

O/585/20

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3361148

BY

ALESSANDRO CALISTA

TO REGISTER THE FOLLOWING TRADEMARK IN CLASS 43



AND OPPOSITION THERETO NO. 416337

BY

FRANCA DOMENICA IAVARDINO

## Background and pleadings

1. Alessandro Calista (“The Applicant”) applied to register the UK trade mark no. 3361148 for the trade mark as shown on the front cover page. It was filed on 15 December 2018 and published on 22 February 2019 for services in class 43, namely, *“takeaway food and drink services”*.

2. On 15 May 2019, Franca Domenica Iaverdino (“the Opponent”) opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) relying on the following trade marks:

UKTM no.1367534

FRANCA’S

Filed: 13 December 1988

Registered: 18 May 1990

Class 30: Pizza, pasta, farinaceous foods and preparations made from the aforesaid goods, all included in Class 30.

UKTM no. 1367535

FRANCA’S

Filed: 13 December 1988

Registered: 11 January 1991

Class 43: Catering services.

3. The Opponent claims that under section 5(2)(b) there is a likelihood of confusion because the trade marks are similar and are to be registered for goods and services identical with or similar to those for which the earlier mark is protected. In particular the Opponent submits that:

“The contested mark incorporates the Opponent’s mark and so is similar. A consumer encountering the contested marks NANA FRANCA in relation to takeaway food and drink services would believe it to be linked to the Opponent’s catering services provided under the mark FRANCA’S.”

4. The Applicant filed a defence and counterstatement denying the claims, submitting that there are “significant visual aural and conceptual differences such that there is no similarity and therefore no confusion to the public.” Furthermore that “it is not uncommon for consumers to encounter bars/restaurants etc using the same of similar words forenames and/or surnames for businesses and that does not automatically mean they are confused.”

5. In these proceedings, the Opponent is relying upon its UK trade mark registrations, as shown above, which qualify as earlier marks under section 6 of the Act because each was applied for at an earlier date than the Applicant’s contested mark. As both earlier marks have been registered for more than five years at the date the application was filed, ordinarily, they would be subject to the proof of use provisions contained in section 6A of the Act. However, in its counterstatement the Applicant did not require the Opponent to demonstrate use of its marks. Consequently, the Opponent is entitled to rely upon all the goods and services for which the marks are registered, without having to establish genuine use.

6. Both parties are professionally represented; the Opponent by Nash Matthews LLP, the Applicant by Mincoffs Solicitors LLP. Both parties filed evidence. Neither party requested a hearing, however the Applicant filed submissions in lieu which I have taken into account and will refer to as appropriate in the course of this decision. This decision is taken following a careful perusal of all the papers.

### **The evidence**

7. The Opponent’s evidence consists of the witness statement of Franca Domenica Iavardino, the Opponent and owner of several businesses trading under the earlier trade marks, dated 19 October 2019. The Applicant’s evidence consists of the witness statement of Alessandro Calista dated 23 December 2019. Whilst I have read all of the evidence filed, I do not intend to summarise it here, but will return to it as appropriate later in this decision.

## Section 5(2)(b)

8. The opposition is based on section 5(2)(b) of the Act which states as follows:

“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.”

9. The following principles are gleaned from the decisions of the EU courts 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 B.V. Case C-342/97*, *Marca Mode CV v Adidas AG & Adidas Benelux BV, Case C-425/98*, *Matratzen Concord GmbH v 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-334/05P* and *Bimbo SA v OHIM, Case C-591/12P*.

The principles:

(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 greater 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 to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

## **Comparison of the goods and services**

10. When conducting a goods and services comparison, all relevant factors should be considered as per the judgment of the Court of Justice of European Union “(CJEU)” in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, 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.”

11. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

12. In *Gérard Meric v Office for Harmonisation in the Internal Market* (“OHIM”), Case T-133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM - Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or Applicant relies on those goods as listed in paragraph where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

13. Furthermore, in *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

“...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”.

14. Whilst in *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

15. The contested goods and services are as follows:

Opponent's goods and services	Applicant's services
<p data-bbox="204 331 478 365">UKTM no.1367534</p> <p data-bbox="204 389 754 584">Class 30: Pizza, pasta, farinaceous foods and preparations made from the aforesaid goods, all included in Class 30.</p> <p data-bbox="204 689 488 723">UKTM no. 1367535</p> <p data-bbox="204 748 616 781">Class 43: Catering services.</p>	<p data-bbox="809 725 1315 808">Class 43: Takeaway food and drink services</p>

16. The Applicant accepts that the goods and services of both parties are similar but has made no submissions as to the extent of similarity. To my mind the Opponent's *catering services* include the provision of food and drink not only to include the provision at a social gathering but also would include takeaway and drink services. It is my view that the Applicant's contested services are included within the broader category of the Opponent's *catering services* and vice versa. I regard the respective services to be identical according to the principles as outlined in *Meric*. If I am wrong in this finding, then the services will overlap in purpose as both are used for the provision of food and drink. There will be overlap in user as both may be used by members of the general public. There will also be overlap in nature and method of use. I also consider there to be overlap in trade channels, as the same undertakings may provide both services. Consequently, they will be highly similar.

17. In relation to the Opponent's goods in class 30, *pizza, pasta and farinaceous foods and preparations made from the aforesaid goods*, they are all types of convenience foodstuff to be consumed immediately or taken away and heated up at home such that consumers would expect these goods to be sold under the provision of a takeaway service. Even though the goods and services differ in nature they coincide in user and trade channels. Furthermore, taking into account the nature of the Opponent's goods



they are complementary in the sense that the provision of a takeaway service cannot exist without the provision of the foodstuff. These goods and services are indispensable such that the average consumer would consider that they originate from the same undertaking, as envisaged in the case law cited above. In addition, there would also be a degree of competition in so far as customers may choose to buy the goods themselves to cook at home or use the services of a takeaway for the purchase of a pre-prepared meal. Taking into account the caselaw and all of these factors, I consider that the Opponent's goods in class 30 and the Applicant's services in class 43 are similar to a medium degree.

### **Average consumer and the purchasing process**

18. When considering the opposing trade marks, I must determine, first of all, who the average consumer is for the goods and services and then I must then determine the purchasing process. The average consumer is deemed reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion I must bear in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question.<sup>1</sup>

19. In *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), 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 parties were agreed that 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 words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

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<sup>1</sup> *Lloyd Schuhfabrik Meyer*, case c- 342/97.

20. Neither party has specifically addressed the issue regarding the average consumer or the purchasing process, focusing their submissions on the similarity or otherwise of the marks. To my mind taking into account the type of foodstuff and the provision of the services on offer, the average consumer is likely to be a member of the general public at large. In relation to the purchasing process itself I consider that the services will be selected on a fairly frequent basis, primarily via visual means following a display of the name at the actual venue, via the internet or on advertising/promotional material. I do not discount an aural aspect to the selection process however following enquiries made over the telephone or following word of mouth recommendations.

21. With regards the Opponent's goods I consider that they would be self-selected via visual means from a shop or supermarket or over the counter in a restaurant, café or fast food establishment. In the latter scenario there may be an aural aspect to the selection process by a request made to serving staff or when placing an order over the telephone. However, even in these circumstances I consider that there remains a visual aspect to the selection process with consumers perusing a menu before ordering.

22. In relation to the level of attention undertaken for the goods and services, generally fast food establishments are not ordinarily afforded the greatest level of attention relying to a degree on passing trade. Nevertheless, consumers would still consider such things as price, quality, product range and personal taste before selecting the services on offer and such things as dietary requirements, food allergies and intolerances before selecting the goods.

23. Taking all these factors into account therefore, overall, I consider that a medium level of attention would be undertaken for the goods and services.<sup>2</sup>

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<sup>2</sup> *Monster Energy Company v Chris Dominey and Christopher Lapham* BL O/061/19

## Comparison of the marks

24. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....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.”

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

26. The Opponent relies upon its two earlier marks which are identical only differing in relation to their respective specifications. The same comparison will, therefore, apply to both.

27. The respective trade marks are shown below:

Applicant's trade mark	Opponent's trade marks
	FRANCA'S

### Overall impressions

28. The earlier marks consist of the single word FRANCA'S presented in capitals in its possessive form. There are no elements to contribute to the overall impression of the trade marks which resides in the word itself.

29. The Applicant's mark consists of a number of elements, the words NANA and FRANCA, presented in black and red respectively. These words are intersected by a circular device. The device is presented in black and white and includes a drawing of a female head in profile at its centre. The words NANA FRANCA and FINE ITALIAN FOOD appear around the outer edge of the circular device in considerably smaller font. Since the eye is naturally drawn to the element of the mark that can be read and the size of the font used in the Applicant's mark compared to the other elements, I consider that the combination of the words NANA FRANCA plays the greater role in the overall impression. The device and the word elements contained within it will play a lesser role due to its size, as will the figurative element and colour combination. In particular, the words FINE ITALIAN FOOD will have lesser impact due to their size, position and because they will be regarded as descriptive of the type of food provided by the undertaking.

### Visual Comparison

30. The trade marks coincide only in so far as both include the word FRANCA. They differ to the extent that in the Opponent's marks the word FRANCA is presented in its possessive form by the inclusion of an apostrophe and the additional letter S. The

Applicant's trademark also includes additional elements which have no counterpart in the Opponent's trade marks, namely, the colour combination, the word NANA and the device which in itself includes additional written elements. I do not place any great reliance on the colour combination used in the Applicant's mark or that this acts as a distinguishing factor in the visual comparison assessment because, notional and fair use allows trade marks which are registered in black and white to be used in any colour.<sup>3</sup> Having regard to my assessment of the overall impressions of each mark and weighing up the similarities and the differences, I consider that overall the trade marks are visually similar to no more than a medium degree.

### **Aural comparison**

31. With regards the Applicant's mark I consider that only the words NANA FRANCA will be articulated and they will be pronounced as NAN-NAH-FRAN-KAH. The device itself will not be articulated nor the additional verbal elements present within device due to their relative size, descriptive and/or repetitive nature. The Opponent's trade marks will be pronounced as FRAN-KAHS since no articulation will be given to the apostrophe. The parties do not offer any different pronunciations to their respective marks and even if they had, I consider the common element FRANCA would be pronounced identically in any event. Taking these matters into account I consider that aurally the marks are similar to a medium degree.

### **Conceptual comparison**

32. The addition of the element FRANCA in the respective marks will give rise to the concept of a name albeit not particularly common within the UK or to UK consumers. This will be reinforced by the fact that, in the applicant's mark, the word FRANCA is accompanied by the title NANA and, in the opponent's marks, it is in the possessive form. Whilst the Applicant argues that the name Franca would be seen as an abbreviation of the female Italian name Francesca and a common name in Italy, I do not consider that generally UK consumers would necessarily and immediately recognise its origins as such, merely perceiving it as a forename or surname. The use

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<sup>3</sup> *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2014] C-252/12

of the possessive form in the opponent's mark will be seen as indicating goods or services that originate from an individual with either the surname or forename FRANCA. The ordinary meaning will be attributed to the element Nana recognised as an alternative term for grandmother. The Applicant's mark will therefore be regarded as referring to an individual called NANA FRANCA. The device in the Applicant's mark reinforces the concept that the services are provided by an individual named NANA FRANCA. The concept of a grandmother will act as a point of conceptual difference between the marks. Whilst I recognise that there are conceptual differences, the marks coincide to the extent that they both refer to an individual whose name is FRANCA. I consider that the marks will be conceptually similar to a medium degree.

### **Distinctiveness of earlier marks**

33. 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 Attenberger* [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).”

34. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

35. Whilst the Opponent has filed evidence it has not claimed that its trade mark has achieved an enhanced level of distinctiveness. Even if it had, it has not filed any evidence regarding its overall sales, turnover figures or advertising expenditure. Ms Iavardino provided some evidence that Franca’s had won awards but I note that this was a local award in the Bolton area. Likewise, the reviews produced are provided by customers who live in Bolton and the surrounding area and the newspaper articles were published in the Bolton Local news. Whilst Ms Iavardino states that the trade marks are known nationally and globally there is no evidence produced to support such an assertion or that any customers outside the local area would be aware of the Opponent’s business. There has been insufficient evidence to establish how strongly the mark identifies the goods and services as being that of the Opponent in the market as a whole, in order to claim an enhanced level of distinctive character. I am only therefore able to consider the matter based on inherent characteristics.

36. In *Becker v Harman International Industries*, Case C-51/09 P, the distinctive character of a surname was considered. Whilst this case relates to surnames it applies equally to forenames. The CJEU stated as follows:

“Although it is possible that, in part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate to take account of factors specific to the case and, in particular, to the fact that the

surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character.”

37. In addition in *El Corte Inglés, SA v OHIM*, Case T-39/10, the GC found that:

“54. As the applicant asserted in its pleadings, according to the case-law, the Italian consumer will generally attribute greater distinctiveness to the surname than to the forename in the marks at issue (Case T-185/03 *Fusco v OHIM – Fusco International (ENZO FUSCO)* [2005] ECR II-715, paragraph 54). The General Court applied a similar conclusion concerning Spanish consumers, having established that the first name that appeared in the mark in question was relatively common and, therefore, not very distinctive (Case T-40/03 *Murúa Entrena v OHIM – Bodegas Murúa (Julián Murúa Entrena)* [2005] ECR II-2831, paragraphs 66 to 68).

55. Nevertheless, it is also clear from the case-law that that rule, drawn from experience, cannot be applied automatically without taking account of the specific features of each case (judgment of 12 July 2006 in Case T-97/05 *Rossi v OHIM – Marcorossi (MARCOROSSI)*, not published in the ECR, paragraph 45). In that regard, the Court of Justice has held that account had to be taken, in particular, of the fact that the surname concerned was unusual or, on the contrary, very common, which is likely to have an effect on its distinctive character. Account also had to be taken of whether the person who requests that his first name and surname, taken together, be registered as a trade mark is well known (Case C-51/09 P *Becker v Harman International Industries* [2010] ECR I-5805, paragraphs 36 and 37). Likewise, according to the case-law cited in the previous paragraph, the distinctive character of the first name is a fact that should play a role in the implementation of that rule based on experience.”

38. Names, be they surnames or forenames are commonly used as trade marks and are therefore not considered as greatly distinctive. However, the less common the name the greater the effect on the level and degree of distinctiveness attributed to the



mark. I note that the name FRANCA is not a particularly common name in the UK. The addition of the apostrophe and the letter S gives rise to the possessive form of the undertaking which will be regarded as responsible for the goods and services. There are no other elements to contribute to the distinctiveness of the mark and the mark is not descriptive or allusive to the goods or services. I consider, therefore, that it possesses a medium degree of inherent distinctive character.

### **Likelihood of confusion**

39. The purpose of a trade mark is to distinguish the goods/services of one undertaking from another. In considering whether a likelihood of confusion arises, I am required to make a global assessment of all relevant factors based on the facts before me, taken from the point of view of the average consumer, who rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

40. These factors include the interdependency principle where, for example 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. To summarise, I found that the marks possessed no more than a medium degree of visual similarity, a medium degree of aural and conceptual similarity I found the average consumer to be a member of the general public paying a medium level of attention in the selection process primarily using visual means but not discounting aural considerations. I have found the respective goods and services to be identical or similar to a medium degree. I have found the Opponent's mark to possess a medium degree of inherent distinctive character on the basis that the name FRANCA is not particularly common within the UK.

41. I bear in mind that I must consider the marks as wholes whilst keeping in mind the contribution of each component to the distinctiveness of the mark, with the distinctiveness of the common element being key.<sup>4</sup>

42. Taking into account my conclusions and notwithstanding the fact that consumers rarely have an opportunity to compare marks side by side, when encountering the marks both aurally and visually I do not consider that the additional elements present in the Applicant's mark (predominantly the addition of the NANA element) would go unnoticed by the average consumer. I do not consider that the element NANA will be overlooked or not pronounced such that the Applicant's mark will solely be pronounced as "Franca". I also do not consider that the device element will be overlooked. Notwithstanding the fact that the earlier mark has a medium degree of inherent distinctiveness, even when used for identical services, I do not consider there to be a likelihood of direct confusion.

43. In so far as indirect confusion is concerned and its distinction from direct confusion, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, noted 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 recognised 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

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<sup>4</sup> *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

the later mark, I conclude that it is another brand of the owner of the earlier mark.

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).”

44. Furthermore, in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor QC, sitting as the Appointed Person, stressed that the finding of indirect confusion should not be made merely because two marks share a common element. He pointed out that it is not sufficient that a mark merely calls to mind another mark; this is association not indirect confusion.

45. Having noticed the differences between the marks, I see no reason why the average consumer would conclude that the one mark is a brand extension or sub brand of the other or that the goods and services are provided by one and the same undertaking. Even discounting the device it would be highly unusual for a sub brand to remove or add the NANA element from its mark. In my view, whilst the use of the common name FRANCA may call to mind the other party’s mark, the consumer would

not consider that the goods/services came from the same source. As noted by Mr Mellor QC, this is mere association, not indirect confusion. In my view it would be implausible for consumers to believe that there is an economic link between them merely because the use of FRANCA/FRANCA's brings to mind the other's mark. I do not consider that consumers will think that the addition of the NANA element is a natural brand extension or different range being provided by the same or related undertaking as envisaged in *LA Sugar*. It is far more likely that the consumer will view this as a coincidental use of the same name by separate undertakings. I do not consider that there would be a likelihood of indirect confusion.

46. Based upon these conclusions the opposition under section 5(2)(b) fails and subject to any appeal the application can proceed to registration.

### **Costs**

47. As the Applicant has been successful it is entitled to a contribution towards its costs. Award of costs in proceedings are based upon the scale as set out in Tribunal Practice Notice 2 of 2016. In making this award, I have taken into account the fact that, whilst the applicant filed evidence, it has not been of assistance to me in reaching this decision. I have reduced the award accordingly. Consequently, I award costs to the Applicant on the following basis:

Preparing a defence and counterstatement:	£200
Considering the Opponent's evidence:	£300
<b>Total:</b>	<b>£500</b>

48. I order Franca Domenica Iaverdino to pay Alessandro Calista the sum of £500 as a contribution towards its costs. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 19th day of November 2020

Leisa Davies

For the Registrar