the Brewers Primary Logo in 1983. He states that the club is a member of the American League Central Division and plays at the Milwaukee County Stadium. He states that Major League Baseball games are televised in virtually every country in the world and includes the UK. He also states that the sport gets media coverage in newspapers and magazines and the internet. At exhibit A he provides copies of what appear to be articles from various American publications relating to baseball in general.

14) At exhibit B he provides copies of royalty statements which he claims shows use of the club's mark in the UK. The statements show sales of £173 on novelties and pennants between the years 1991 - 1996 under to the opponent's mark. He also claims that weekly television shows about baseball are available to viewers in the UK.

15) Mr Orlinsky claims that baseball players, in uniform, often feature in advertisements and also in films which are seen worldwide. He also states that many publications feature baseball and these publications are available worldwide. Specifically he refers to The International Herald Tribune which he claims has a daily circulation in the UK of 14,961 and reports daily on baseball games. He also refers to a number of other publications and provides world wide

circulation figures, but none specific to the UK. Mr Orlinsky states that with the wide circulation of newspapers, magazines, films, videos and television programmes and the internet “numerous persons living in the UK have seen and are familiar with the Major League baseball marks, including the club’s marks”.

16) Mr Orlinsky also states that as there is extensive travel between the UK and the US, many UK residents will be aware of major league baseball.

#### APPLICANT’S EVIDENCE

17) The applicant filed two declarations. The first, dated 29 August 1997, is by John Richard Grout a director of the applicant company, a position he has held since 1986.

18) Mr Grout states that the marks in suit has been used in the UK by his company since 1945. He also states that the mark in suit reflects the company name under which the applicant has traded since 1904. The applicant also holds two registrations Nos 1532946 & 1532947 (both registered 14 April 1993) for the mark in suit for goods in Classes 2 and 27 respectively.

19) Mr Grout provides approximate sales figures for the UK, and approximate figures for promotional activities for the marks in suit as follows:

Financial Year ending	Sales £	Promotional £
1990	53,200,000	278,000
1991	49,300,000	172,000
1992	44,400,000	226,800
1993	44,000,000	287,200
1994	47,100,000	282,100
1995	49,800,000	325,500

20) Mr Grout states that the marks in suit have become known as a result of the advertising in trade journals, use on delivery vehicle and displays in retail outlets. He states that the company has approximately 66 outlets located in numerous towns and cities. At exhibit 2 he provides specimens of sales literature, carrier bags, stationery and invoices, which carry one or other of the marks in suit.

21) The second declaration, dated 5 June 1998, is by Kevin Peter Jones a technical assistant working for Roystons, trade mark agents for the applicant.

22) Mr Jones states that in October 1997, 49 letters and questionnaires were sent out to individuals and companies selected from the Yellow Pages under the heading “Painters and Decorators”. A copy of the letter, questionnaire and Yellow Pages entry are provided at exhibit 1. Fourteen responses were received, of which twelve were completed forms, one form was blank and the other response was a letter. These replies are at exhibit 2.

23) In December 1997 a further 44 questionnaires were sent out using another edition of Yellow pages, again selecting at random from those listed under “Painters and Decorators”. A copy of the letter, questionnaire and Yellow Pages entry are at exhibit 3. Twelve completed questionnaires were returned, and these are at exhibit 4.

24) Mr Jones states that all 24 respondents recognised the subject trade mark as denoting the source of a wide range of decorating products. He therefore claims the mark does act as a trade mark, and the public has been educated to recognise the marks in suit as indicating the applicant’s decorative products.

25) That concludes my review of the evidence. I now turn to the decision.

## DECISION

26) As a preliminary point the opponent had asked for the decision to be deferred for one month from the date of the hearing. The applicant agreed to a deferral but requested a shorter period. I therefore agreed that the decision would be deferred for a period of two weeks from the date of the hearing.

27) I turn to consider the grounds of opposition under Section 3(1)(c) which reads:

*3 (1) The following shall not be registered -*

*(a) ....,*

*(b) ....,*

*(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,*

*(d) .....*

*Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.*

28) The opponent contends that the marks in suit are barred from registration by Section 3(1)(c) because they describe goods for use in breweries. The goods included in the specification of the marks in suit are general building materials, typically for DIY. They would be used in almost any and every industry as well as in offices and homes. There is no evidence to suggest that any are specific to the brewing industry. Neither is there any evidence that the marks in suit serve in trade to designate kind, quality, origin etc. This ground of opposition therefore fails.

29) The next ground of opposition is under Section 3(3)(b) which reads:

- (3) *A trade mark shall not be registered if it is -*
- (a) *.....*
  - (b) *of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).*

30) The opponents have contended that the marks applied for are deceptive when applied to goods for use other than in breweries. No evidences for this contention has been produced other than a dictionary entry providing meanings for the word “brewer”. The ground of opposition under Section 3(3)(b) therefore fails.

31) Similarly, the opponents have offered no evidence in support of their grounds of opposition under Sections 3(4) and 3(6) and therefore they fail.

32) I next consider the ground of opposition under Section 5(2) which states:

- “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 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.”*

33) An earlier right is defined in Section 6, the relevant parts of which state

- 6.- (1) In this Act an ‘earlier trade mark’ means -*
- (a)...a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.*

34) I have to determine whether the respective marks and goods / services are so similar that there exists a likelihood of confusion on the part of the relevant public. In deciding this issue I rely on the guidance of the European Court of Justice in *Sabel Bv v Puma AG [1998 RPC 199 at 224]*, *Canon v MGM [1999 ETMR 1]* and *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel BV [1999 ETMR 690 at 698]*. It is clear from these cases that: -

- (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

/ 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;

(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 therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

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

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2);

(h) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section.

35) I also take into account the recent case of *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723. The European Court of Justice said of Article 4(1)(b) (transposed into UK law in Section 5(2)(b):

“The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character.....Nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense.”

36) The Court felt that the concept of association of marks in the global assessment of the likelihood of confusion was over emphasised. It is not sufficient for the average consumer to merely associate marks in the sense that if prompted a consumer will call to mind another mark. Thus a mere possibility of confusion, even in situations where a mark clearly has a strong reputation, is not a valid ground for opposition to a trade mark.

37) As is clear from the Annex to this decision the opponents are relying on a number of registrations. The five registrations are very similar in that they all feature a baseball glove with a ball and the words MILWAUKEE BREWERS. There are slight differences in the glove and ball device, and also the words appear underneath the device in some whilst in others they are split with the word MILWAUKEE appearing above the device with the word BREWERS being below the device.

38) The series of two marks applied for are identical other than the second mark appears in four colours. I will therefore regard the series as a single mark which consists of the word BREWERS with the letter “W” appearing as two inverted triangles. Despite the device element, the word would still be recognised by the average consumer as being a stylised form of the name BREWERS.

39) When comparing the mark in suit to MILWAUKEE BREWERS and device, visually the respective marks are quite different. I have already found that despite the device element the average consumer would view the applicant’s mark as a stylisation of the word or name BREWERS and to that extent the applicant’s mark is contained in the opponent’s marks. The opponent’s marks also have the word MILWAUKEE and a device, whereas they lack the stylisation in the applicant’s marks. These differences far outweigh the commonality. Aurally the marks are quite different and unlikely to be confused. The opponent’s mark consists of two words whilst the applicant’s mark has only one word. Conceptually the word BREWERS although a dictionary word would probably be seen in this context as a surname. Whereas the opponent’s marks would be seen as the name of a team, based in the city of Milwaukee USA, or if the consumer were unable to determine that the device is a baseball glove and ball, the mark would be seen as a reference to brewers from the city of Milwaukee, USA. The marks are quite distinct and are not confusable.

40) There is no evidence that the opponent had a reputation in any of the items covered by their various marks at the material date, 29 March 1995. The opponent has provided sales figures in relation to novelties and pennants of only £173 between the years 1991 and 1996. No other sales or promotional figures were provided. Although various claims have been made, particularly by Mr Orlinsky, no supporting evidence relating to the reputation in the UK of the opponents marks has been provided. The evidence supplied refers to the reputation of the game of baseball and that of the American Major League.

41) The opponent contends that the goods of both parties are common place consumer items and would be purchased and used by ordinary members of the public. Specifically they regard the Class 16 goods in the instant application as similar to the “artists’ materials” specified in their registration number 1333493. They also regard the wall coverings and lining paper in Class 27 as similar to the “posters” also found in registration 1333493.

42) Even if I accept that the specific instances outlined in the previous paragraph are identical or similar goods, taking into account all the other factors I do not believe that there is a likelihood of confusion within the meaning of Section 5(2)(b) of the Act. Consequently, the opposition under Section 5(2)(b) fails.

43) If I am wrong in this then I should also have regard to the fact that the opponent’s marks all have a disclaimer which gives no right to the exclusive use of a letter “M” and separately of the words “Milwaukee” and “Brewers”. In the case of “Paco Life in Colour”[2000] RPC 451 the Hearing Officer concluded that:

“It therefore appears to me that the entry of the disclaimer should be regarded as an admission by the proprietor that - in any proceedings based upon the registration with the disclaimer - the disclaimed matter is not to be regarded as in itself distinctive of the trade origin of the proprietor’s goods or services. In these circumstances, use of the disclaimed matter by another party, as a trade mark, cannot, without other similarities,



be sufficient to give rise to a likelihood of confusion with the registered trade mark concerned.”

44) Therefore even if the applicant’s mark were viewed as the word BREWERS solus then the opponent could not have been successful under Section 5(2)(b).

45) The opponent’s submissions under Sections 5(3) and 5(4) are different to those under 5(2) only in that they claim that:

“To the extent that the applicant’s goods are not similar to the opponent’s goods and services, the widespread reputation of the opponent, through media coverage and the like as evidenced in these proceedings, creates a real risk of damage and detriment if the applicant were to be permitted to use its mark, bearing in mind the strongly overlapping customer bases. As far as the Section 5(4) ground of opposition is concerned, this danger is even more real when the similar goods between the parties’ rights are taken into consideration.”



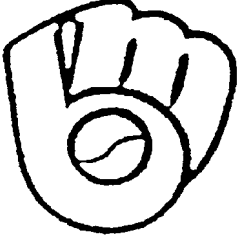
46) The opponent has not shown that, at the relevant date, they had a reputation in the UK in the various MILWAUKEE BREWERS and device marks as signs which identify the source of goods / services, or otherwise. They have merely shown that the game of baseball and, in particular, the American Major League is well known in the UK. Nor have they shown that the “customer bases” overlap. I have already considered the marks when used on identical goods and found that there is no likelihood of confusion because of the dissimilarities between them. In the circumstances the opposition under Sections 5(3) and 5(4) fail.



The opposition having failed the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £1685. This sum to be paid within one month of the expiry of the appeal period or within one month of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 18<sup>TH</sup> day of April 2001

George W Salthouse  
For the Registrar  
The Comptroller General

# ANNEX A

Trade Mark	Number	Date registered	Class	Specification
	1333493	29.1.88	16	<p>Printed articles, cardboard articles and labels, all included in Class 16; printed matter, books, printed publications, pictures, posters, photographs; pencil sharpeners, binders and files, all being articles of stationery; ordinary playing cards; decalcomanias, writing implements, rubber erasers, note pads, drawing rulers, calendars; office requisites (other than furniture) artists' materials (other than colours or varnish); instructional and teaching materials (other than apparatus); but not including any such goods relating to brewing.</p>
	1333494	29.1.88	25	<p>Vinyl gloves, T-shirts, baseball shirts, sleeveless vests, shorts, trousers, tracksuits, socks, footwear, training shoes, tennis shoes, canvas shoes, headwear, hats, baseball caps, visors, jeans, denim skirts, denim jackets, wristbands, jackets, anoraks, sweatshirts, casual clothing for children, sweaters, articles of clothing for babies, boxer shorts, ties, belts, bibs, aprons, coats, pants, overalls, shirts, tank tops, pyjamas, nightgowns, nightshirts, housecoats, underwear, mittens, scarves, swimwear, beach robes, cardigans, jumpsuits and vests, all included in Class 25.</p>
 <p data-bbox="119 1848 430 1881">MILWAUKEE BREWERS</p>	1452981	17.1.91	18	<p>Leather, imitation leather and articles made from all the aforesaid materials; bags; cases; articles of luggage; haversacks; holdalls; rucksacks; backpacks and satchels; key fobs incorporating rings; pocket books and pocket wallets; cheque book cases; card holders; purses; belts; umbrellas and parasols; walking sticks and shooting sticks; all included in Class 18.</p>

	1452982	17.1.91	28	Toys, games (other than ordinary playing Cards) and playthings; gymnastic and sporting articles (other than clothing); parts and fittings for all the aforesaid goods; all included in Class 28
	1452983	17.1.91	41	Entertainment services relating to sport; organising of sporting events and competitions; sports tuition; entertainment services provided during intervals at sports events; physical education and physical training services; production of radio and television programmes; arranging and conducting of live shows and displays; production of cine-films, video films and video tapes; publishing; ticket reservation services; all included in Class 41.