

O/0303/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003941464

BY MUSHI LAB OÜ

TO REGISTER THE TRADE MARK:

Mushi^{LAB}

IN CLASSES 5 AND 35

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 444041

BY BAR1 BRANDS LIMITED

BACKGROUND AND PLEADINGS

1. On 3 August 2023, Mushi Lab OÜ (“the applicant”) applied to register the trade mark shown on the cover page to this decision in the United Kingdom. Registration is sought for the following goods and services:

Class 5: Vitamin and mineral supplements; Food supplements; Probiotic supplements; Nutritional supplements consisting primarily of mushroom extract for boosting energy, enhancing mental focus and supporting the immune system.

Class 35: Promoting the goods and services of others via computer and communication networks; Providing commercial information and advice for consumers in the choice of products and services; Online ordering services; Promotional services.

2. The trade mark application was published for opposition purposes on 8 September 2023. On 8 November 2023, the application was opposed in its entirety by BAR1 BRANDS LIMITED (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). For the purpose of the opposition, the opponent relies upon the following trade mark and all goods for which it is registered, as laid out below:

United Kingdom Trade Mark (“UKTM”) 3840093:



Filing date: 18 October 2022

Registration date: 6 January 2023

Class 5: Dietetic substances; mineral food supplements; nutritional supplements; vitamin preparations; trace elements (preparations of -) for human use; vitamin supplements; mineral supplements; protein supplements; liquid vitamin supplements;

liquid nutritional supplements; nutritional supplement energy bars; powdered nutritional supplement energy drink mix; dietetic foods; dietetic beverages; nutritional supplement meal replacement bars for boosting energy.

Class 30: Confectionery; candy bars; energy food bars; energy bars; snack bars containing a mixture of grains, nuts and dried fruit [confectionery]; high-protein cereal bars; cereal bars; granola-based snack bars; muesli bars.

Class 32: Non-alcoholic beverages; mineral and aerated waters; fruit beverages and fruit juices; syrups and other preparations for making non-alcoholic beverages; vitamin fortified non-alcoholic beverages; isotonic drinks; non-alcoholic drinks enriched with vitamins and mineral salts; soft drinks for energy supply; concentrates for use in the preparation of energy drinks; powders for the preparation of beverages; powders used in the preparation of soft drinks; powders for isotonic beverages; energy drinks; preparations for making beverages; essences for making beverages.

3. The opponent submits that the similarities between the parties' respective trade marks and the identity and/or similarity between the parties' goods and services gives rise to a likelihood of confusion on the part of the relevant public, which includes a likelihood of association.

4. In its counterstatement, the applicant denies that the parties' marks are similar and, for the most part, denies that the respective goods and services are similar, though it does make some concession in relation to the applied-for goods in class 5. Nevertheless, it denies that there exists a likelihood of confusion or a likelihood of association.

5. The applicant is represented by Taylor Wessing LLP and the opponent by Mathys & Squire LLP. Only the opponent filed evidence during the course of the proceedings and, whilst neither party requested a hearing, both elected to file written submissions in lieu. This decision is taken following a careful perusal of the papers.

The opponent's evidence

6. Whilst I do not propose to summarise the opponent's evidence to any great extent, it comprises a witness statement from Mr Adam Hodgkinson dated 22 April 2024 and six supporting exhibits (AH1-AH6). Mr Hodgkinson has been the opponent's director since its incorporation on 29 April 2022. The exhibits comprise an extract from Companies House, screenshots from websites associated with the opponent and its various brands, websites discussing the effects of mushrooms and mushroom supplements, Amazon screenshots showing the applicant's goods for sale, extracts from the TikTok account of Mushi Lab and a report from the U.S Patent and Trade Mark Office showing that the applicant has applied to register its mark in the U.S.

DECISION

Relevance of EU law

7. 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. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Section 5(2)(b)

8. Section 5(2)(b) of the Act reads as follows:

“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.”

9. Section 5A of the Act reads as follows:

“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.”

10. The opponent’s mark clearly qualifies as an earlier trade mark pursuant to section 6 of the Act. Given that it had not been registered for five years or more before the filing date of the opposed application, it is consequently not subject to the proof of use provisions laid out in section 6A of the Act.

Section 5(2)(b) – case law

11. 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:

(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 goods and services

12. The competing goods and services are laid out at paragraphs 1 and 2 to this decision.

13. In addition to cases of *literal* identity, the General Court (“GC”) set out a further provision as to when goods (though it equally applies to services) can be considered identical in *Gérard Meric v Office for Harmonisation in the Internal Market*¹. It stated:

“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 where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

14. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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;

¹ Case T-133/05

(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.

15. In *Kurt Hesse v OHIM*,² the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*³, 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.”

16. 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 and/or 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 Amalia Mary Elliot v LRC Holdings Limited*⁴:

“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:

² Case C-50/15 P

³ Case T-325/06

⁴ BL O/255/13

“.....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.”

17. For the purpose of a comparison it is permissible to group goods or services together, as appropriate.⁵

18. Both parties' specifications include *vitamin supplements* and *mineral supplements* (albeit presented as a single term in the application and two distinct terms in the earlier mark). These goods are, clearly, identical.

19. As the applicant's *food supplements* encompasses the opponent's *mineral food supplements* these are, in accordance with *Meric*, to be deemed identical.

20. The applicant's *nutritional supplements consisting primarily of mushroom extract for boosting energy, enhancing mental focus and supporting the immune system* is encompassed by the opponent's *nutritional supplements*. These goods are therefore identical.

Probiotic supplements

21. The applicant has admitted that “some contested goods are classified the same as the opponent's goods (i.e. vitamin and mineral supplements)” but it has not cited *probiotic supplements* specifically. To my mind, these are likely to be encompassed by the opponent's *nutritional supplements*. In the alternative, I find there is at least a high degree of similarity between the goods, which will likely be utilised by the same consumer for the purpose of enhancing its health in some way. The trade channels are likely to be shared, for the most part, and there may be some similarity in the goods' physical nature (allowing for variation in the respective ingredients). The goods may, in certain circumstances, be competitive, and, given that the average consumer may expect that they originate from a shared or related undertaking, the goods may be considered complementary (though they are not necessarily indispensable).

⁵ *Separode Trade Mark* BL O-399-10 (AP)

Promoting the goods and services of others via computer and communication networks; Providing commercial information and advice for consumers in the choice of products and services; Online ordering services; Promotional services

22. In its submissions in lieu, the opponent states as follows:

“As regards the Applicant’s Services, these are broadly worded and not limited to specific sectors or products. If considered by reference to the Applicant’s Goods in Class 5, it is clear that the Applicant’s Services are intended to be directed to consumers of supplements and related goods; these could be direct consumers or wholesalers/retailers. It would follow, therefore, that the Applicant’s Services are closely similar to the Opponent’s Goods.”

23. Whilst the opponent’s comments are noted, I am mindful that the applicant’s terms are not limited in their scope and I will approach the terms as they appear before me, keeping in mind that my interpretation of the terms should be confined to the core of their possible meanings.⁶ On review of the relevant factors, I can see no meaningful degree of similarity between the applicant’s services in class 35 and the goods relied upon by the opponent. Any opportunity for coincidence, to my mind, is limited to the respective users of the goods and services which is likely to be in fairly broad terms only and not sufficient, in and of itself, to reach a finding of similarity. Whilst I appreciate that the opponent relies upon a number of goods which may, in reality, require engagement with some of the applicant’s services (promotional or ordering services, for example), this does not amount to what I consider to be a complementary relationship. Whilst there may be circumstances whereby the goods and services are considered important to one another, I do not find it likely that the average consumer would expect them to originate from a single undertaking. There is no similarity in use, nature nor trade channels and the goods and services are not competitive. Weighing all findings, I take the view that the goods and services are dissimilar.

24. As some degree of similarity between the parties’ terms is necessary to engage a likelihood of confusion,⁷ the opposition fails at this juncture in respect of all services applied for in class 35.

⁶ See, for example, *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36 or *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch)

⁷ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

The average consumer and the nature of the purchasing act

25. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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.”

26. The average consumer of the goods at issue is likely to predominantly comprise members of the general public, though it may also include healthcare professionals such as dieticians. To my knowledge, the goods are typically self-selected from the shelves of a traditional retail outlet, such as a pharmacy or an online equivalent, or will be viewed in the pages of a medical journal, for example. The marks' visual impression is, consequently, likely to carry the greatest weight throughout the purchasing process, though I do not discount the relevance of the marks' aural impact, particularly as recommendations may be made by retail representatives or peers, for example. Generally, the goods are not likely to carry a particularly high cost and will be purchased fairly frequently. The average consumer is likely to be alive to considerations such as compatibility and the health benefits of the goods' active ingredients, for example. Weighing all these conclusions, and having taken into account that the average consumer will comprise both the general public and healthcare professionals, I find the average consumer is likely to apply at least a medium degree of attention to its selection of the relevant goods.

Comparison of trade marks

27. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated, at paragraph 34 of its judgment in *Bimbo SA v OHIM*⁸, 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.”

28. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account 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.

29. For ease, the parties’ trade marks are displayed in the table below:

Opponent’s trade mark	Applicant’s trade mark
	Mushi ^{LAB}

⁸ Case C-591/12P

30. The opponent's mark is presented in black and white and comprises a number of elements. At the top of its mark, in a central position, is a device element depicting what will likely be perceived as a mushroom or toadstool character, presented within a circular shape. On the mushroom's stem is a face with a somewhat mischievous expression. On close inspection, I note that the character has lightning bolts above its eyes in lieu of traditional 'eyebrows'. However, I find it highly unlikely, in the wider context of the mark, that this would be recognised by the average consumer. The mushroom character appears to be growing from the ground or grass beneath. Underneath the circle it sits in are the words "MUSHEE GET ZAPPED". "MUSHEE" is significantly larger than "GET ZAPPED" and the adopted font is bold and italic. Finally, there is a shape reminiscent of a lightning bolt positioned underneath the mark's word elements. Particularly on account of their proportionate sizes, I find the most dominant elements within the mark are its device and the word "MUSHEE", which I consider will each make a roughly equal contribution to the mark's overall impression. The remaining elements are not negligible but play a lesser role.

31. The applicant's mark combines two word elements; "Mushi" and "Lab". "Mushi" is notably the largest of the words, presented in an ordinary typeface, with the first letter capitalised. "LAB" is positioned to the top right of the mark's "Mushi" element, in uppercase, in a fine black font. Whilst the mark's overall impression resides in the combination of both its word elements, the word "Mushi" may be attributed a greater weight on account of its size.

32. Visually, where the marks coincide is the similarity in the respective words "MUSHEE" and "Mushi", which share their first, second, third and fourth letters. Notwithstanding this identical sequence, given that I see little similarity in the marks' remaining elements and in light of my conclusions concerning the marks' respective overall impressions, I find the visual similarity is fairly low.

33. Aurally, the opponent's mark will likely be articulated in four syllables, roughly MUH-SHEE-GET-ZAPPED. I find it highly unlikely that either of the device elements within the marks will be articulated (or attempted to be articulated). The applicant's mark is likely to comprise three syllables; MUH-SHEE-LAB. The marks differ in their respective lengths but their first two syllables are identical. I can see little meaningful similarity in

the marks' remaining syllables. On balance, and keeping in mind that the beginnings of trade marks typically have a greater impact on the average consumer,⁹ I find a medium degree of aural similarity between the parties' marks.

34. When it comes to the marks' respective conceptual impressions, I turn first to the parties' submissions on the matter, beginning with the applicant:

“...The Opponent's mark invites the relevant consumer to think of goods containing mushrooms. It therefore has some element of inherent meaning, even if not a clear one. It uses visual quirks such as repetition of the lightning bolts in the mark to give connotations that the products made from mushrooms are energising and will give the consumer a “jolt”. This jarring impression is reinforced by the edgy, tense expression depicted on the face of the Mushroom Caricature. In addition, the term “GET ZAPPED” is intended to invoke an emotional response from the consumer.

37. In contrast, the Contested mark is devoid of these visual clues that invoke emotion. The element “LAB”, if anything, is intended to appeal to a consumer's sense of reason, i.e. well-regarded and quality products. As a whole, the Contested Mark may convey one of the following:

- a. no meaning at all (and appear as an entirely meaningless name for a laboratory); and
- b. a meaning derived from how the Applicant coined the word, namely as a laboratory in mushrooms are grown, handled or processed.

38. In the case of (a) above, no conceptual comparison can be made. In the case of (b), the comparison shows that the meanings are very different.

39. In consequence, the Contested Mark and the Opponent's Mark are conceptually dissimilar.”

35. The opponent contends as follows:

⁹ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

“34. The Applicant’s Mark consists of the words “Mushi” and “LAB”. As discussed above, the word “LAB” will be disregarded by the average consumer as it is banal. The average consumer will, therefore, focus on the word “Mushi”.

35. As also discussed above, the average consumer is likely to focus on the word “MUSHEE” when encountering the Opponent’s Mark.

36. The words “Mushi” and “MUSHEE” are invented words. Nevertheless, when considered by reference to the Applicant’s Goods, the average consumer will likely understand the word “Mushi” as alluding to the inclusion of mushroom-derivatives in the Applicant’s products. Indeed, with reference to Exhibit AH4 of the Witness Statement, it can be seen that the Applicant’s Mark is used in combination with words such as “Lion’s Mane Extract” and “Cordyceps” to reinforce this concept. Whilst it is true that, for the purposes of assessing the similarity of trade marks they should be examined only as they appear on the register, the manner in which the Applicant’s Mark is used emphasises the relevance of the Applicant’s Goods when assessing the conceptual meaning of the Applicant’s Mark.

37. Whilst the Opponent’s Registration does not make specific reference to mushroom-derivatives, the Opponent’s Goods are broadly worded such that they would include products containing mushroom-derivatives/extracts. In any case, the inclusion of a figurative mushroom device in the Opponent’s Mark will lead to the average consumer perceiving the concept of mushrooms when encountering the mark. From this, the average consumer will understand the word “MUSHEE” as alluding to the fact that the Opponent’s Goods include mushroom-derivatives/extracts.

38. As such, the respective marks will both evoke the concept of mushrooms. The marks therefore share at least an average degree of conceptual similarity on account of this.”

36. Consideration of the marks' conceptual impressions must be approached from the perspective of the average consumer. In the opponent's mark, the concept of mushrooms will readily be communicated by the depiction of a mushroom character. I take the view that, given the placement of the mark's elements, MUSHEE may be viewed as the character's name, though I accept that it may also simply be perceived as an invented word. The remaining word elements "GET ZAPPED" will create thoughts of either the MUSHEE character, or an unknown entity, being 'zapped' or destroyed. The lightning bolt underneath feeds into the latter concept. In the applicant's mark, whilst I take note of the opponent's comments, the applicant poses two likely interpretations of "Mushi LAB"; either a meaningless word used as the name of a laboratory or, alternatively, a laboratory in which mushrooms are grown, handled or processed. Even having regard to there being a term in the applicant's specification which refers to mushrooms specifically, I find it more likely that the average consumer will view "Mushi" as an invented term (with LAB understood as a common shortening of laboratory). I make this finding notwithstanding the shared sequence of "M-U-S-H" at the beginning of "Mushi" and "mushroom". To my mind, the words are not sufficiently similar to compel the average consumer to find an association between the two and automatically retrieve a concept of mushrooms from the applicant's mark as a consequence. Proceeding on that basis, I find there is no conceptual similarity between the respective marks. If I am found to have erred on that point, and the average consumer does derive the concept of mushrooms from both parties' marks, I find no more than a medium degree of conceptual similarity in light of the marks' additional conceptual elements. The opponent's mark presents an image of a character, and the notion of being 'zapped', whereas the concept conveyed by the applicant's mark is that of a laboratory.

Distinctive character of the earlier trade mark

37. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,¹⁰ 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

¹⁰ Case C-342/97

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-2779, 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)."

38. 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, to those with high inherent distinctive character, such as invented words which have no descriptive or allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

39. I do not have sufficient evidence before me showing use of the earlier mark to assess whether its distinctiveness has been enhanced through use. Consequently, I have only the inherent position to consider. I have already made my conclusions, above, regarding both the overall impression of the earlier mark and the conceptual impression it is likely to convey. Whilst I accept, as the opponent submits, that "the Opponent's Registration does not make specific reference to mushroom-derivatives, the Opponent's Goods are broadly worded such that they would include products containing mushroom-derivatives/extracts", as the specification does not make reference to mushrooms specifically, I will consider the mark's distinctiveness having regard to the terms as they appear before me. On that basis, given that mushrooms do not have any immediate link to the goods at hand, I do not consider the mark

particularly allusive, nor does it incorporate any descriptive elements. It comprises a number of figurative and word elements and the largest of its word elements, “MUSHEE”, is rather unusual and is likely to be perceived as an invented word or name. Weighing all factors, I find the earlier mark enjoys a fairly high degree of inherent distinctiveness.

Likelihood of confusion

40. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and/or services, and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark, as the more distinctive it is, the greater the likelihood of confusion. Conversely, the less distinctive it is, the lower the likelihood of confusion.

41. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

42. I take note of the comments made by Mr Iain Purvis Q.C., as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*¹¹, where he 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

¹¹ Case BL O/375/10

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).¹²

43. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*,¹² Arnold LJ approved Mr Purvis’s formulation but added:

“13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] ‘a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion’. Mr Mellor went on to say that, if there is no likelihood of direct confusion, ‘one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion’. I would prefer to say that there must be a proper

¹² [2021] EWCA Civ 1207

basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

44. To make the assessment, I must adopt the global approach advocated by the case law whilst taking account of my earlier conclusions. I also bear in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and, instead, must rely upon the imperfect picture of them retained in its mind.

45. Throughout the course of my decision, I have found the marks visually similar to a fairly low degree, aurally similar to a medium degree and, conceptually, I have found there is either no conceptual similarity between the marks or they are conceptually similar to no more than a medium degree. I have found that the average consumer, comprising the general public and professional users, is likely to apply at least a medium degree of attention to its purchase and that the marks’ visual impression is likely to play the greatest role in the selection process, though I do not discount the significance of the aural position. I have also found the earlier mark to enjoy a fairly high degree of inherent distinctiveness. Finally, the goods that remain in contention are identical or highly similar to those relied upon by the opponent.

46. I will begin by considering a likelihood of direct confusion. I keep in mind when approaching a likelihood of direct confusion the effects of the interdependency principle, as set out above. Even having done so, I find there is ample difference between the marks, particularly visually, for the average consumer to successfully identify that they are not the same. Whilst I accept that the consumer may imperfectly recollect the spelling of MUSHEE/Mushi, particularly as neither is an ordinary dictionary word, this is not the only element within the respective marks and their remaining elements and distinct conceptual nods (even where both marks evoke a concept of mushrooms) will allow the consumer to readily distinguish between them.

47. I move now to consider a likelihood of indirect confusion. On reflection of my findings throughout the decision, even when approached in regard to identical goods, I see no logical basis on which the average consumer, having identified that the marks are not the same and acknowledged their differences, would be minded to conclude that they originate from a shared or related undertaking. The differences between the marks are

not consistent with any of the examples set out in *L. A. Sugar* and I cannot identify any additional basis on which the consumer would reasonably reach that conclusion. Any similarity between the marks' respective "MUSHEE" and "Mushi" word elements and/or where both marks provide a partial conceptual indication of a mushroom would, to my mind, likely be attributed simply to coincidence. Whilst this may be sufficient for one mark to call the other to mind, particularly in regard to identical goods, this is mere association, and is not sufficient to satisfy a finding of indirect confusion.¹³

Conclusion

48. The opposition has failed. Subject to any successful appeal against this decision, the application will proceed to registration.

Costs

49. The applicant has been successful and is entitled to a contribution toward its costs. Awards of costs commenced on or after 1 February 2023 are governed by Annex A of Tribunal Practice Notice ("TPN") 1/2023. In accordance with that TPN, I award the costs to the applicant as follows:

Reviewing the Notice of Opposition and
preparing a counterstatement:

£250

Considering the opponent's submissions and
preparing submissions in lieu of a hearing:

£350

Total:

£600

50. I hereby order BAR1 BRANDS LIMITED to pay Mushi Lab OÜ the sum of £600. 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.

¹³ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

Dated this 31st day of March 2025

**Laura Stephens
For the Registrar**