

O-0892-24

TRADE MARKS ACT 1994

IN THE MATTER OF

THE UK DESIGNATION OF

INTERNATIONAL REGISTRATION NO 1681927

IN THE NAME OF

FELLAS GIDA VE SAĞLIK ÜRÜNLERİ SANAYİ VE TİCARET ANONİM ŞİRKETİ

FOR THE MARK:

FELLAs

IN CLASS 30

AND

OPPOSITION THERETO (UNDER NO. 438654)

BY

BIRDS EYE PIZZA LIMITED

BACKGROUND

1) Fellas Gıda Ve Sağlık Ürünleri Sanayi Ve Ticaret Anonim Şirketi ('the holder') is the holder of the following International Registration ('IR'):

IR 1681927

FELLAS

Office of Origin: Turkey

International Registration date: 15 April 2022

For goods in class 30 (as set out in the table at paragraph 13 of this decision)

2) The holder designated the UK for protection of the IR on 15 April 2022. It was published in the Trade Marks Journal for opposition purposes on 02 December 2022 and opposition was subsequently filed by Birds Eye Pizza Limited ('the opponent'). The opponent claims that the UK designation offends under Section 5(2)(b) of The Trade Marks Act 1994 ('the Act'). Two earlier trade mark registrations are relied upon, as follows:

- **UKTM 3589750 ('750)**

GOODFELLAS

For goods in classes 29 and 30 (as set out in the table at paragraph 13 of this decision)

Filing date: 03 February 2021

Date of entry in register: 11 June 2021

- UKTM 918008842 ('842)



For goods in classes 29 and 30 (as set out in the table at paragraph 13 of this decision)

Filing date: 10 January 2019

Date of entry in register: 15 June 2019

3) The trade marks relied upon by the opponent are both earlier marks, in accordance with section 6 of the Act¹. As they did not complete their registration procedure more than five years prior to the date on which the holder designated the UK for protection of its mark, they are not subject to the proof of use provisions, as per Section 6A of the Act.

4) The holder filed a counterstatement. It states that the respective marks are visually, aurally and conceptually distinct. It argues that the 'Fellas' part of the earlier marks, being the latter part of those marks, may be overlooked. It also points out that the contested mark is presented in red and refers to the different stylisation of the respective marks. It accepts that there is 'some identity' between the respective goods but it does not identify which of its goods this concession relates to. It further states that some of the applicant's other goods (also not identified) are not covered by the opponent's marks. It requests that the opponent identify where the claimed identity or similarity lies in that respect.

¹ Following the end of the transition period of the UK's withdrawal from the EU, all EUTMs registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). Accordingly, the opponent's comparable mark (EU) ('842) retains the same filing date and registration date of the EUTM from which it derives.

5) The holder is represented by ip21 Limited; the opponent is represented by Haseltine Lake Kempner LLP. Neither party filed any evidence or submissions during the evidence rounds. Neither party requested a hearing. Only the opponent filed submissions in lieu². I make this decision based on the papers before me.

DECISION

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

7) The relevant section of the Act provides:

“5. - (2) A trade mark shall not be registered if because –

(a)....

(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.

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

² Dated 19 December 2023

8) The leading authorities which guide me are from the CJEU: *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 great degree of similarity between the marks, and vice versa;

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

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

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

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

Comparison of goods

9) All relevant factors relating to the goods should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU, Case C-39/97, stated at paragraph 23 of its judgment:

“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.”

10) Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

- (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.

11) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06, it was stated:

“It is true that goods are complementary if 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..”

In *Sanco SA v OHIM* Case T-249/11, the General Court (GC) found 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 was 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-O-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.”

12) Finally, I note the decision in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05) (*‘Meric’*), where the GC held 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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

13) The goods to be compared are:

Opponent's goods	Holder's goods
<p>Class 29: Meat, fish, poultry and game; meat products, fish products, poultry products and game products; processed potato and potato products; vegetables and vegetable products; prepared meals consisting primarily of meat, fish, poultry, game or vegetables; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams; eggs; edible oils; soups.</p> <p>Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals; bread; pastry; pastry products; pasta and pasta products; chilled ready meals consisting wholly or substantially wholly of pasta; chilled ready meals consisting wholly or substantially wholly of pizza; pizza; pizza products; dough; dough balls; flavoured breads; pancakes; sweet glazes and fillings; sauces; confectionery; ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, spices; ice cream; fruit sauces.</p>	<p>Class 30: Coffee, cocoa; coffee or cocoa based beverages, chocolate based beverages; pasta, stuffed dumplings, noodles; pastries and bakery products based on flour; desserts based on flour and chocolate; bread; honey, bee glue for human consumption, propolis for food purposes; condiments for foodstuff, vanilla (flavoring), spices, sauces (condiments), tomato sauce; yeast, baking powder; flour, semolina, starch for food; sugar, cube sugar, powdered sugar; tea, ice tea; confectionery, chocolate, biscuits, crackers, wafers; chewing gums; ice-cream, edible ices; salt; cereal-based snack food, popcorn, crushed oats, com chips, breakfast cereals, processed wheat for human consumption, crushed barley for human consumption, processed oats for human consumption, processed rye for human consumption, rice; molasses for food; candy bars; grain-based food bars also containing dried fruits, chocolate, nuts; ice cream bars; quinoa-based food bars; cereal bars; chocolate-based meal replacement bars; high-protein cereal bars; bars of sweet jellied bean paste (yohkan); chocolate based ingredient for use in confectionery products, chocolate</p>

	<p>bars; muesli bars; frozen confections, namely, freezer bars; granola-based snack bars; chocolate bars; fruit ice bar; frozen juice bars; chocolate-based ready-to-eat food bars; ready to eat, cereal derived food bars; ice milk bars; grain-based food bars; cereal-based snack bars; fruit ice bars; steel cut oats; oat flakes; rolled oats and wheat; rolled oats; processed oats; granola snacks; granola; crushed oats; cereal based energy bars; grain-based chips.</p>
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14) The holder's 'Coffee, cocoa' are self-evidently identical to the same terms in the opponent's specification.

15) The holder's 'coffee or cocoa based beverages' are highly similar, if not identical, to the opponent's 'coffee' and 'cocoa'.

16) The holder's 'chocolate-based beverages' are highly similar, if not identical, to the opponent's 'cocoa'.

17) The holder's 'pasta, stuffed dumplings, noodles; pastries and bakery products based on flour; desserts based on flour and chocolate; bread; flour, semolina, starch for food; cereal-based snack food, popcorn, crushed oats, corn chips, breakfast cereals, processed wheat for human consumption, crushed barley for human consumption, processed oats for human consumption, processed rye for human consumption, rice; grain-based food bars also containing dried fruits, chocolate, nuts; quinoa-based food bars; cereal bars; high-protein cereal bars; muesli bars; granola-based snack bars; ready to eat, cereal derived food bars; grain-based food bars; cereal-based snack bars; steel cut oats; oat flakes; rolled oats and wheat; rolled oats; processed oats; granola snacks; granola; crushed oats; cereal based energy bars;

grain-based chips' all fall within the opponent's broad term 'flour and preparations made from cereals'. Those goods are therefore identical, as per the *Meric* principle.

18) The holder's 'honey' is identical to the opponent's 'honey'.

19) The holder's 'bee glue for human consumption, propolis for food purposes' and the opponent's 'honey' are all goods which are produced by bees and will be harvested from beehives (propolis/bee glue being by-products of the honey-making process by bees). The respective goods may therefore come from the same source and may share trade channels. Although the respective nature may not be the same, all will be consumed for nutritional purposes. However, it is not obvious to me that the opponent's goods are likely to be in competition with the holder's goods. I find a medium degree of similarity between the holder's 'bee glue for human consumption, propolis for food purposes' and the opponent's 'honey'.

20) The holder's 'condiments for foodstuff' and 'salt' are identical to the opponent's 'salt', either on the *Meric* principle or self-evidently.

21) The holder's 'vanilla (flavoring), spices' are identical to the opponent's 'spices'.

22) The holder's 'sauces (condiments), tomato sauce' are identical to the opponent's 'sauces'.

23) The holder's 'yeast, baking powder' is self-evidently identical to the same terms in the opponent's specification.

24) The holder's 'sugar, cube sugar, powdered sugar' are identical to the opponent's 'sugar'.

25) The holder's 'tea, ice tea' are identical to the opponent's 'tea'.

26) The holder's 'confectionery, chocolate, biscuits, crackers, wafers; chewing gums; candy bars; chocolate-based meal replacement bars; bars of sweet jellied bean paste (yohkan); chocolate based ingredient for use in confectionery products, chocolate

bars; frozen confections, namely, freezer bars; chocolate bars; chocolate-based ready-to-eat food bars' are identical to the opponent's 'confectionery', either self-evidently or on the *Meric* principle.

27) The holder's 'ice-cream, edible ices; ice cream bars; fruit ice bar; frozen juice bars; ice milk bars; fruit ice bars' are identical to the opponent's 'ice cream' and/or 'ices'.

28) The holder's 'molasses for food' is highly similar, if not identical, to the opponent's 'treacle' (they are both thick, dark syrups made during the process of making sugar and are used as an ingredient in cooking).

Average consumer and the purchasing process

29) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. 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. (as he then was) 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.”

30) The average consumer for the goods at issue is a member of the general public. The goods are typically low-cost purchases and are likely to be purchased fairly frequently. The consumer may consider factors such as flavour, ingredients, allergens and/or nutritional benefits. I would expect no more than a medium degree of attention to be paid during the purchase. The purchasing act will be primarily visual as the goods will be sought out on shelves in retail establishments and the like. Aural considerations

are, however, borne in mind given that the goods may be the subject of discussions with sales staff, for example.



Comparison of marks

31) 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.”

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

32) The marks to be compared are:

Opponent's marks	Holder's mark
Mark '750: 	

Mark '842:



Overall impressions

33) The holder's mark consists of the word 'Fellas', presented a slightly stylised red font. The mark is overwhelmingly dominated by the word 'Fellas' with the colour and stylisation playing a far lesser role.

34) Turning to the opponent's marks, mark '750 is presented as a single word, 'GOODFELLA'S', in a stylised font where the apostrophe appears to be a triangular shape, reminiscent of a pizza slice. The holder argues that the 'Fellas' part of the earlier mark, being the latter part of the mark, may be overlooked (this submission is made in respect of both earlier marks). I disagree. The mark is dominated by the word 'GOODFELLA'S', with the stylisation playing a lesser role.

35) In the '842 mark, the word 'GOOD' is presented in a different font to 'FELLA'S', emphasising the presence of two separate words in the mark ('GOOD' and 'FELLAS'). There is also the upper and lower lining around the words in the mark which bows out around the word 'GOOD' (but not around 'FELLA'S') further emphasising that the mark consists of two separate words, 'GOOD' and 'FELLA'S'. It is those words which dominate the overall impression of the mark. The black background, font, upper and lower linings and pizza-slice stylisation of the apostrophe all play a lesser role than the words.

Comparison with mark '750

36) Visually, both marks consist of the word 'FELLAS', albeit that that word contains a stylised apostrophe before the letter 's' in the opponent's mark which is not present in the holder's mark. The respective fonts/stylisation are also different. The fact that the holder's mark is presented in red is not a material difference because the opponent's mark could, notionally, be used in the same colour. The opponent's mark also contains the word 'GOOD' (which is combined with the word 'FELLA'S) at its beginning which is not present in the holder's mark and this, therefore, creates a visual difference. Overall, I find a medium degree of visual similarity between the marks.

37) Aurally, both marks share the word 'FELLAS' which is pronounced identically, as two syllables, FELL-AS (the presence/absence of the apostrophe does not affect the pronunciation). However, the opponent's mark also contains the word 'GOOD' which will form the first syllable of the mark and which is not present in the holder's mark. It follows that the opponent's mark consists of three syllables overall. The first of those syllables is absent from the holder's mark but the second and third syllables are identical to the holder's mark. Overall, I find an above-medium degree of aural similarity between the marks.

38) Conceptually, the holder's mark is likely to be perceived as an informal way of referring to men or fellows. The holder submits that its mark is conceptually distinct from the opponent's mark but provides no further explanation as to why this is so. The opponent submits that its mark will be perceived as meaning a 'good person or fellow' because, it submits, the word 'GOOD' simply qualifies the word 'FELLAS' to mean a good fella. I agree that the average consumer, or at least a significant proportion of average consumers, are likely to perceive the opponent's mark as simply meaning 'good men/fellows' given that this is the ordinary and natural combined meaning of the well-known laudatory word, 'GOOD', with the well-known word, 'FELLAS'. The marks are, on that basis, conceptually highly similar. (It matters not that there may be another, separate, significant proportion of consumers who perceive the opponent's mark in some other way, which has not, in any event, been identified by the holder.)

Comparison with mark '842

39) Visually, both marks contain the word 'FELLAS' but the opponent's mark also contains an apostrophe before the 'S' in the shape of a pizza slice which is not present in the holder's mark. The fonts used are also different. Again, the colour red in the holder's mark is not a material difference for reasons already explained. The presence of the stylised word, 'GOOD', the upper and underlining and the black rectangular background in the opponent's mark, which are not present in the holder's mark, are all points of visual difference between the marks. Notwithstanding those differences, I find a medium degree of visual similarity between the marks overall.

40) Aurally, I find the marks to be similar to an above-medium degree, for the same reasons given in paragraph 37, above.

41) Conceptually, I find that the marks are highly similar for the same reasons as given in paragraph 38, above.

Distinctive character of the earlier mark

42) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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).”

43) The opponent submits that neither of its marks have any particular meaning in relation to the goods relied upon and have a normal (medium) degree of inherent distinctiveness. I agree. The opponent has filed no evidence to show any enhanced distinctiveness through use.

Likelihood of confusion

44) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

45) I will begin by considering the likelihood of direct confusion. The respective goods covered by the earlier marks are either identical, highly similar or similar to a medium degree to the holder’s goods. Both earlier marks have a medium degree of inherent distinctiveness. Each earlier mark has a medium degree of visual similarity, an above-medium degree of aural similarity and a high degree of conceptual similarity with the holder’s mark. Weighing all these factors, and bearing in mind, in particular, that the

purchasing act will be primarily visual and that there is only a medium degree of visual similarity between each of the earlier marks and the holder's mark, I find that there is no likelihood of either earlier mark being mistaken for the holder's mark, notwithstanding the potential for imperfect recollection. There is no likelihood of direct confusion in respect of either earlier mark.

46) I now turn to consider the likelihood of indirect confusion. In this connection, I bear in mind that in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10 (*L.A. Sugar*), Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand

extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

47) I also keep in mind that in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion. Furthermore, it is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

48) I bear in mind that the categories listed above in *L.A. Sugar* are, of course, not an exhaustive list of all the ways in which indirect confusion can occur; they are merely examples of the way in which it tends to occur.

49) In the case before me, I find that the average consumer is likely to believe that the respective goods come from the same or linked undertaking(s). I come to this conclusion having borne in mind, particularly, that: i) the respective goods are identical, highly similar or at least similar to a medium degree, ii) the respective marks are visually similar to a medium degree and aurally similar to an above-medium degree, iii) the addition of the word 'GOOD' to the word 'FELLAS' will be seen, by at least a significant proportion of average consumers, as a laudatory qualifier of the word 'FELLAS' and iv) those average consumers are likely to perceive the respective marks as being conceptually highly similar. I find that those average consumers are likely to believe that the holder's mark is a brand extension of both earlier marks. There is a likelihood of indirect confusion in respect of both earlier marks.

COSTS

50) The opponent has been successful and is entitled to an award of costs. The relevant guidance for assessing the cost award in the instant case can be found in Tribunal Practice Notice 2/2016. Using that guidance, I award the opponent costs on the following basis:

Official fee	£100
Preparing a statement and considering the other side's statement	£300
Preparing written submissions in lieu	£300
Total:	£700

51) I order Fellas Gida Ve Sağlık Ürünleri Sanayi Ve Ticaret Anonim Şirketi to pay Birds Eye Pizza Limited the sum of **£700**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 13th day of September 2024

Beverley Hedley
For the Registrar,
the Comptroller-General