

O-311-10

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2502165  
IN THE NAME OF FANELLI'S PIZZA LIMITED  
FOR REGISTRATION OF THE TRADE MARK  
FANELLI'S PIZZA AND DEVICE IN CLASSES 30 AND 43**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 98929  
IN THE NAME OF BOBOLI BENELUX B.V**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No. 2502165  
in the name of Fanelli's Pizza Limited  
for registration of the Trade Mark  
Fanelli's Pizza and Device in Classes 30 and 43**

**And**

**IN THE MATTER OF Opposition thereto under No. 98929  
in the name of Boboli Benelux B.V**

**DECISION**

1. On 11 November 2008, Fanelli's Pizza Limited applied to register the following trade mark:



in respect of the following goods and services:

- Class 30** Pizzas, pizza bases, sauces, dressings and toppings for pizza's; prepared meals and constituents for meals; snack foods.
- Class 43** Restaurant services; carry-out restaurant services; preparation of foodstuffs for consumption on or off the premises; preparation of pizzas for delivery to other premises; catering for the provision of food and drink; take-away food services.

2. The applicants subsequently filed a Form TM21 restricting the goods for Class 30 to the following:

- Class 30** Ready made pizzas sold complete.

3. On 2 April 2009, Boboli Benelux B.V. filed a notice of opposition, the grounds being in summary:

**Under Section 5(2)(b)**

because the application is for a mark that is similar to the opponent's earlier Community Trade Mark for the mark PANELLI which is registered in respect of "Bread and bread products" which the opponents assert are identical or similar to the goods and services for which the applicants seek registration.

4. The applicants filed a counterstatement in which they deny the grounds on which the application is based.
5. The applicants and the opponents both ask for an award of costs in their favour.
6. Both sides filed evidence in these proceedings, which, insofar as it may be relevant I have summarised below. The matter came to be heard on 8 July 2010 when the applicants were represented by Mr Max Stacey of Baron Warren Redfern, their trade mark attorneys. The opponents were not represented but filed written submissions in lieu of attending.

**Opponent's evidence**

7. This consists of a Witness Statement dated 4 November 2009 from Vanessa Ann Broughton Lawrence, a partner in the firm of A. A. Thornton & Co, the opponent's representatives in these proceedings. Ms Lawrence refers to the following exhibits although makes no comment on their relevance to these proceedings:

- VABL 1** A decision of the Opposition division of the OHIM relating to an opposition whereby the words GINO PIZZAS had been opposed on the basis of earlier Spanish trade marks for the words GINO placed on a figurative background.
- VABL2** An extract from the web pages of Boboli that refers to the company having been baking pizza bread since 1998 and that "At this moment we supply the biggest players in Europe..." The first page bears a copyright indication of 2005. The header page bears ovals containing representations of four national flags although none are from the UK.
- VABL3** A decision of the Opposition division of the OHIM relating to an opposition whereby the word PanEsprit had been opposed on the basis of an earlier Community trade mark for the word ESPRIT.
- VABL 4** An extract from the Pizza Express At Home website.
- VABL 5** An extract from the Community Trade Mark Register relating to the earlier mark, No. 4346953 relied upon by the opponents in these proceedings.

I will give further details of the decisions exhibited and the earlier mark relied upon in my decision.

## **Applicant's evidence**

8. This consists of a Witness Statement dated 4 January 2010 from James Maxwell Stacey, a trade mark attorney and partner in the firm of Baron Warren Redfern, the applicant's representatives in these proceedings. Mr Stacey confirms that the contents of his Statement come from either his own research and knowledge, or from Mr Graham Seville, the founder and ongoing director of the applicant.

9. Mr Stacey introduces Exhibits JMS1 and JMS2 which consist of an extract from the Companies House website (showing the applicants to have been incorporated on 13 April 2003) and a copy of the company incorporation papers (listing Mr Seville as a director), respectively. Exhibits JMS3 to JMS8 consist of copies of the annual accounts for the years 31 January 2004 through to 31 January 2009. Exhibit JMS9 consists of a copy of the Annual Return for the period ending 13 April 2009, Mr Stacey noting that Mr Seville is shown as an ongoing director of the company.

10. Mr Stacey goes on to refer to and exhibit details of the trade mark FANELLI'S FAMOUS PIZZA and Device which he says had not been renewed due to an oversight. Exhibit JMS11 consists of e-mail exchanges relating to the redesign and application for the newer version that is the subject of these proceedings. Mr Stacey notes that the word FANELLI has appeared in "substantially similar marks since first registered" and in a stylisation that has "remained constant".

11. Mr Stacey states that the applicant has run a pizza take-away/delivery outlet under the name FANNELI'S since around 1993, Mr Stacey referring to the e-mail dated 20 March 2009 shown as Exhibit JMS12, in which Mr Seville affirms that the FANELLI name has been used for some 16 years. Exhibit JMS13 consists of an extract from Yell.Com showing the applicants to currently have four outlets. Exhibit JMS14 consists of an extract from the applicant's website "currently under construction" showing the current menu, Mr Stacey referring to the name FANELLI appearing in the name of several pizzas. Exhibit JMS 15 consists of a further menu and promotional flyer that Mr Stacey says was available in August 2003 and updated to the website as of 28 August 2003.

12. Mr Stacey submits that Italian sounding names are often adopted for pizza restaurants and take-aways, in support referring to a further extract from Yell.Com (Exhibit JMS16) under the category Pizza Delivery and Take-Away. Mr Stacey says that he undertook the research and copied the results into a word document to save paper. Exhibit JMS17 consists of extracts from two dictionaries showing the word "pizza" to have Italian origins, and a list of pizzas available from Waitrose and Pizza Express.

13. The evidence folder also contains written submissions filed on behalf of the applicants. Being submissions it is neither necessary nor appropriate that I summarise them here. I will, of course take them fully into account in my determination of this case.

14. That concludes my review of the evidence insofar as it is relevant to these proceedings.

## Decision

15. The ground of objection is based upon Section 5(2)(b) which reads as follows:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected

(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.”

16. An earlier trade mark is defined in Section 6 of the Act as follows:

“6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK), or international trade mark (EC) 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,”

17. The opponents rely on one prior registration, Community Trade Mark (CTM) No. 4346953 for the following trade mark:



18. This has a filing date of 18 March 2005 and achieved registration on 10 July 2007. As the date of registration is within five years prior to the date on which the application in suit was published (2 January 2009) the provisions of The Trade Marks (Proof of Use, etc.) Regulations 2004 do not apply.

19. In the assessment of the likelihood of confusion neither the applicants nor the opponents referred me to any specific case law, the closest it got was a statement to the effect that the case law relating to such an assessment is well established, which I agree it is. With this in mind I propose to determine the issues by reference to the guidance from the case law

provided by the ECJ in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)* in that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(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; *Sabel BV v Puma AG*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(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; *Sabel BV v Puma AG*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) 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); *Sabel BV v Puma AG*,

(i) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) 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; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-3/03P *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* [2004] ECR I-3657 at 32. That is the case where the component in the complex is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it (Case T-6/01 *Matratzen Concord v OHIM – Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph 33, and Case T-28/05 *Ekabe International v OHIM – Ebro Puleva (OMEGA3)* [2007] ECR II-4307, paragraph 43, *Shaker di L. Laudato & C. Sas v OHIM (LIMONCELLO)*)

20. So, where marks have a number of component features it is the contribution of the individual elements to the mark as a whole and in the impression conveyed to the “average consumer” of the goods in question that are important factors when considering whether two marks are similar and the potential for confusion as part of the “global appreciation”. Therefore, before looking at the question of whether the respective marks are similar it is necessary to look first at the distinctiveness and dominance of the component parts. The goods here are a foodstuff and the service related to foodstuffs ready prepared for consumption. These are goods and services that are used by the public at large who, for the record, I take to be the notional “relevant consumer”. This is what the applicants contend and I have no submissions from the opponents to the contrary.

21. As far as I am aware Panelli is not an English word, common or otherwise. Nor is there any evidence that it has any descriptive relevance for the goods for which it is registered in any other language; it is, as far as I am aware an invention. I see the oval as no more than a vehicle to contain the word and of no distinctive significance.

22. The applicant’s mark has a number of features. The first is the word Fanelli’s in a fairly plain block script, albeit with some stylisation by the use of oversized “F” and “S” with the word “PIZZA” beneath in smaller lettering. As far as I am aware Fanelli’s is not a word that appears in the English language, nor is there any evidence that it describes any characteristic of the goods for which it sought to be registered in any other language. The “apostrophe” preceding the terminal letter “S” creates a mark in the possessive or pluralised form creating the appearance of a name. Whilst this could be a surname there is no evidence that it is, so I do not need to question its distinctiveness by reference to the guidance in the ECJ’s judgment in Case C-404/02, *Nichols plc v Registrar of Trade Marks* (16 September 2004). The word “PIZZA” is self-evidently a description of the goods and service connected with the preparation and sale of such goods. The words Fanelli’s Pizza are placed on a rather basic depiction of what is probably intended to be the earth, with a caped cartoon figure flying overhead carrying a box marked “PIZZA”; a flying superhero pizza delivery man. Whilst the word FANELLI’S is the most eye catching part of the mark, this graphical element is distinctive in its own right and contributes to the overall distinctive character of the applicant’s mark.

23. In determining the similarity or otherwise of the respective marks I am required to consider whether, and to what extent there are visual, aural and conceptual similarities and to make the assessment by reference to the overall impression created by the marks bearing in mind my findings on the distinctiveness and dominance of their components. I am also mindful of the decision in *Claudia Oberhauser v OHIM (Fifties)* [2003] E.T.M.R. 58, and in *Criminal Clothing Ltd v Aytan's Manufacturing (UK) Ltd*, [2005] EWHC 1303 which adds that the circumstances in which the relevant goods and the trade marks are encountered by the consumer, particularly at the point at which the purchase is made, is also an important consideration. That matter must be considered by applying an assessment of all relevant factors.

24. If there is any likelihood of confusion it must be between the word PANELLI and FANELLI'S, although in reaching my decision on this matter I cannot disregard any other element unless its contribution to the mark is negligible within the overall impression.

25. Foodstuffs and in particular pizzas tend not to be high value items, such that where a purchase is made it will be done with a reasonable rather than a high degree of care and attention. With pizzas the attention is probably more focused on the type of crust and the toppings rather than the mark under which they may be sold.

26. In a visual comparison it is easy to see the similarity in the respective marks. FANELLI'S and PANELLI are but one letter difference in length, and are the same from the second letter to the letter "i". Then there is the difference. In that the mark applied for has an apostrophe and the terminal letter S. The initial letters "P" and "F" can be quite similar in shaping when in the same font but that is not the case here. The opponent's mark is in a rounded italicised script whereas the mark applied for is in a very angular font with a shadow effect. That the letter "F" is enlarged makes it clear it will be seen for what it is, and then there is the terminal letter "S" which is also enlarged. I take the view that in the form that they are shown, these word elements may have visual similarities but are not visually similar. Factor in the graphical elements, particularly in the applicant's mark and they are even further apart in appearance.

27. Given that the respective marks are identical from their second to sixth letters it would be surprising if they did not have any phonetic resemblance. This similarity is enhanced by the fact that the initial letters are both soft in sound. There is a tendency to laziness in the enunciation of the endings of words, such that unless the letter combination creates a particularly hard sound the termination will be slurred or just drift away. That is not the case here, reducing the impact of the applicant's mark being in the pluralised or possessive form. In referring to the applicants I see no reason why the consumer would use the mere description PIZZA. I consider the respective marks to be aurally similar.

28. As I have already said, as far as I am aware neither PANELLI nor FANELLI'S has any meaning for the goods/services or any of their characteristics, or at least none that has been brought to my attention and I am not aware of any. They appear to be inventions but that does not automatically mean that is the message and only message they send to the consumer. Mr Stacey provides evidence (JMS16) obtained from Yell.com to illustrate that there is widespread practice of adopting Italian sounding names for pizza outlets to add an air of authenticity. The opponents point to the absence of names that sound like PANELLI which is the case.

29. It seems likely that PANELLI will be perceived by the relevant consumer as being a foreign word, possibly Italian, and potentially also a name although certain amount of thought construction is required to reach this conclusion. Exactly what PANELLI will signify is open and will be determined by the consumer. As already mentioned the applicant's mark is a word in the pluralised or possessive form and followed as it is by the product description PIZZA creates a certainty that it will be seen as a name and most probably that of a supplier of the stated goods. This is even more likely given the depiction of the globe and superhero deliveryman above. So to the extent that they are likely to be taken as foreign words they will send the same message to the consumer, but whether they will say "these are both names" let alone the names of the supplier of pizzas is far from certain.

30. Balancing of these assessments I consider the differences to outweigh the similarities such that whilst there is some similarity the respective marks cannot be considered similar.

31. When comparing the respective goods, the established tests in assessing similarity is set out in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 and *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*. I also have regard to the decision of the General Court in *Saint-Gobain SA v OHIM* Case T-364/05. I must consider the uses and users of the respective goods or services, the physical nature of the goods, and the trade and distribution channels through which they reach the market. In the case of self-serve consumer items this will also include consideration of where the respective goods are likely to be found, particularly in multi product outlets such as supermarkets. The extent that the respective goods or services are competitive or complementary is also a relevant consideration guided by how they are classified in trade, and known by the relevant consumer.

32. The application seeks registration in respect of "ready-made pizzas sold complete" in Class 30, and services for the preparation and provision of foodstuffs (including pizza) and beverages by a number of means. This compares with the specification of "Bread and bread products" for which the earlier mark relied upon by the opponents is registered.

33. In their submissions the opponents mention the use that the applicants have made of PANELLI'S PIZZA, not so much in relation to the mark, other than to say that this has been without the globe and the flying deliveryman spatially separated, but rather that this use has included "garlic bread" included as part of a promotion with a pizza. This, they say, is at odds with the applicant's claims that pizzas and bread are not similar, or that services for the provision of food and drink do not share similarities with the products offered through such a service. Setting aside the mere fact that a single trader may sell a range of goods does not make the goods sold similar, the decision I am required to make is a notional one based on the extent of the wording of the respective specifications, and using the criteria set out above. That said, evidence from the trade can be useful in assessing the question of similarity.

34. I have already mentioned that the users are to be considered as the public at large. The respective goods are types of foodstuffs, and in the applicant's case also the service of the preparation and provision of food, notionally including bread products, and beverages. The definition for "Pizza" given by Collins English Dictionary refers to the base as being made of "dough" rather than "bread", whereas the Oxford reference work "A-Z of Food and Drink" refers to pizza as "The notion of taking a flat piece of bread dough...". There is no evidence, but I am also aware that there is a type of pizza that uses what is commonly referred to as

“French bread” as a base instead of a traditional pizza base. There is also a type of garlic bread platter that is flat in the same way as a pizza base, so it is reasonably clear that in their use and nature the respective goods are potentially the same and/or similar. Whilst the end product of the service could be the same in physical nature to the opponent’s bread products, the service itself cannot be. I see no reason why the opponent’s bread products and the applicant’s pizzas could not reach the market through the same trade and distribution channels, pizzas are, after all, a bread type base with a topping.

35. There is evidence of the applicants selling garlic bread products (JMS14 and JMS15) as a menu option alongside pizzas which is pretty conclusive in showing that these goods are capable of reaching the market and consumer from the same outlets. Potentially this is possible from any location selling foodstuffs, for example, delicatessens, shops, supermarkets restaurants and takeaways, etc. In respect of the services I see no reason why the same supplier-wholesaler chain could not be used, although as the provider of restaurant and takeaway services and services for the preparation of foodstuffs for consumption it is the applicants who will be the consumer interface and there can be no convergence at the point of sale. The descriptions “preparation of pizzas for delivery to other premises” and “catering for the provision of food and drink” probably refer to a delivery service to consumers but are wide enough to cover a service of providing these goods to others for onward sale, opening the possibility of use in the same retail outlets.

36. Where the respective goods are available in shops for purchase and later preparation it is likely that these will be open for self-selection, but may also be prepared to order behind a counter. With their similarity in nature it seems possible, even likely, that goods such as garlic bread and pizza bases would be sold in reasonably close proximity to complete pizzas although I have no specific evidence on this point. Where sold prepared in a service environment such as a restaurant or takeaway they will almost certainly be obtained on request, but may be obtainable for selection at self-service cafes and the like. Insofar as these are all foodstuffs it could be argued that they compete to be the choice to satiate the hunger, but in my experience bread products such as garlic bread are provided as side orders whereas a pizza is a main dish. I therefore consider such goods to be complementary rather than in competition. Insofar as the restaurant/takeaway offers the choice of having the foodstuffs served ready for consumption as an alternative to preparation at home the opponent’s goods and applicant’s services are also complementary.

37. I have no evidence of how the respective goods are classified in trade, but to the extent that they are foodstuffs this is likely to be the same. I would have thought that a service even for the provision of foodstuffs would be classified in a different trade sector. This, I believe would also reflect the consumers understanding of the goods and services.

38. In support of their claim that the respective goods and services are similar the opponents have provided two Community Trade Mark decisions. The first is Case R 57/2000-2 which is a decision of the Second Board of Appeal in the opposition by *Dobra GmbH* to an application made by *Autogrill S.P.A* to register a trade mark in relation to goods in Class 30 including “flour and preparations made from cereals, bread, pastry and confectionery, ices” and services in Class 42 including “restaurants, coffee-shops, snack-bars, ice-cream parlours and pizzerias, including those self-serving type...”. The Board stated that “...’bread’ and ‘flour confectionery’ are specific ‘bakery products’, and ‘preparations made from cereals’ are similar products to ‘pizzas’ and ‘bakery products’”. The Board further concluded that there “is

an element of similarity between ‘services in relation to a pizzeria’ and ‘pizzas’ that created a possibility that a consumer might attribute an identical origin when distinguished by an identical or similar sign”. I have no argument with this.

39. The second decision exhibited by the opponents is No. 1278/2003 whereby Sigla S.A. opposed the registration of the word mark *GINO PIZZAS* by Société des Etablissements Bougro Sodebo based on an earlier composite mark including the word GINOS. Given that the mark applied for consists of the singular form of the earlier mark followed by a mere description of the goods it is perhaps not surprising that the OHIM found these to be similar, but this decision was not provided to establish similarity in the marks but rather that the goods at issue here are similar. I mention it to place the eventual finding of the case in context. In this there was a finding that goods such as pizzas are similar to “bread” and whilst I may not have reached the same conclusions in the assessment of some of the individual criteria I do not take issue with the final outcome. The decision also found “pasta” to be similar to bread because these products share certain common ingredient and preparation features, have the same composition and organoleptic features belonging to the same category of nutrients, i.e. carbohydrates, satisfy the same needs, are in competition and usually produced by the same undertakings. This assessment has overtones of a scientific rather than the commercial/consumer-faced analysis that the above cases guide me to make. It is also sweeping in the determination of where and how the goods will impact on the consumer, for example, I am not aware of any baker of bread that also produces pasta and there is no evidence to support such a contention.

40. In conclusion I find the bread and bread products covered by the opponent’s earlier mark to be similar goods to the goods in Class 30 of the application, namely, ready-made pizzas sold complete, and also to the services listed in Class 43.

41. Both sides make reference to the use that they have made of their marks although in fairly general terms. What has been provided lacks the detail that I would need to be able to say that the opponent’s mark has acquired an enhanced level of distinctiveness or that it enjoys a reputation worthy of note, and likewise that I should take account of concurrent use by the applicants as part of the “global assessment”.

42. Taking all of the above into account and adopting the global approach advocated, I reach the conclusion that notwithstanding the similarity in respect of the goods and services and the connected “notional” circumstances such as in the channels of trade, market and consumer, the difference in the respective marks is such use of the mark applied for by the applicants, in connection with the stated goods and services, will not lead to confusion. Allowing for the possibility of imperfect recollection does not create the required potential for confusion. The opposition under Section 5(2)(b) therefore fails.

43. The opposition having failed on all grounds the applicants are entitled to a contribution towards their costs. I order the opponent to pay the applicants the sum of £2,250. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 6<sup>th</sup> day of September 2010**

**Mike Foley  
for the Registrar  
the Comptroller-General**